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

| | |
|---------------------------|---|
| Proceeding | 91177900 |
| Party | Defendant BioWare Corp. |
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| Date | 08/31/2007 |
| Attachments | Applicant's Motion to Dismiss.pdf (17 pages)(549254 bytes) |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Trademark Trial and Appeal Board**

IN RE: BIOWARE CORP. v. VUTEK, INC.

Trademark: BIOWARE/PANDEMIC STUDIOS

Opposer: BioWare Corp.

Applicant: VUTEK, Inc.

Opposition No. 91177900

Serial No. 76653517

United States Patent and Trademark Office

Trademark Trial and Appeal Board

P.O. Box 1451

Alexandria, VA 22313-1451

APPLICANT BIOWARE CORP.'S MOTION TO DISMISS

PURSUANT TO FED.R.CIV.P. 12 (B)(6)

Pursuant to TBMP § 503 and Fed. R. Civ. P. 12(b)(6), Applicant BioWare Corp. (hereafter, "BioWare") brings the instant motion to dismiss the opposition to its pending application (the "Opposition") brought by Opposer VUTEK, Inc. (hereafter, "VUTEK") for the reasons set forth herein.

I. Introduction

BioWare brings its motion to dismiss VUTEK's opposition on two separate grounds: (1) Opposer VUTEK fails to assert a legally-cognizable ground upon which BioWare's registration

may be denied and, as such fails to state a claim, and (2) VUTEk lacks standing to oppose BioWare's registration.

II. Argument

“The purpose of a motion to dismiss under Fed.R.Civ.P. 12(b)(6) is to test the formal sufficiency of the statement of the claim for relief.” *Hartwell Co. v. Shane*, 17 U.S.P.Q.2D (BNA) 1569, 1570 (TTAB 1990). In order to survive a motion to dismiss, VUTEk must plead facts showing (1) that VUTEk has standing and (2) a valid ground for denying the registration. *Young v. AGB Corp.*, 47 U.S.P.Q.2D (BNA) 1752, 1754 (TTAB 1998). As discussed, *infra*, VUTEk has failed to do either.

The sole facts pled by Opposer are stated in Paragraphs 6 through 9 of the Opposition:

6. BioWare has filed an opposition against VUTEk's application for the mark BIOWARE in International Class 2 based on BioWare's ownership of registrations of the mark BIOWARE in International Classes 9, 16 and 41 (the "BioWare Opposition"). The BioWare Opposition is currently pending before the Trademark Trial and Appeal Board ("TTAB"), Case No. 91174133. In the BioWare Opposition, BioWare has asserted a likelihood of confusion between its BIOWARE registrations in International Classes 9, 16 and 41 and VUTEk's application for the mark BIOWARE in International Class 2.

7. Accordingly, VUTEk believes that if Applicants' application for the BIOWARE/PANDEMIC STUDIOS mark proceeds to registration, BioWare will assert a likelihood of confusion between this mark and VUTEk's application for the mark BIOWARE in International Class 2. Any such action by BioWare would prejudice VUTEk's application for the mark BIOWARE in International Class 2.

8. Based on BioWare's actions including the BioWare Opposition, VUTEk believes that it will be damaged if the BIOWARE/PANDEMIC STUDIOS mark is registered, and hereby opposes the registration.

9. By virtue of the foregoing, Applicants' application should be rejected and registration of the term BIOWARE/PANDEMIC STUDIOS as a trademark of Applicants should be denied and refused.

Opposition, pp. 2-3

In summary, VUTEk's facts pled in support of standing and grounds for denial of BioWare's application are:

1. BioWare filed an opposition against VUTEk's application for the mark, "BIOWARE."
2. VUTEk believes that BioWare would assert the mark that is the subject of the instant proceeding, "BIOWARE/PANDEMIC STUDIOS," if registered, against VUTEk in the other proceeding.
3. VUTEk believes that it will be damaged if that happens.

VUTEk alleges no likelihood of confusion, no concern for dilution, in fact, no pecuniary interest whatsoever. Indeed, it cannot as such a position would be inconsistent with resisting BioWare's Opposition to its own efforts to register the "BIOWARE" mark for itself. Indeed, VUTEk expressly pleads that there is no likelihood of consumer confusion and no dilution that would result if it is allowed to register "BIOWARE" for itself. *See*, Vutek's Answer to Notice of Opposition, Opp.No. 91174133, Affirmative Defenses, ¶ 2, a true and correct copy of which is attached hereto as Exhibit "A" ("There is no likelihood of confusion under all applicable facts and criteria required by U.S. trademark law.").

Instead, VUTEk attempts to argue what is, essentially, some sort of procedural disadvantage with respect to the other proceeding. As a matter of law, this does not constitute a basis for denying registration, nor does an allegation of a naked and factually unsupported "belief" that it would be so disadvantaged confer standing to oppose.

A. VUTEk Fails to Plead Valid Grounds for Denying Registration

“A party opposing a registration pursuant to Section 13 of the Lanham Act must show . . . a statutory ground which negates the applicant's entitlement to registration.”

Young v. AGB Corp., supra. This requirement provides that a legally-cognizable infirmity be pled. *See, e.g.,* 3. J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, § 20:13 (4th ed. 2007) (“By administrative and judicial interpretation, it has been held that once standing to oppose is shown, opposer may raise any legal defect or deficiency in the application.”) VUTEk’s Opposition fails to allege any legal basis upon which BioWare’s pending application could or should be denied. VUTEk’s only allegation is that it will be “damaged” because of its belief that BioWare might cite the pending registration in another proceeding.

As a matter of law, VUTEk’s contention does not constitute “damage” providing a basis upon which relief may be sought. This specific question was addressed in *Morton Foods, Inc. v. The Frito Co.*, 50 C.C.P.A. 1105, 314 F.2d 822; 1963 CCPA LEXIS 389, 137 U.S.P.Q. (BNA) 58 (C.C.P.A. 1963). *Morton Foods* reviewed the granting of a motion to dismiss an opposition for failure to state a claim in which the opposer’s sole ground for opposition was, for all intents and purposes, identical to that alleged by VUTEk in the instant action:

“In view of the infringement action against Opposer [by Applicant], based in part on the unregistered trademark ‘CHEE-TOS’, Opposer believes it would be damaged by the registration of such mark by reason of the advantages that would accrue to applicant as plaintiff in the infringement suit by having a Federal trademark registration for ‘CHEE-TOS’, such advantages, among others, being

set forth in the Trademark Act of July 6, 1946, Sections 33(a) and 39; 15 U.S.C. 1115(a) and 1121.”

Id.

The C.C.P.A., in reviewing the TTAB’s granting of the applicant’s 12(b)(6) motion, framed the question presented as follows: “Whether the specified procedural advantages which accrue to the owner of a registered mark, constitute, as a matter of law, such ‘damage’ to the defendant in an infringement action as to support an opposition brought under Sec. 13 of the Lanham Act?” *Id.* Relying on a series of decisions by the T.T.A.B¹, the C.C.P.A. held, “[T]he facts as are alleged here by opposer do not constitute a showing of damage within the meaning of Section 13 of the Lanham Act, *supra.*” *Id.*

This Board, as well, has consistently denied such assertions of “damage” as a basis for opposition. For example, in *DeLuxe Reading Corp. v. Rexall Drug and Chemical Co.*, 147 U.S.P.Q. 54 (TTAB 1995), a cancellation proceeding, this Board held:

“It is clear from the pleading and from petitioner's response to the motion under consideration that [Opposer] De Luxe is predicating its right to cancel the registrations in question on the ground that it is being damaged thereby by virtue of the fact that in an opposition proceeding respondent relied on said registrations as a basis for opposing the registration of petitioner's trademark. It is well established, however, that the mere filing of an opposition against one's application to register a mark cannot be said to constitute legal injury within the meaning of sections 14 or 24 of the Act.”

¹ . E.g., *Brown & Bigelow v. The International Silver Company*, 86 USPQ 460 (Commr., 1950) and *Conde Nast Publications, Inc. v. Swann*, 127 USPQ 85 (TT&A Bd., 1960)

Id., citing, *Sunbeam Corporation v. Duro Metal Products Co.*, 112 USPQ 403 (Comr., 1957); *Joseph Dixon Crucible Company v. Richard Best Pencil Company*, 99 USPQ 170 (Comr., 1953). Cf. *Morton Foods, Inc. v. The Frito Company*, 137 USPQ 58 (CCPA, 1963); accord, *FS Services, Inc. v. Feed Service Corp.*, 150 U.S.P.Q. (BNA) 201, 202 (TTAB 1956) (“[T]he mere filing of an opposition against the registration of a mark does not in and of itself constitute damage or legal injury.” [citations omitted])

“In order to establish probable damage because of the registration of a mark, it must be alleged and shown not only that the registration is invalid but that the presence of the mark is inconsistent with some right to use the same or a confusingly similar term for like goods which the petitioner possesses under the Trademark Act of 1946. That is to say, the petition must be sufficient in and of itself independently to state a valid cause of action notwithstanding that petitioner may have been charged with a violation of the registrant's trademark rights.” *Richard Gregg Mfg. Co., Inc. v. La Maur, Inc.*, 166 U.S.P.Q. 568 (TTAB 1970). VUTEk has, clearly, failed to state on basis for denying BioWare’s pending application for registration.

As in *Morton*, Opposer in the instant matter alleges as “damage” only that the procedural advantages that, it contends, would accrue to BioWare in another action, if the instant application matures into a registration. As in *Morton*, this does not constitute “damage” within the meaning of the law. As VUTEk fails to allege cognizable damage, its Opposition is insufficient as a matter of law and should, therefore, be dismissed pursuant to Fed. R. Civ. P. 12(b)(6).

B. VUTEk Lacks Standing to Assert an Opposition

As discussed, *supra*, VUTEk’s Opposition fails to plead any legal ground under which BioWare’s pending application may be denied. However, the Board need not even reach this

question, because VUTEk also lacks the fundamental requirement of standing to assert an Opposition in the first place.

“Section 13 of the Lanham Act establishes a broad class of persons who are proper opposers; by its terms the statute only requires that a person have a belief that he would suffer some kind of damage if the mark is registered. However, in addition to meeting the broad requirements of § 13, an opposer must meet two judicially-created requirements in order to have standing -- the opposer must have a ‘real interest’ in the proceedings and must have a ‘reasonable’ basis for his belief of damage.” *Ritchie v. Simpson*, 170 F.3d 1092, 1095 (Fed. Cir. 1999). Here, Opposer has neither a real interest in the proceedings nor a reasonable basis for belief of damage.

As discussed, *supra*, an applicant’s gain of a procedural advantage in a different proceeding does not constitute “damage” within the meaning of Section 13 of the Lanham Act. As a matter of law, this is insufficient to confer standing on VUTEk. *See, e.g., American Angus Ass’n v. Sysco Corp.*, 865 F. Supp. 1180, 1182 (D.N.C. 1993) (“The Court further notes that while an attack on the mark may give Defendants leverage in the underlying infringement action, that does not constitute ‘belief in damage’ so as to give Defendants standing to challenge the mark.”), *citing, Morton Foods, Inc. v. Frito Co.*, 50 C.C.P.A. 1105, 314 F.2d 822, 823 (C.C.P.A. 1963).

Similarly, Opposer states only that it “believes” that “BioWare will assert a likelihood of confusion between this mark and VUTEk's application for the mark BIOWARE in International Class 2.” There is absolutely no factual allegation supporting this purported “belief.” BioWare has done nothing to suggest that it believes that Opposer’s pending application is barred because of a likelihood of consumer confusion with the mark that is the subject of the instant application,

or that it would assert the instant application against Opposer in the other proceeding and, indeed, Opposer alleges no facts whatsoever that would suggest its belief is, in any way, reasonable. Opposer has simply invented its “belief,” without the slightest basis in reality, solely for the purpose of attempting to satisfy the standing requirement for a trademark opposition. Such a subjective and unverified (and unverifiable) “belief” is insufficient to confer standing. *See, e.g., Ritchie v. Simpson*, 170 F.3d 1092, 1097-1098 (Fed. Cir. 1999) (“[O]ur precedents suggest something more -- that the ‘belief of damage’ required by § 13 of the Lanham Act is more than a subjective belief. *See Universal Oil v. Rexall Drug & Chemical Co.*, 463 F.2d 1122, 1124, 174 U.S.P.Q. (BNA) at 459-60. (“The belief must have a ‘reasonable basis in fact,’ [emphasis added]”); *accord, Young v. AGB Corp.*, 47 U.S.P.Q.2D (BNA) 1752, 1754 (Fed. Cir. 1998) (“A party opposing a registration pursuant to Section 13 of the Lanham Act must show (1) that he has standing and (2) a statutory ground which negates the applicant's entitlement to registration. Moreover, an opposer must at the pleading stage allege facts in support of both, a conclusion that is fully consistent with the PTO's rules. *See generally 37 C.F.R. Section 2.112(a)* (1997) [emphasis added]).”

VUTEk has failed, utterly, to allege either a belief that it will suffer legally-cognizable damage, or any factual basis that would render such belief reasonable within the meaning of the statute. As such, VUTEk lacks standing to oppose the instant application, and its Opposition should be dismissed on this ground as well.

III. Conclusion

VUTEk's Opposition lacks the most fundamental requirements to be viable. VUTEk fails to allege any cognizable basis for denying BioWare's pending application. Moreover,

VUTEk fails, completely, to assert any basis for standing – it pleads no belief in cognizable damages nor a single fact that would render any such belief reasonable. As such, its Opposition pleading is fatally deficient. For the foregoing reasons, BioWare respectfully requests that VUTEk’s Opposition be dismissed pursuant to Fed. R. Civ. P. 12(b)(6) and TBMP § 503.

Dated: August 31, 2007

Respectfully submitted,

BRYAN CAVE LLP

/s/ Paul N. Tauger

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Attorney for Trademark Opposer

BioWare Corporation

CERTIFICATE OF FILING

The undersigned hereby certifies that the foregoing APPLICANT BIOWARE CORP.’S MOTION TO DISMISS PURSUANT TO FED.R.CIV.P. 12 (B)(6) was electronically filed with the U.S. Patent & Trademark Office Trademark Trial and Appeal Board, on this 31st day of August, 2007.

/s/Paul N. Tauger

CERTIFICATE OF SERVICE

I hereby certify that a true copy of APPLICANT BIOWARE CORP.'S MOTION TO DISMISS PURSUANT TO FED.R.CIV.P. 12 (B)(6) was served upon the Opposer Vutek, Inc. by mailing the same by first class mail to Opposer's counsel, Terence J. Clark, Esq., Greenberg, Traurig, 2450 Colorado Avenue, Suite 400E, Santa Monica, CA 90404, on the 31st day of August, 2007.

/s/Julie D. Fitzwater
Julie D. Fitzwater

TABLE OF AUTHORITIES

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EXHIBIT “A”

TTAB
78,841,029

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

| | | |
|----------------|---|-------------------------|
| BioWare Corp., |) | Opposition No. 91174133 |
| |) | |
| Opposer, |) | |
| vs. |) | |
| |) | |
| Vutek, Inc., |) | |
| |) | |
| Applicant. |) | |

ANSWER TO NOTICE OF OPPOSITION

Applicant Vutek, Inc. ("Applicant"), by and through its undersigned counsel, hereby answers the Notice of Opposition and believes that it is entitled to registration of the mark shown in Application Serial No. 78/841,029 and that opposer BioWare Corp. ("Opposer") will not be damaged by registration of the mark.

Applicant responds to the numbered paragraphs of the Notice of Opposition as follows:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 1 of the Notice of Opposition and therefore denies the same.
2. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 2 of the Notice of Opposition and therefore denies the same.
3. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 3 of the Notice of Opposition and therefore denies the same.



4. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 4 of the Notice of Opposition and therefore denies the same.

5. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 5 of the Notice of Opposition and therefore denies the same.

6. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 6 of the Notice of Opposition and therefore denies the same.

7. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 7 of the Notice of Opposition and therefore denies the same.

8. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 8 of the Notice of Opposition and therefore denies the same.

9. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 9 of the Notice of Opposition and therefore denies the same.

10. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 10 of the Notice of Opposition and therefore denies the same.

11. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 11 of the Notice of Opposition and therefore denies the same.

12. Applicant denies the allegations set forth in Paragraph 12 of the Notice of Opposition.

13. Applicant denies the allegations set forth in Paragraph 13 of the Notice of Opposition.

14. Applicant denies the allegations set forth in Paragraph 14 of the Notice of Opposition.

15. Applicant denies the allegations set forth in Paragraph 15 of the Notice of Opposition.

16. Applicant denies the allegations set forth in Paragraph 16 of the Notice of Opposition.

17. Applicant admits that federal registration provides Applicant a legal presumption of ownership of the mark and the exclusive right to use the mark nationwide on or in connection with the goods and/or services listed in the registration, but denies that registration of the mark shown in Application Serial No. 78/841,029 would be a source of injury or damage to Opposer. Applicant denies the remaining allegations set forth in Paragraph 17 of the Notice of Opposition.

18. Applicant denies the allegations set forth in Paragraph 18 of the Notice of Opposition.

Affirmative Defenses

1. Opposer has failed to state a claim on which relief may be granted.
2. There is no likelihood of confusion under all applicable factors and criteria required by U.S. trademark law.
3. There is no likelihood of confusion because the goods or services of the parties are noncompetitive and unrelated.
4. Opposer's mark has not attained the requisite secondary meaning to acquire distinctiveness as claimed by Opposer.
5. There is no likelihood of dilution under all applicable factors and criteria required by U.S. trademark dilution law.
6. Opposer's mark is not famous under the requirements of U.S. trademark dilution law.
7. Opposer's mark has not become the principal meaning of the word Bioware.
8. Opposer's mark is not so distinctive that the public would associate Opposer's mark with Opposer even when such mark is encountered apart from Opposer's goods or services.
9. Third party use of its mark precludes Opposer's claim of dilution.

WHEREFORE, Applicant respectfully requests that the Opposition be dismissed with prejudice and that Application Serial No. 78/841,029 proceed to registration.

Dated: December 28, 2006

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Terence J. Clark", written over a horizontal line.


Terence J. Clark
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Certification of Mailing

I hereby certify that this ANSWER TO NOTICE OF OPPOSITION is being filed electronically with the United States Patent and Trademark Office, Trademark Trial and Appeal Board.

December 28, 2006

(Date)




Grace E. Kim
Sr. Trademark Paralegal

Certificate of Service

The undersigned hereby certifies that a true and correct copy of the foregoing ANSWER TO NOTICE OF OPPOSITION was served on counsel for Opposer via first class mail, with pre-paid postage thereon, on December 28, 2006, at the following address:

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Grace E. Kim
Sr. Trademark Paralegal