

ESTTA Tracking number: **ESTTA1285619**

Filing date: **05/17/2023**

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

Proceeding no.	92076233
Party	Defendant Imagination Holdings Pty Ltd.
Correspondence address	JACQUELINE M LESSER ICE MILLER LLP 1735 MARKET STREET SUITE 3900 PHILADELPHIA, PA 19103 UNITED STATES Primary email: Jacqueline.Lesser@icemiller.com Secondary email(s): Barbara.Bacon@icemiller.com, ipdocket@icemiller.com 215-982-5165
Submission	Opposition/Response to Motion
Filer's name	Jacqueline M. Lesser
Filer's email	Jacqueline.Lesser@icemiller.com, Barbara.Bacon@icemiller.com, Robin.Lantz@icemiller.com, ipdocket@icemiller.com
Signature	/Jacqueline M. Lesser/
Date	05/17/2023
Attachments	Imagination Holdings Pty Ltd - Opposition to Renewed Motion to Compel - IMAGINATION.pdf(111452 bytes)

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

IMAGINATION GAMES, INC.,

Petitioner

v.

IMAGINATION HOLDINGS PTY LTD.,

Registrant.

Reg. No.: 4001241

Reg. Date: 07/26/2011

Mark: IMAGINATION

Cancellation No.: 92076233

OPPOSITION TO RENEWED MOTION TO COMPEL

Pursuant to TBMP 502.02(b), and the order of the Trademark Trial and Appeal Board (the “Board”), dated May 4, 2023 (23 TTABVUE), Registrant submits its opposition to Petitioner’s renewed Motion to Compel. (22 TTABVUE).

Petitioner’s renewed motion should be denied on grounds that it is mooted by the Director’s grant of Registrant’s amendment to its specification. (20 TTABVUE). Petitioner has stated that the basis for its cancellation action is nonuse abandonment of DVD products. 22 TTABVUE 1. That is not a dispute. Registrant has agreed that it no longer sells DVDs and accordingly has been granted an amendment of its registration.

Moreover, Petitioner’s renewed motion is procedurally deficient under 37 C.F.R. § 2.120(f) insofar as Petitioner has not indicated what issues are currently in dispute and what actions have been taken to resolve any outstanding issues without interference of the Board. Petitioner has not contacted Registrant’s counsel to discuss any purported remaining issues in dispute, and indeed, Registrant knows of no issues in dispute with respect to the discovery dispute.

Further, Petitioner claims in its recent renewed motion that it had discussed with Registrant’s counsel *two years ago* evidence of use on the amended goods and believed them to

be fabricated. 22 TTABVUE 2. There is no basis for Petitioner's comment (and none provided) to call into question Registrant's accepted specimens of use, which were submitted under sworn statement and showed contemporaneous use in commerce of Registrant's mark. However notably, Petitioner concedes that it has no further communications with Registrant's counsel leading up to this renewed motion.

Petition for Cancellation should be dismissed as it involves goods that are no longer the subject of the Registrant's existing registration. Petitioner's motion to compel should be denied, and its action dismissed.

Dated: May 17, 2023

Respectfully submitted,

ICE MILLER LLP

By: /s/ Jacqueline M. Lesser

Jacqueline M. Lesser
jacqueline.lesser@icemiller.com
1735 Market Street, Suite 3900
Philadelphia, PA 19103
Telephone: (215) 982-5165
Facsimile: (215) 982-5168

Attorney for Registrant
Imagination Holdings Pty Ltd.

CERTIFICATE OF SERVICE

I, Jacqueline M. Lesser, hereby certify that on May 17, 2023, a true and correct copy of the foregoing Opposition to Renewed Motion to Compel has been served by e-mail upon Counsel for Petitioner, Imagination Games, Inc. at jpearce@socalip.com; btamsut@socalip.com nabeloe@socalip.com; uspto@socalip.com.

/s/ Jacqueline M. Lesser