

ESTTA Tracking number: **ESTTA784143**

Filing date: **11/21/2016**

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	Id Software LLC
Granted to Date of previous extension	11/23/2016
Address	500 North Greenville Avenue, Suite 700 Richardson, TX 75081 UNITED STATES

Attorney information	D. Wade Cloud, Jr. Hiersche, Hayward, Drakeley & Urbach PC 15303 Dallas Parkway, Suite 700 Addison, TX 75001 UNITED STATES wcloud@hhdulaw.com Phone:9727017013
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Applicant Information

Application No	87001099	Publication date	07/26/2016
Opposition Filing Date	11/21/2016	Opposition Period Ends	11/23/2016
Applicant	TOMY COMPANY, LTD. 7-9-10 Tateishi, Katsushika-ku Tokyo, 124-8511 JAPAN		

Goods/Services Affected by Opposition

Class 028. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Toy spinning tops; play sets therefore, namely, spinners for spinning toy tops and playing surface boards for playing toy tops thereon; toy action figures

Grounds for Opposition

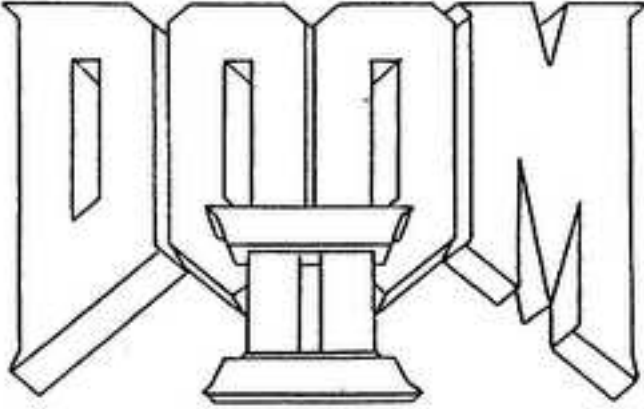
Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
Dilution by tarnishment	Trademark Act Sections 2 and 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2050083	Application Date	12/10/1992
Registration Date	04/08/1997	Foreign Priority Date	NONE

Word Mark	DOOM
Design Mark	
Description of Mark	NONE
Goods/Services	Class 028. First use: First Use: 1993/12/10 First Use In Commerce: 1993/12/10 computer software games and computer game programs

U.S. Registration No.	2084910	Application Date	02/07/1996
Registration Date	07/29/1997	Foreign Priority Date	NONE
Word Mark	FINAL DOOM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 1996/06/27 First Use In Commerce: 1996/06/27 computer software games and computer game programs		

U.S. Registration No.	2303100	Application Date	09/30/1994
Registration Date	12/28/1999	Foreign Priority Date	NONE
Word Mark	DOOM II		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 1994/09/27 First Use In Commerce: 1994/09/27 computer software games and computer game programs		

U.S. Registration No.	2928605	Application Date	02/13/2004
Registration Date	03/01/2005	Foreign Priority Date	NONE
Word Mark	DOOM3		

Design Mark	<h1>DOOM 3</h1>		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2004/08/06 First Use In Commerce: 2004/08/06 computer software games, computer software game programs and computer game cartridges or CD-ROMs for video games for entertainment uses with manuals sold as a unit		

U.S. Registration No.	3529554	Application Date	01/30/2006
Registration Date	11/11/2008	Foreign Priority Date	NONE
Word Mark	DOOM RPG		
Design Mark	<h1>DOOM RPG</h1>		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2005/10/31 First Use In Commerce: 2005/10/31 Computer game software for use on cell phones and other handheld wireless devices and via download for cell phones and other handheld wireless devices		

U.S. Registration No.	4621580	Application Date	05/31/2012
Registration Date	10/14/2014	Foreign Priority Date	NONE
Word Mark	DOOM 3 BFG EDITION		
Design Mark	<h1>DOOM 3 BFG EDITION</h1>		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2012/10/16 First Use In Commerce: 2012/10/16 downloadable computer game software offered via the internet and wireless		

	devices; computer game software for use with computers and video game consoles; computer game software for use on cell phones and other handheld wireless devices; computer game software for use with on-line interactive games
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Attachments	74710905#TMSN.png(bytes) 76575353#TMSN.png(bytes) 76654206#TMSN.png(bytes) 85640286#TMSN.png(bytes) Doomscizor Opposition Final Filed 11-21-2016.pdf(164979 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	/dwc/
Name	D. Wade Cloud, Jr.
Date	11/21/2016

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

Id Software LLC	§	In the Matter of Trademark
	§	Application Serial No. 87001099
Opposer,	§	
	§	For the Mark:
v.	§	DOOMSCIZOR
	§	
Tomy Company, LTD	§	Published in the Official Gazette on
	§	July 26, 2016
	§	
Applicant.	§	Opposition No. _____

NOTICE OF OPPOSITION

COMES NOW, Id Software LLC (“*Opposer*”) and opposes the trademark application for the mark DOOMSCIZOR (“*Opposed Mark*”); Serial No. 87001099 (“*Opposed Application*”) filed by Tomy Company, LTD (“*Applicant*”) under the provisions of Sections 2(d), 13 and 43(c) of the Trademark Act of July 5, 1946, 15 U.S.C. §§ 1052(d), 1063 and 1125(c), and respectfully asserts the following:

PARTIES

1. Opposer is a Delaware Limited Liability Company located at 1500 N. Greenville Ave., Suite 700, Richardson, Texas 75150.
2. Applicant, on information, is a limited liability company with an address of 7-9-10 Tateishi, Katsushika-ku Tokyo JAPAN 124-8511.

FACTUAL BACKGROUND

3. Opposer, a developer of computer software games and computer game programs, is the owner of all right, title and interest in and to these trademarks registered with the United States Patent and Trademark Office: DOOM, (Reg. Number 2050083, Registered April 8, 1997); FINAL DOOM, (Reg. Number 2084910, Registered July 29, 1997); DOOM II, (Reg. Number 2303100, Registered December 28, 1999); DOOM 3, (Reg. Number 2928605, Registered March 1, 2005); and DOOM RPG, (Reg. Number 3529554, Registered November 11, 2008). In addition, Opposer is the owner of DOOM 3 BFG EDITION in International Class (“*IC*”) 009 (Reg. Number 4621580, Registered October 14, 2014) for “downloadable computer game

software offered via the internet and wireless devices; computer game software for use with computers and video game consoles; computer game software for use on cell phones and other handheld wireless devices; computer game software for use with on-line interactive games.” All of the foregoing marks of Opposer are collectively referred to as the DOOM Marks.

4. DOOM, DOOM II, and FINAL DOOM are registered in IC 009 for "computer games and computer game programs". DOOM 3 is registered in IC 009 for "computer software games, computer software game programs and computer game cartridges or CD-ROMs for video games for entertainment uses with manuals sold as a unit". DOOM RPG is registered in IC 009 for "computer game software for use on cell phones and other handheld wireless devices and *via* download for cell phones and other handheld wireless devices.”

5. The Opposed Application was filed on April 14, 2016 and published for Opposition on July 26, 2016. Opposer timely filed requests for extension to file Opposition. Opposer's extension requests were granted by the Trademark Trial and Appeal Board ("**TTAB**") thereby extending the Opposition period to November 23, 2016.

6. Opposer has used DOOM on or in connection with computer software games and computer game programs on a valid and continuous basis since at least as early as December 10, 1993. Opposer's computer games, which include the famous games of DOOM, QUAKE, RAGE and WOLFENSTEIN, have appeared in both PC and video game console versions. Some of Opposer's computer games including DOOM, DOOM II AND DOOM 3 are multiplayer, real-time games playable over the Internet and local area networks. Some of Opposer's computer games including DOOM, DOOM II AND DOOM 3 are available *via* download from the Internet and *via* tangible media made available through retailers. DOOM RPG is a role-playing software game. The DOOM mark has been used in connection with toy figurines. In addition, Opposer has used some of the DOOM Marks on caps and t-shirts and intends to continue to do so. The DOOM Marks have not been abandoned and their Registrations continue in full effect.

7. Opposer has established substantial goodwill in the DOOM Marks. The DOOM Marks are identified exclusively with Opposer and Opposer's computer software games and computer game programs as well as clothing and other goods marked with DOOM.

8. The Opposed Application states that Applicant intends to use the Opposed Mark in connection with the following goods:

IC 028 - toy spinning tops; play sets therefore, namely, spinners for spinning toy tops and playing surface boards for playing toy tops thereon; toy action figures

9. Opposer opposes the Opposed Application's Class 028 goods ("**Class 028 Opposed Goods**"). Opposer would show that Opposer will suffer damages, including, without limitation, the loss of goodwill, unless the Opposed Mark is refused registration.

CLAIMS / GROUNDS FOR OPPOSITION

A. Prior Use.

10. Opposer incorporates paragraphs 1 through 9, inclusive, herein.

11. The DOOM Marks are prior and senior to the Opposed Mark as described above. Opposer's prior use of the DOOM Marks as described above supports denial of the Opposed Application and refusal of registration of the Opposed Mark.

B. Likelihood of Confusion.

12. Opposer incorporates paragraphs 1 through 11, inclusive, herein.

13. The Opposed Mark closely resembles the registered DOOM Marks because of Applicant's inclusion of DOOM at the beginning of the Opposed Mark. Opposer contends that Applicant's proposed use of the Opposed Mark on or in connection with the Class 028 Opposed Goods is likely to cause confusion, or to cause mistake, or to deceive.

14. Opposer has continuously and prominently used the DOOM Marks in connection with computer games and computer game programs.

15. According to the Opposed Application, Applicant intends to use the Opposed Mark in connection with the Class 028 Opposed Goods which overlap with Opposer's prior uses, and potential future uses, including in connection with toy figurine figures. Accordingly, a likelihood of confusion, mistake or deception amongst consumers appears to be likely, as well as a loss of goodwill by Opposer should registration issue for the Opposed Mark.

C. Dilution.

16. Opposer incorporates paragraphs 1 through 15, inclusive, herein.

17. Opposer's DOOM Marks are famous and became famous before the filing date or any use of the Opposed Mark by Applicant. The use and registration of the Opposed Mark is likely to dilute the distinctive quality of Opposer's famous DOOM Marks in violation of Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c).

CONCLUSION

18. Opposer believes it will be damaged by registration of the Opposed Mark under Section 13 of the Trademark Act, 15 U.S.C. § 1063, because consumers, familiar with Opposer's famous DOOM Marks are likely to believe, mistakenly, that Applicant's Class 025 Opposed Goods emanate from, are sponsored or authorized by, or are otherwise associated or affiliated with Opposer, in violation of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

19. Opposer believes it will be damaged by registration of the Opposed Mark under Section 13 of the Trademark Act, 15 U.S.C. § 1063, because the use and registration of the Opposed Mark with the Class 025 Opposed Goods is likely to dilute the distinctive quality of Opposer's famous DOOM Marks in violation of Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c).

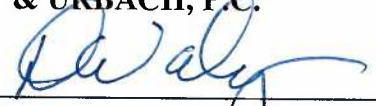
20. For the foregoing reasons, the Opposed Application should be denied and

registration of the Opposed Mark should be refused.

WHEREFORE, Opposer believes that it will be damaged by registration of the Opposed Mark and respectfully requests that the registration sought by Applicant be refused entirely.

DATED: **November 21, 2016**

Respectfully submitted,
**HIERSCHE, HAYWARD, DRAKELEY
& URBACH, P.C.**

By: 
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State Bar No. 04407500

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Addison, Texas 75001
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**ATTORNEYS FOR OPPOSER
ID SOFTWARE LLC**

CERTIFICATE OF SERVICE

I, D. Wade Cloud, Jr., hereby certify that a true copy of the foregoing **NOTICE OF OPPOSITION** was served on Applicant's attorney of record this **November 21, 2016** sending same *via* First Class mail, postage prepaid to:

**Midge M. Hyman, Esq.
COWAN, LIEBOWITZ & LATMAN, P.C.
114 WEST 47TH STREET
NEW YORK, NEW YORK 10036**

By: 
D. Wade Cloud, Jr.