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

Proceeding	91237780
Party	Defendant Stardock Systems, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 87/371,549

Mark: ENDLESS EMPIRES

AMPLITUDE STUDIOS,

Opposer,

-against-

STARDOCK SYSTEMS, INC.,

Applicant.

Consolidated Opposition No. 91237780

-and-

In the Matter of Application Serial No. 87/372,185

Mark: ENDLESS ENEMIES

AMPLITUDE STUDIOS,

Opposer,

-against-

STARDOCK SYSTEMS, INC.,

Applicant.

RESPONSE IN OPPOSITION TO MOTION TO AMEND REGISTRATION

Pursuant to Trademark Rule 2.127, Applicant and Petitioner, Stardock Systems, Inc. (“**Stardock**” or “**Applicant**”), through its undersigned counsel, hereby submits this Response in Opposition to Opposer and Registrant, Amplitude Studios’ (“**Amplitude**” or “**Opposer**”) Motion to Amend Registration (the “**Motion**”).

I. Amplitude’s Proposed Amendment to Registration

Amplitude has moved to amend U.S. Registration No. 4,366,504 for the mark ENDLESS SPACE (the “**ENDLESS SPACE Registration**”) to delete certain goods and services in the registration, as follows:

~~**Class 9:** *Scientific apparatus, namely, sensing and signaling devices for measurement and quality control of materials processing by laser; photographic apparatus, namely, cameras, photographic filters, straight viewfinders and angled viewfinders, flash units for cameras, flashbulbs and projectors; cinematographic apparatus, namely, cinematographic cameras, cinematographic projectors, and optical apparatus, namely, optical cables, optical fiber cables, optical character readers, optical communications systems comprised of optical and electronic hardware and computer software for the transmission of data between two points, optical disc players, and apparatus for the recording, transmission, reception, reproduction and processing of sound and images; apparatus for projecting slides, namely, slide projectors; telephone, facsimile apparatus and telecommunication apparatus, namely, automatic switching apparatus, change over switches, electric capacitors, electric resistors, electrical transformers, electronic testing equipment, namely, telecommunication line integrity testing apparatus, indicator lights, microphones, wireless digital electronic apparatus to secure and protect data and images on all forms of wireless equipment including mobile telecommunications equipment using an automatic synchronization process and alarm notification of the loss or theft of the wireless equipment including mobile telecommunications equipment; sound amplification apparatus, namely, personal headphones for use with sound transmitting systems, sound amplifiers, sound equalizers and crossovers, sound loudspeakers; electronic data processing apparatus; coin operated juke boxes; personal digital assistants, personal stereos, loudspeaker cabinets, cinematographic cameras, video cameras, video game cartridges, blank video cassettes, pre-recorded video cassettes featuring music and images in the field of galaxies, civilizations and planets. video games cartridges and cassettes, blank CD-ROMs for sound or video recording, prerecorded CD-ROMs featuring video games and sound recording disks, namely, blank record disks, audio disks featuring music; blank audio and video compact disks for sound and video recording, prerecorded audio and video compact disks featuring music and images in the field of galaxies, civilizations and planets; blank magnetic disks, blank optical disks; digital tablets, namely, mobile computer input devices; computer game consoles; video and projection screens; recorders, namely, audio and video recorders, digital voice and video recorders, telephone recorders; data processing equipment and computers; **Computer game software; software recorded***~~

~~on magnetic, optical, digital and electronic media, namely, software programs for the integration of text, audio, graphics, still images and moving pictures into an interactive delivery for multimedia applications, software for processing digital music files, software for use in relation to digital animation and special effects of images, software for processing digital images, software for creating and editing music and sounds, game engine software for video game development and operation; computers and computer peripheral devices, namely, screens, keyboards, mice, web consoles, joysticks, magnetic coded card readers, optical readers, digital book readers and electronic book readers, electronic card readers, computer cursor control devices, namely, digitizer tablets, printers for use with computers, modems, computer memories, and magnetic, optical, digital and electronic recording media, namely, blank magnetic data carriers, blank optical data carriers, blank digital storage media, blank electronic storage media. magnetic, optical, digital and electronic media for computer programs, namely, blank magnetic computer tapes and pre-recorded magnetic computer tapes featuring video games, blank optical disks and pre-recorded optical disks featuring video games, blank digital audio and video tapes and pre-recorded digital audio and video tapes featuring video games, blank electronic storage media and pre-recorded electronic storage media featuring video games~~

Class 28: ~~Games and toys, namely, action skill games, games adapted for use with television receivers, video game consoles for use with an external display screen or monitor, video game interactive control floor pads or mats, video game interactive remote control units; electronic games apparatus other than those adapted for use with an external display screen or monitor, automatic games apparatus, not coin operated and other than those adapted for use with an external display screen or monitor, playing cards, targets and electronic targets for games and sports, parlor games, large and small balls for games, bowling balls, toy carousels, puppets, theatrical masks, carnival masks, toy guns, elbow guards and knee guards for athletic use, toy vehicles and remote control toy vehicles, shuttlecocks; amusement apparatus adapted for use with an external display screen or monitor; automatic and coin-operated amusement machines~~

Class 41: ~~Education services, namely, providing live or on-line, classes, seminars, workshops, tutoring, mentoring in the field of computer programs and video games; entertainment, namely, arranging, organizing, conducting, and hosting special events for social entertainment purposes, arranging, organizing and conducting, live or on-line, video games competitions; organizing community sporting and cultural events; videotaping; production of sound recordings; operation of online, non-downloadable electronic publications, namely, publishing of electronic publications; operation of amusement arcades; information on entertainment and recreation and providing information about education; rental of audio apparatus, lighting apparatus for theater sets or television studios, cinematographic apparatus and accessories, videotapes, video cameras, show scenery, cinematographic films, sound recordings, and video games; organization of shows for cultural purposes, organization of exhibitions for cultural or educational purposes, arranging and conducting of training workshops, colloquiums, concerts, conferences, congresses, seminars, and symposiums in the field of computer programs and video games, and all for educational purposes; sporting and cultural~~

~~competitions; organization and production of television shows, game shows, live plays and live television shows; production of films, audio tapes, video games software, and radio and television programs; publication of books and texts other than publicity texts; writing of scripts and texts other than publicity texts; **electronic game services provided on-line from a computer network**; recording studio services; digital imaging services; providing recreation facilities; music composition services. performing artists' services, namely, providing information and news releases about a performing artist and providing the services of a performing artist in the nature of musical performances, theater performances and dance performances; box office services, namely, entertainment ticket agency services; **providing information on-line in the fields of computer games and other entertainment information**~~

The goods and services requested to be deleted by Amplitude above are herein referred as the “**Proposed Deleted Goods and Services.**” If the amendment is allowed, the remaining identification of goods and services in the ENDLESS SPACE Registration would be as follows:

Class 9: *computer game software*

Class 28: *games adapted for use with television receivers*

Class 41: *entertainment, namely, arranging, organizing, conducting, and hosting special events for social entertainment purposes, arranging, organizing and conducting on-line, video games competitions; electronic game services provided on-line from a computer network; providing information on-line in the fields of computer games*

Because Stardock is entitled to discovery on Amplitude’s bona fide intent to use the ENDLESS SPACE mark in connection with *all* goods and services listed in the ENDLESS SPACE Registration, including the Proposed Deleted Goods and Services, Amplitude’s Motion should be denied, or at the very least deferred, as further discussed below.

II. The Motion Should Be Denied as Stardock Is Entitled to Discovery on Amplitude’s Bona Fide Intent to Use the Mark with Respect to All Goods and Services

On May 21, 2012, Amplitude filed its application for ENDLESS SPACE with the United States Patent and Trademark Office (“USPTO”) under Section 66(a) of the Trademark Act representing that it had a bona fide intent to use the mark in commerce on all goods and services listed in the application. *See* 15 U.S.C. § 1141f(a) (“A request for extension of protection of an

international registration to the United States that the International Bureau transmits to the United States Patent and Trademark Office shall be deemed to be properly filed in the United States if such request, when received by the International Bureau, *has attached to it a declaration of bona fide intention to use the mark in commerce that is verified by the applicant for, or holder of, the international registration.*”) (emphasis added). Amplitude’s filing of the present Motion to delete an overwhelming majority of the goods and services from the ENDLESS SPACE Registration suggests that Amplitude likely never had the requisite bona fide intent to use the mark in commerce in the United States at the time of filing the request for extension of protection of the international registration in the United States.

The Trademark Trial and Appeal Board (“**Board**”) has held that a lack of a bona fide intention to use the mark with respect to some goods or services in an application or registration supports an opposition or cancellation against *all* of the goods or services in the respective application or registration. *See, e.g., Spirits International B.V. v. S.S. Taris Zeytin Ve Zeytinyagi Tarim Satis Kooperatifleri Birliđi*, 99 USPQ2d 1545, 1547 n.3 (TTAB 2011) (“A lack of a bona fide intention to use the mark with respect to any of the goods or services in a class results in sustaining the Opposition against all the goods or services in that class.”); *Bryan Papé and Spello Group, LLC v. Me To We Social Enters., Inc.*, Opposition No. 91218595, 2016 WL 1642754, at *4 (TTAB Feb. 29, 2016) (“A lack of a bona fide intention to use the mark with respect to any of the goods or services in a class results in sustaining the Opposition against all the goods or services in that class.”); *see also, DLR Licensing, LLC v. Carnival Corp.*, 2014 TTAB LEXIS 451, *25-26 (Trademark Trial & App. Bd. October 22, 2014).

Thus, given the nature of Amplitude’s Motion, Stardock should be afforded the opportunity to obtain discovery as to whether Amplitude had a bona fide intent to use the mark ENDLESS

SPACE in connection with *all* of the goods and services listed in the ENDLESS SPACE Registration at the time of extending protection in the United States and further assess its potential claims and defenses against Amplitude in this proceeding.

III. Alternatively, a Ruling on the Motion Should Be Deferred Until Final Decision

Pursuant to 37 C.F.R. § 2.133(a), “An application subject to an opposition may not be amended in substance nor may a registration subject to a cancellation be amended or disclaimed in part, except with the consent of the other party or parties and the approval of the Trademark Trial and Appeal Board, or upon motion granted by the Board.” *See* Trademark Trial and Appeal Board Manual of Procedure (“TMEP”) § 514.01. Stardock has not consented to Amplitude’s Motion. Thus, the ENDLESS SPACE Registration may only be amended upon motion granted by the Board.

According to TMEP § 514.03, “[t]he Board generally will defer determination of a timely filed (i.e., pretrial) unconsented motion to amend in substance until final decision, or until the case is decided upon summary judgment.” *See Zachry Infrastructure LLC v. American Infrastructure, Inc.*, 101 USPQ2d 1249, 1255-56 (TTAB 2011) (unconsented motion to amend to Supplemental Register deferred until summary judgment or final hearing); *Enbridge Inc. v. Excelerate Energy L.P.*, 92 USPQ2d 1537, 1539 n.3 (TTAB 2009) (motion to amend identification of goods and dates of use deferred until final hearing); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1219 (TTAB 1990) (motion to amend identification of goods deferred); *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552, 1554 (TTAB 1987) (motion to amend dates of use deferred); *Mason Engineering & Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956, 957 n.4 (TTAB 1985) (same).

Still, as Amplitude correctly states in its Motion, the Board may grant a motion to amend immediately and without deferment, if all of the following circumstances are present:

- 1) the proposed amendment must serve to limit the broader identification of goods or services;
- 2) the applicant must consent to the entry of judgment on the grounds for opposition with respect to the broader identification of goods or services present at publication;
- 3) if the applicant wishes to avoid the possibility of a *res judicata* effect by the entry of judgment on the original identification, the applicant must make a *prima facie* showing that the proposed amendment serves to change the nature and character of the goods or services or restrict their channels of trade and customers so as to introduce a substantially different issue for trial; and
- 4) where required to support the basis of the subject application, any specimens of record must support the goods or services as amended; and the applicant must then introduce evidence during its testimony period to prove use of its mark with the remaining goods or services prior to the relevant date as determined by the application's filing basis.

Wis. Cheese Group, LLC v. Comercializadora de Lacteos y Derivados, S.A. deC.V., 118 U.S.P.Q.2D (BNA) 1262, 1265-1266 (TTAB March 30, 2016) (“*Wis. Cheese*”) (quoting *Johnson & Johnson v. Stryker Corp.*, 109 USPQ2d 1077, 1078-79 (TTAB 2013)). Despite Amplitude’s argument to the contrary, the third circumstance is relevant and not present in this proceeding. Therefore, the Motion should be deferred, if not otherwise denied.

Amplitude’s proposed amendment will not serve to change the nature and character of the goods or services or restrict their channels of trade and customers so as to introduce a substantially different issue for trial, as the goods and services most relevant to the proceeding will remain in the ENDLESS SPACE Registration. And, Amplitude’s proposed amendment does not delete all of the goods and services subject to Stardock’s counterclaim. Moreover, as discussed above, Stardock is entitled to discovery as to Amplitude’s bona fide intent to use the ENDLESS SPACE mark in connection with *all* goods and services currently listed in the ENDLESS SPACE

Registration. By amending the registration to delete the Proposed Deleted Goods and Services, Amplitude is limiting the scope of discovery under Fed. R. Civ. P. 26(b) to which Stardock is entitled as discussed above. *See Wis. Cheese*, 118 U.S.P.Q.2D (BNA) at 1266 (“Here, while Applicant's deletion of goods from its applications does not automatically alter the scope of discovery, the parties should keep these principles in mind as they agree to the appropriate scope of and limits on discovery in this proceeding given the amendments to Applicant's identification of goods.”); *see generally, Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147, 149 n.2 (TTAB 1985) (finding discovery relating to goods other than those enumerated in applicant’s applications irrelevant to the proceeding). As a result, since not all of the circumstances in *Wis. Cheese* are present in this case, the Board should, at the very least, defer the Motion until final decision.

IV. Conclusion

In light of the foregoing, Stardock respectfully requests that the Board deny Amplitude’s Motion and allow the parties to conduct discovery in relation to all goods and services currently listed in the ENDLESS SPACE Registration. In the alternative, the Board should defer a decision on the Motion until final decision of the proceeding, or until the case is decided upon summary judgment.

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CERTIFICATE OF SERVICE

I hereby certify that on June 27, 2018, I caused to be served via Electronic Mail a true and correct copy of the foregoing Response in Opposition to the Motion to Amend Registration on Opposer and Registrant, Amplitude Studios' counsel of record, as follows:

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