

ESTTA Tracking number: **ESTTA250603**

Filing date: **11/21/2008**

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	Sony Computer Entertainment America Inc.
Granted to Date of previous extension	12/17/2008
Address	919 E. Hillsdale Blvd. Foster City, CA 94404 UNITED STATES

Correspondence information	Sony Computer Entertainment America Inc. 919 E. Hillsdale Blvd. Foster City, CA 94404 UNITED STATES suzanne_williams@playstation.sony.com Phone:650-655-7313
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### Applicant Information

Application No	77441100	Publication date	08/19/2008
Opposition Filing Date	11/21/2008	Opposition Period Ends	12/17/2008
Applicant	Ernesto Ramirez 6838 Thistle Hill Way Austin, TX 78754 UNITED STATES		

### Goods/Services Affected by Opposition

Class 028. All goods and services in the class are opposed, namely: Plush toys
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### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

### Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	77513861	Application Date	07/02/2008
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	SACKBOY		

Design Mark	<b>SACKBOY</b>
Description of Mark	NONE
Goods/Services	Class 028. First use: TOYS, NAMELY, ACTION FIGURES

Related Proceedings	Opposer has also filed a related proceeding No. 91186359 for the mark PLAY CREATE SHARE
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Attachments	77513861#TMSN.jpeg ( 1 page )( bytes ) SACKBOYOPPTTAB0001.pdf ( 18 pages )(546032 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 Overnight Courier on this date.

Signature	/anthony justman/
Name	Sony Computer Entertainment America Inc.
Date	11/21/2008

SONY COMPUTER ENTERTAINMENT AMERICA INC., a Delaware corporation with its principal place of business as 919 E. Hillsdale Blvd., Foster City, CA 94404 (“Opposer”), believes that it will be damaged by the registration of the alleged mark SACKBOY shown in the Intent-to-Use Application bearing Serial No. 77/441,100 (“Application”). Opposer opposes the Application on the grounds set forth in this Opposition.

1. The owner of the Application is Ernesto Ramirez (“Applicant”). Applicant filed the Application on April 6, 2008 for the alleged mark “SACKBOY” in International Class 28 for “Plush toys.” A true and correct copy of the Application is attached to this Opposition as Exhibit “A”.

2. On July 2, 2008, Opposer filed an application to register SACKBOY with the U.S. Trademark Office, Serial No. 77/513,861, for “toys, namely, action figures” in International Class 28. A true and correct copy of the Application is attached to this Opposition as Exhibit “B”.

3. Registration of the alleged mark “SACKBOY” contained in the Application is improper for two reasons: (1) Opposer’s trademark use of “SACKBOY” precedes that of Applicant for the mark in question; and (2) Applicant did not have a bona fide intention to use “SACKBOY” in connection with goods to be offered by him at the time Applicant filed his trademark application.

#### **FACTS ESTABLISHING OPPOSER’S PRIOR USE OF SACKBOY**

4. Opposer and its affiliates have for many years marketed and sold in the United States a wide range of video game and video game hardware products

under the world-famous PLAYSTATION®, PLAYSTATION®2, PSP® and PLAYSTATION®3 marks. These products include the PLAYSTATION and PS ONE video game consoles and the PLAYSTATION 2, PSP and PLAYSTATION 3 computer entertainment systems. Opposer and its close affiliates are also one of the largest publishers of video game titles in the world.

5. Opposer has published a new video game entitled *Little Big Planet* for play exclusively on the PLAYSTATION 3 system. Opposer and its affiliates distribute *Little Big Planet* world wide, having published the game in October 2008.

Opposer and its affiliates will invest millions of dollars in developing, advertising and distributing *Little Big Planet*. Video game titles like *Little Big Planet* are the video game industry's equivalent of Hollywood's "blockbusters," referred to in the industry as "AAA" titles due to the investment of time and money in creating the game and, hopefully, the sales of the game. "AAA" titles often take years to develop, and video game publishers commonly promote and market such titles far in advance of their release so as to create demand for the games upon publication.

6. In March 2007, Opposer unveiled *Little Big Planet* publicly for the first time at the Game Developers Conference in San Francisco, California. The Game Developers Conference is a well-attended and prominent trade event in the video game industry, and all important media outlets that cover the video game industry attend and report on the event.

7. Opposer's unveiling of *Little Big Planet* demonstrated videos of the game's footage and introduced the game's main character SACKBOY, a burlap sack

creature with child-like expressions and demeanor. Opposer made press releases in connection with the Game Developers Conference event containing information about *Little Big Planet*, the game's tagline *Play Create Share*,<sup>1</sup> and the SACKBOY character.

8. Contemporaneous with the Game Developers Conference, Opposer's game developer, Media Molecule, began a world-wide promotion of *Little Big Planet* with the central character, SACKBOY, on its website. The portion of the website dedicated to *Little Big Planet* touts the features and functionality of the game, provides creative promotional assets for download, and features pictures of SACKBOY.

9. In July 2007, Opposer released a video demonstrating *Little Big Planet*, the associated *Play Create Share* tagline, and the game's main character, SACKBOY, to the press at the video game industry's annual convention, E3. E3 is typically an even larger trade event than the Game Developers Conference and receives world-wide coverage by the media, including mainstream media outlets. The *Little Big Planet* video was disseminated throughout the world the same day, via the internet, and was featured on numerous video game related websites, on blogs and in the press.

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<sup>1</sup> As described in this Opposition, Applicant filed the Application for SACKBOY as well as for *Play Create Share* after Opposer's introduction of these two marks in connection with *Little Big Planet*. The selection of these two marks can be no mere coincidence and provides strong evidence that Applicant's purpose in filing applications for these marks is not to use them but instead to interfere with Opposer's legitimate use of them.

10. Since February 2008, Opposer, through its game developer Media Molecule, has featured pictures of the SACKBOY character and used the SACKBOY mark on the internet, including featuring blog postings regarding SACKBOY dolls. The SACKBOY doll has generated hundreds of consumer comments expressing interest in buying a SACKBOY plush doll. Two months later, Applicant filed for the marks SACKBOY and SACKBOY TOYS.

11. Since early 2007, Opposer has spent approximately \$500,000.00 in pre-sale advertising and marketing activities to promote *Little Big Planet* and its featured character SACKBOY in the United States. These pre-sale activities include the creation of artwork, advertising and promotional materials, sell sheets and web sites related to the game and issuing press releases and promoting *Little Big Planet* at trade shows and consumer events. These activities include the use of the SACKBOY mark in connection with the game and the merchandise that Opposer intends to bring to market. All of these activities are intended to generate sales of games and merchandise through building goodwill around the franchise and the associated trademarks including SACKBOY.

12. As a result of Opposer's extensive and continuous use in commerce through its pre-sales activities, the SACKBOY character and its name have become known to the relevant purchasing public as representing goods and services associated with Opposer and the *Little Big Planet* franchise, and SACKBOY has acquired significant goodwill.

13. Opposer's and Applicant's SACKBOY marks are identical. The alleged goods for which Applicant states he intends to use his alleged mark are similar to

Opposer's goods. In view of the similarity of the respective marks and the related nature of the goods of the respective parties, Opposer alleges that Applicant's mark so resembles Opposer's mark as to be likely to cause confusion or to cause mistake or to deceive.

14. Applicant's intended use of Opposer's SACKBOY mark can only mislead or will likely mislead others to believe mistakenly that goods offered in connection with Applicant's mark originate from or are in some way associated with, sponsored or endorsed by, or related to Opposer and its goods and services. Applicant's mark should be denied registration pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d).

**APPLICANT DID NOT FILE THE APPLICATION FOR SACKBOY WITH A GOOD-FAITH INTENT TO USE THE MARK**

15. Applicant has filed two Intent-to-Use trademark applications incorporating the word SACKBOY (Application Nos. 77/513,861 and 77/441,100). SACKBOY is the name of the main character in *Little Big Planet*. SACKBOY is a fanciful and original name, and Opposer has invested substantial time and money as set forth above in creating goodwill in the SACKBOY mark and establishing an association between that mark, on the one hand, and the *Little Big Planet* video game and related merchandise, on the other hand.

16. Opposer is informed and believes and on that basis alleges that Applicant's sole reason for filing the SACKBOY and SACKBOY TOYS applications is to interfere with Opposer's business. All of Applicant's Intent-to-Use trademark filings are preemptive in nature. The fact that Applicant has

applied for *Play Create Share*, SACKBOY and SACKBOY TOYS before Opposer's launch of its *Little Big Planet* video game can be no mere coincidence because no other connection exists between these marks other than Opposer's video game. Applicant's filing of these marks is conclusive evidence that Applicant intends to interfere in bad faith with Opposer's business and related trademarks. Applicant's Intent-to-Use trademark filing for SACKBOY is fraudulent and should be denied.

**COUNT ONE: OPPOSER'S TRADEMARK USE PRECEDES THAT OF APPLICANT**

17. Opposer's pre-sales activities relating to *Little Big Planet* and SACKBOY constitute analogous-use priority under Section 2(d) of the Lanham Act, 15 U.S.C.S. §1052(d). Opposer is therefore the senior user of the trademark SACKBOY. Through Opposer's extensive and continuous pre-sales activities for the launch of *Little Big Planet* and related merchandise and Opposer's use of SACKBOY, the relevant purchasing public has come to associate SACKBOY with the goods and services of Opposer. Because Opposer's use precedes the filing date of Applicant's Intent-to-Use Application, the Application should be denied registration.

**COUNT TWO: APPLICANT DID NOT HAVE A BONA FIDE INTENTION TO USE SACKBOY IN CONNECTION WITH HIS GOODS AT THE TIME APPLICANT FILED HIS TRADEMARK APPLICATION.**

18. Alternatively, the U.S. Patent and Trademark Office should deny the Application because Applicant did not have a bona fide intention at the time he



filed the Application to use SACKBOY in connection with any goods to be offered by him.

19. The trademark SACKBOY is a trademark of Opposer and associated with Opposer's *Little Big Planet* video game and merchandise related to this game. Applicant's pre-emptive Intent-to-Use trademark applications for SACKBOY, SACKBOY TOYS and *Play Create Share* - marks whose only connection is Opposer's highly publicized video game - demonstrates that Applicant had no legitimate use for these marks other than to interfere with Opposer's use of these marks as the senior user. Applicant's trademark application should be denied on the basis of fraud.

WHEREFORE, Opposer prays that Application No. 77/441,100 for the alleged mark SACKBOY be denied and refused registration. Please recognize as attorneys for Opposer, Riley R. Russell, General Counsel & Senior Vice President, and Anthony J. Justman, Director, of Sony Computer Entertainment America Inc., 919 E. Hillsdale Blvd., Foster City, CA 94404.

# EXHIBIT “A”



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# Sackboy

<b>Word Mark</b>	<b>SACKBOY</b>
<b>Goods and Services</b>	IC 028. US 022 023 038 050. G & S: Plush toys
<b>Standard Characters Claimed</b>	
<b>Mark Drawing Code</b>	(4) STANDARD CHARACTER MARK
<b>Serial Number</b>	77441100
<b>Filing Date</b>	April 6, 2008
<b>Current Filing Basis</b>	1B
<b>Original Filing Basis</b>	1B
<b>Published for Opposition</b>	August 19, 2008
<b>Owner</b>	(APPLICANT) Ernesto Ramirez INDIVIDUAL UNITED STATES 6838 Thistle Hill Way Austin TEXAS 78754
<b>Type of Mark</b>	TRADEMARK
<b>Register</b>	PRINCIPAL
<b>Live/Dead Indicator</b>	LIVE

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**Serial Number:** 77441100 Assignment Information      Trademark Document Retrieval

**Registration Number:** (NOT AVAILABLE)

**Mark**

# Sackboy

**(words only):** SACKBOY

**Standard Character claim:** Yes

**Current Status:** A request for an extension of time to file an opposition has been filed at the Trademark Trial and Appeal Board.

**Date of Status:** 2008-09-08

**Filing Date:** 2008-04-06

**Transformed into a National Application:** No

**Registration Date:** (DATE NOT AVAILABLE)

**Register:** Principal

**Law Office Assigned:** LAW OFFICE 102

**Attorney Assigned:**  
BUTLER ANDREA P

**Current Location:** 650 -Publication And Issue Section

**Date In Location:** 2008-07-17

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

---

1. Ernesto Ramirez

**Address:**  
Ernesto Ramirez

6838 Thistle Hill Way  
Austin, TX 78754  
United States  
**Legal Entity Type:** Individual  
**Country of Citizenship:** United States  
**Phone Number:** 512-278-1963  
**Fax Number:** 512-278-1963

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**GOODS AND/OR SERVICES**

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**International Class:** 028  
**Class Status:** Active  
Plush toys  
**Basis:** 1(b)  
**First Use Date:** (DATE NOT AVAILABLE)  
**First Use in Commerce Date:** (DATE NOT AVAILABLE)

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**ADDITIONAL INFORMATION**

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(NOT AVAILABLE)

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**MADRID PROTOCOL INFORMATION**

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(NOT AVAILABLE)

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**PROSECUTION HISTORY**

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- 2008-09-08 - Extension Of Time To Oppose Received
- 2008-08-19 - Published for opposition
- 2008-07-30 - Notice of publication
- 2008-07-17 - Law Office Publication Review Completed
- 2008-07-17 - Assigned To LIE
- 2008-07-17 - Approved for Pub - Principal Register (Initial exam)
- 2008-07-17 - Assigned To Examiner
- 2008-04-10 - Notice Of Pseudo Mark Mailed
- 2008-04-09 - New Application Entered In Tram

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**ATTORNEY/CORRESPONDENT INFORMATION**

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**Correspondent**

ERNESTO RAMIREZ

6838 THISTLE HILL WAY

AUSTIN, TX 78754-5800

Phone Number: 512-278-1963

Fax Number: 512-278-1963

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# EXHIBIT “B”



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# SACKBOY

**Word Mark** SACKBOY  
**Goods and Services** IC 028. US 022 023 038 050. G & S: TOYS, NAMELY, ACTION FIGURES  
**Standard Characters Claimed**  
**Mark Drawing Code** (4) STANDARD CHARACTER MARK  
**Serial Number** 77513861  
**Filing Date** July 2, 2008  
**Current Filing Basis** 1B  
**Original Filing Basis** 1B  
**Owner** (APPLICANT) Sony Computer Entertainment America Inc. CORPORATION DELAWARE  
 919 E. Hillsdale Blvd. Foster City CALIFORNIA 94404  
**Type of Mark** TRADEMARK  
**Register** PRINCIPAL  
**Live/Dead Indicator** LIVE

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**Registration Number:** (NOT AVAILABLE)

**Mark**

# SACKBOY

**(words only):** SACKBOY

**Standard Character claim:** Yes

**Current Status:** An office action suspending further action on the application has been mailed.

**Date of Status:** 2008-08-05

**Filing Date:** 2008-07-02

**Transformed into a National Application:** No

**Registration Date:** (DATE NOT AVAILABLE)

**Register:** Principal

**Law Office Assigned:** LAW OFFICE 112

**Attorney Assigned:**  
BORSUK ESTHER A

**Current Location:** M3X -TMO Law Office 112 - Examining Attorney Assigned

**Date In Location:** 2008-08-05

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

---

1. Sony Computer Entertainment America Inc.

**Address:**  
Sony Computer Entertainment America Inc.  
919 E. Hillsdale Blvd.

Foster City, CA 94404  
United States  
**Legal Entity Type:** Corporation  
**State or Country of Incorporation:** Delaware  
**Phone Number:** 650/655-7313  
**Fax Number:** 650/655-5901

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**GOODS AND/OR SERVICES**

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**International Class:** 028  
**Class Status:** Active  
TOYS, NAMELY, ACTION FIGURES  
**Basis:** 1(b)  
**First Use Date:** (DATE NOT AVAILABLE)  
**First Use in Commerce Date:** (DATE NOT AVAILABLE)

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**ADDITIONAL INFORMATION**

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**MADRID PROTOCOL INFORMATION**

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**PROSECUTION HISTORY**

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2008-08-05 - Letter of suspension mailed  
2008-08-05 - Suspension Letter Written  
2008-08-04 - Assigned To Examiner  
2008-07-08 - Notice Of Pseudo Mark Mailed  
2008-07-07 - New Application Entered In Tram

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**ATTORNEY/CORRESPONDENT INFORMATION**

---

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Fax Number: 650/655-5901

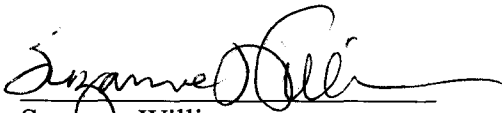
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**Certificate of Mailing by "Overnight Delivery"**

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I hereby certify that this Trademark Opposition is being deposited with the United States Postal Service "Overnight Delivery" service on November 21, 2008 in an envelope addressed to:

Ernesto Ramirez  
6838 Thistle Hill Way  
Austin, Texas 78754

A handwritten signature in black ink, appearing to read "Suzanne Williams", written over a horizontal line.

Suzanne Williams  
Sony Computer Entertainment America Inc.  
919 East Hillsdale Boulevard  
Foster City, CA 94404