

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: October 22, 2018

Opposition No. 91237780

Amplitude Studios

v.

Stardock Systems, Inc.

Before Wellington, Ritchie and Goodman,
Administrative Trademark Judges.

By the Board:

This case now comes up for consideration of Opposer's fully-briefed motion (filed June 16, 2018) to amend to limit the identification of goods and services of its pleaded registration for the mark ENDLESS SPACE, the subject of Applicant's counterclaim.

I. Background

Opposer opposes registration of Applicant's standard character marks ENDLESS EMPIRES¹ and ENDLESS ENEMIES² based on a likelihood of confusion with its

¹ Application Serial No. 87371549, filed March 15, 2017, based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. § 1051(b). The identification of goods in that application is "Computer game software for personal computers and home video game consoles; Computer game software downloadable from a global computer network; Downloadable computer game programs" in International Class 9.

² Application Serial No. 87372185, filed November 14, 2017, based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b). The identification of goods in that application is "Computer game software downloadable from a global computer network; Computer game software for personal computers and home video game consoles; Downloadable computer game programs" in International Class 9.

previously used and registered “family” of ENDLESS marks, comprising standard character marks ENDLESS SPACE,³ ENDLESS LEGEND,⁴ and DUNGEONS OF THE ENDLESS.⁵ Applicant, in its answer, denied the salient allegations of the notice of opposition, asserted affirmative defenses, and, in an amended counterclaim,⁶ seeks to cancel Opposer’s pleaded registration for the mark ENDLESS SPACE on the ground of abandonment based on Opposer’s “apparent nonuse of the mark ... in connection with the goods and services below as set forth within the ... [r]egistration ... for three (3) or more consecutive years,” 13 TTABVUE 6. In lieu of an answer to the amended counterclaim, Opposer filed a motion to amend the identification of goods and services by limiting the identification to: “computer game software” in International Class 9, “games adapted for use with television receivers” in International Class 28, and “entertainment, namely, arranging, organizing, conducting, and hosting special events for social entertainment purposes; arranging,

³ Registration No. 4366504, issued July 16, 2013 under Trademark Act Section 66(a), 15 U.S.C. § 1141f(a), for a wide range of goods and services in International Classes 9, 28 and 41.

⁴ Registration No. 5173614, issued April 4, 2017, under Trademark Act Section 66(a) for “computer game software” in International Class 9, “games adapted for use with television screen” in International Class 28, and “electronic game services provided on-line from a computer network; information services concerning online computer games” in International Class 41. Opposer limited the identification of goods and services during the pendency of this case.

⁵ Registration No. 5178663, issued April 11, 2017, under Trademark Act Section 66(a) for the same goods and services as Registration No. 5173614. Opposer limited the identification of goods and services during the pendency of this case.

⁶ Applicant filed the original counterclaim on February 22, 2018, as part of its answer, 9 TTABVUE. Applicant filed an amended counterclaim, 13 TTABVUE, on April 26, 2018, in response to Opposer’s motion, filed April 6, 2018, to dismiss the counterclaim under Fed. R. Civ. P. 12(b)(6), 11 TTABVUE.

organizing and conducting on-line, video games competitions; electronic game services provided on-line from a computer network; providing information on-line in the field of computer games” in International Class 41. Applicant opposes entry of the proposed amendment at this time and asks that consideration be deferred until final decision or resolution of this case by motion for summary judgment.

II. Motion to amend granted, judgment entered on abandonment counterclaim re: deleted goods and services

A registration that is the subject to a counterclaim may not be amended 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 Rules 2.114(b)(3)(iii) and 2.133(a). The Board generally defers determination of a pretrial unconsented motion to amend until final decision or until the case is decided upon motion for summary judgment. *See* TBMP § 514.03 (2018) and cases cited therein.

Nonetheless, an unconsented motion to amend may be granted prior to trial where:

- The proposed amendment limits the identification of goods and/or services;
- The registrant consents to the entry of judgment on the ground for cancellation with respect to the broader identification of goods and/or services as originally registered;
- If the registrant wishes to avoid the possibility of a *res judicata* effect by the entry of judgment on the original identification, the registrant 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
- Where specimens were required to support the filing basis of the application for the involved registration, the specimens of record support the goods or services as amended; and the registrant 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 Grp., LLC v. Comercializadora de Lacteos y Derivados S.A. de C.V., 118 USPQ2d 1262, 1265-66 (TTAB 2016); *Johnson & Johnson v. Stryker Corp.*, 109 USPQ2d 1077, 1078-79 (TTAB 2013). A decision on the proposed amendment now may impact the scope of discovery and thus reduce the cost of litigating this case. *See* TBMP § 414(11) ("A party need not provide discovery with respect to those of its marks and goods and/or services that are not involved in the proceeding and have no relevance thereto.") and cases cited therein. Therefore, notwithstanding that we generally we defer consideration of unconsented amendments until summary judgment or final decision, we elect to exercise our discretion to decide the motion to amend now.

Regarding the first and second of the foregoing factors, the proposed amendment limits the identification of goods and services, and Opposer consents to entry of judgment in the counterclaim on the claim of abandonment with regard to the deleted goods and services. As for the fourth of these factors, the application for Opposer's subject registration was filed under Trademark Act Section 66(a) and did not require submission of specimens in support thereof.

Thus, Opposer's motion turns on the third factor, i.e., whether the proposed amendment serves to change the nature and character of the goods and services or restrict their channels of trade and customers so as to introduce a substantially different issue for trial. Opposer's proposed amendment eliminates the vast majority of the identified goods and services from the registration at issue, see below. In so

eliminating, the proposed amendment restricts the channels of trade and prospective customers of those goods and services so as to introduce a substantially different issue for trial. *See Johnson & Johnson*, 109 USPQ2d at 1079; *Int'l Harvester Co. v. Int'l Tel. and Tel. Corp.*, 208 USPQ 940 (TTAB 1980) (applicant's proposed amendment found to permissibly restrict the scope of the goods to the extent that it narrowed the category of users and, therefore, the function for which the goods may normally be used).

In opposition to the motion to amend, Applicant contends that it is entitled to seek discovery regarding Opposer's bona fide intent to use the mark ENDLESS SPACE on all of the goods and services currently identified in Opposer's involved registration. However, abandonment is the only pleaded claim in Applicant's counterclaim; Discovery is limited to "any nonprivileged matter that is relevant to any party's claim or defense and proportional to the needs of the case." Fed. R. Civ. P. 26(b)(1). Since Applicant did not allege a claim of no bona fide intent to use, there is no basis for discovery on such claim. Relying upon *Spirits Int'l B.V. v. S.S. Taris Zeytin Ve Zeytinyagi Tarim Satis Kooperatifleri Birliigi*, 99 USPQ2d 1545, 1547 n.3 (TTAB 2011), Applicant asserts that lack of a bona fide intention to use the mark with respect to any of the goods or services in each class would result in the counterclaim being sustained against each class in its entirety. 17 TTABVUE 5-7. In *Spirits Int'l B.V.*, however, the Board indicated that, prior to trial, the applicant in that case "could have moved to delete [certain goods] from its identification if applicant did not

have a bona fide intention to use its mark in commerce with respect to such goods,” as Opposer seeks to do here.⁷ *Spirits Int’l B.V.*, 99 USPQ2d at 1547 n.3.

Based on the foregoing, we find that it is appropriate to allow Opposer to amend its pleaded Registration No. 4366504. Opposer’s motion to amend is hereby granted.

Judgment is hereby entered against Opposer on the counterclaim of abandonment as to the following deleted goods and services:

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,

⁷ In addition, as Opposer notes in its reply brief, 18 TTABVUE 7-10, the Board has, in decisions subsequent to *Spirits Int’l B.V.*, followed an earlier Board decision, *Wet Seal, Inc. v. FD Mgt., Inc.*, 82 USPQ2d 1629, 1633 (TTAB 2007), wherein the Board determined that, where there is no bona fide intent to use a mark as to some, but not all, of the identified goods, registration is refused as to only those goods for which there is no bona fide intent to use the mark at issue. See *Syndicat Des Proprietaires Viticulteurs De Chateauf-neuf-Du-Pape v. Pasquier DesVignes*, 107 USPQ2d 1930, 1943 (TTAB 2013); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036, 1045 (TTAB 2012). Although not binding upon the Board, the United States Court of Appeals for the Sixth Circuit followed *Wet Seal* over *Spirits Int’l B.V.* on this issue. See *Kelly Servs., Inc. v. Creative Harbor, LLC*, 121 USPQ2d 1357, 1361-70 (6th Cir. 2017).

Further, where there is nonuse or abandonment as to some, but not all, the identified goods or services, the remedy is deletion of the goods at issue. Cf. *Grand Canyon West Ranch LLC v. Hualapai Tribe*, 78 USPQ2d 1696, 1697 (TTAB 2006) (“[A]s long as the mark [in a use-based application] was used on some of the identified goods or services as of the filing of the application, the application is not void in its entirety.”); *DAK Indus. Inc. v. Daiichi Kosho Co.*, 35 USPQ2d 1434, 1438 (TTAB 1995) (counterclaim of abandonment as to some, but not all, of the identified goods results in deletion of those abandoned goods).

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; 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 in International Class 9;

Games and toys, namely, action skill games, 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 in International Class 28; and

Education services, namely, providing live or on-line, classes, seminars, workshops, tutoring, mentoring in the field of computer programs and video games; arranging, organizing and conducting, live 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; 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 field of entertainment other than computer games in International Class 41.

Opposer's Section 2(d) claim in the opposition will go forward based on its pleaded registrations as amended during the pendency of this proceeding and Opposer's pleaded common law rights.

III. Proceedings resumed

Proceedings herein are resumed. Dates are reset as follows.

Answer to Counterclaim Due	11/19/2018
Deadline for Discovery Conference	12/19/2018
Discovery Opens	12/19/2018
Initial Disclosures Due	1/18/2019
Expert Disclosures Due	5/18/2019
Discovery Closes	6/17/2019
Pretrial Disclosures Due for Party in Position of Plaintiff in Original Claim	8/1/2019
30-day Trial Period Ends for Party in Position of Plaintiff in Original Claim	9/15/2019
Pretrial Disclosures Due for Party in Position of Defendant in Original Claim and in Position of Plaintiff in Counterclaim	9/30/2019
30-day Trial Period Ends for Party in Position of Defendant in Original Claim, and in Position of Plaintiff in Counterclaim	11/14/2019
Pretrial Disclosures Due for Rebuttal of Party in Position of Plaintiff in Original Claim and in Position of Defendant in Counterclaim	11/29/2019
30-day Trial Period Ends for Rebuttal of Party in Position of Plaintiff in Original Claim, and in Position of Defendant in Counterclaim	1/13/2020
Pretrial Disclosures Due for Rebuttal of Party in Position of Plaintiff in Counterclaim	1/28/2020
15-day Trial Period Ends for Rebuttal of Party in Position of Plaintiff in Counterclaim	2/27/2020
Opening Brief for Party in Position of Plaintiff in Original Claim Due	4/27/2020
Combined Brief for Party in Position of Defendant in Original Claim and Opening Brief as Plaintiff in Counterclaim Due	5/27/2020
Combined Rebuttal Brief for Party in Position of Plaintiff in Original Claim and Brief as Defendant in Counterclaim Due	6/26/2020

Rebuttal Brief for Party in Position of Plaintiff in Counterclaim Due	7/11/2020
Request for Oral Hearing (optional) Due	7/21/2020

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence.