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

Proceeding	92076233
Party	Plaintiff Imagination Games Inc.
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**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.	Cancellation No. 92076233 Registration No. 4001241 Mark: IMAGINATION Registration date: July 26, 2011
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**PETITIONER’S OPPOSITION TO REGISTRANT’S REQUEST FOR AMENDMENT
OF REGISTRATION AND REQUEST FOR SANCTIONS**

Registrant abandoned its mark. Literally in its request for amendment of registration, Registrant admits that it is no longer using its mark in connection with the registered services, and yet asks the Board to improperly transmute its registration into a *different* set of goods so as to enable it to maintain its registration. In so doing, Registrant seeks to circumvent the normal registration process, to dramatically shift the coverage of the registration without any opportunity for opposition from third parties, not the least of which is Petitioner here, and to essentially circumvent the entire ordinary course of registration and this cancellation process by resetting the playing field mid-game to move its newly-proposed goods *closer* to Petitioner’s pending application.

This cancellation is about the mark IMAGINATION for goods of “Pre-recorded DVDs featuring computer games.” Registrant has no evidence of use for those goods. So, instead, and only after this petition was filed, it seeks this improperly broadening amendment to delay this proceeding and in an effort to save a registration it is aware is unsupported by use. The Board should deny Registrant’s request to amend registration. Based upon the materials submitted with that request, the Board should also cancel the registration for admitting non-use.

I. REGISTRANT'S OWN MOTION DEMONSTRATES THAT THE MARK HAS BEEN ABANDONED

The registration at issue is Registration No. 4001241 (the "Registration") for the mark IMAGINATION in class 009 for "Pre-recorded DVDs featuring computer game programs".

Registrant's counsel states in the motion,

"Registrant is a pioneer in the DVD gaming industry. *That technology has transformed into a video plus tactile game industry* with the evolution of technology to streaming services, from DVDs. Notably, *Registrant provides the same games through new technology. Registrant will separately file its Section 8*, but notably wishes to show the Board that the *updated technology replicates the content of the former specimen*" (9 TTABVUE emphasis added).

If we accept the above as true¹, then Registrant has admitted to not offering for sale Pre-recorded DVD's featuring computer game programs in commerce within the last three years and thus the Registration should be cancelled. Abandonment is the basic premise of Petitioner's cancellation and it is borne out in the Registrant's motion.

II. LEGAL STANDARD

Section 14 of the Trademark Act, 15 U.S.C. § 1064 provides for the cancellation of a registration if the registered mark has been abandoned. Under Section 45 of the Trademark Act, 15 U.S.C. § 1127, a mark is considered abandoned when "its use has been discontinued with intent not to resume such use." The provision further states,

"A mark shall be deemed to be 'abandoned' if either of the following occurs: (1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. 'Use' of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark." 15 U.S.C. § 1127.

¹ Counsel for Petitioner sincerely doubts this is true as the exhibits Respondent provided appear to be different and the application on the app store is not for an actual game from a DVD or otherwise, but appears to be merely a "buzzer" application that can be used with a physical game (e.g. class 28).

The party seeking their cancellation bears the burden of proving a prima facie case of abandonment by a preponderance of the evidence. *See On-Line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1476 (Fed. Cir. 2000); *Exec. Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1180-81 (TTAB 2016). Abandonment is a question of fact. *See Stock Pot Rest., Inc. v. Stockpot, Inc.*, 737 F.2d 1576, 222 USPQ 665, 667 (Fed. Cir. 1984). Proof of nonuse for three consecutive years, constitutes prima facie evidence of abandonment, because it supports an inference of lack of intent to resume use. Section 45 of the Trademark Act. *See also On-line Careline Inc. v. America Online Inc.*, 56 USPQ2d at 1476 (“The party seeking cancellation establishes a prima facie case of abandonment by showing proof of nonuse for three consecutive years.”); *Emergency One, Inc. v. American FireEagle, Ltd.*, 228 F.3d 531, 56 USPQ2d 1343 (4th Cir. 2000).

Here, Registrant has filed a paper with the Board under penalty of perjury and “declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.” (9 TTABVUE). The paper asserts that Registrant will be amending its Registrant to not cover DVD’s (indeed the only good and service the original application and Registration covered), and that Registrant will be filing a Section 8 affidavit. Section 8 affidavits are used to excuse nonuse and “include a verified statement attesting to the use in commerce or excusable nonuse of the mark within the period set forth in section 8 of the Act.” (TMEP 1604.05 *See* 37 C.F.R. §2.161). In essence, Registrant admits they have no use with DVD’s, and informs the Board they will be filing a section 8 affidavit if the Board approves this improper amendment. These admissions present a prima facie case, by a preponderance of the evidence, that the Registration is invalid, and the Board should cancel it.

III. THE PROPOSED AMENDMENT IS IMPROPERLY BROADENING

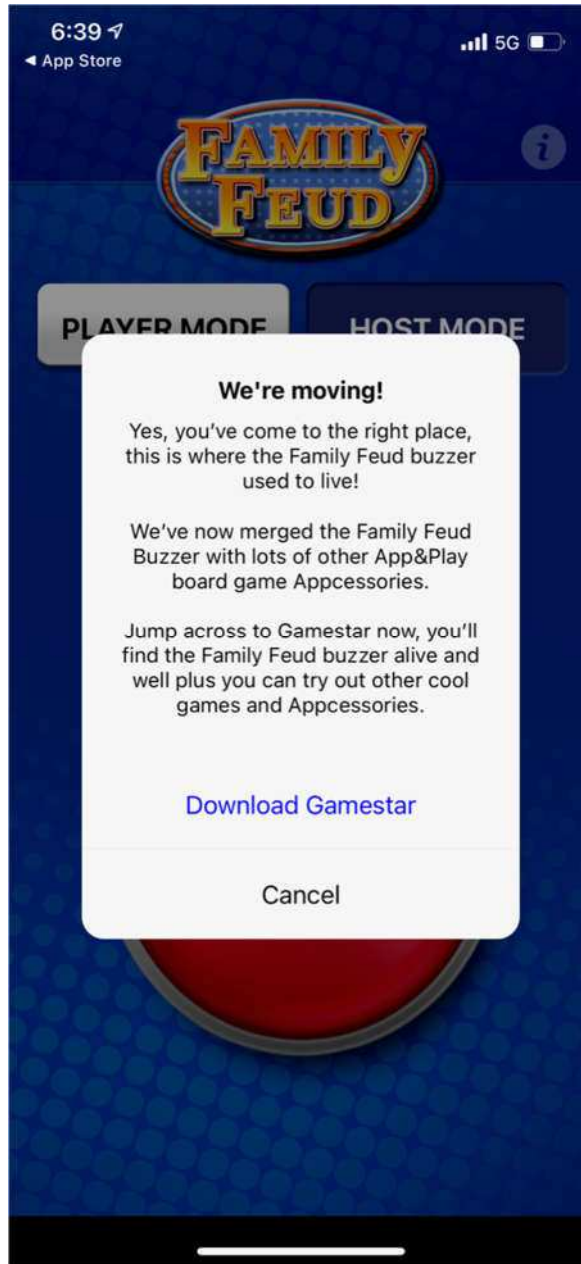
Section 7 amendment is generally only available for amendments that either delete or narrow goods and services. “Specifically, the holder of a registered extension of protection may file a request with the USPTO to amend the registered extension of protection to limit or partially surrender goods and/or services.” (TMEP §1609.03). Furthermore, “[i]n registrations based on applications under §§1 and 44 of the Trademark Act, amendments may be made to the identification of goods/services to restrict the identification or otherwise to change it in ways that would not require republication of the mark. However, goods/services may not be added to a registration by amendment. *Id. See* 37 C.F.R. §2.173(e).” This is true even for changes brought about by technology “[c]hanged circumstances (e.g., new technology) will not render acceptable an amendment that is not otherwise permissible. *See In re Capp Enterprises, Inc.*, 32 USPQ2d 1855 (Comm’r Pats. 1993); *In re Fortex Industries, Inc.*, 18 USPQ2d 1224 (Comm’r Pats. 1990); *In re Carter Hawley Hale Stores, Inc.*, 200 USPQ 179”. *Id.* The TMEP even directly addresses issues similar to this case “For example, if the goods in the registration are identified as ‘phonograph records,’ the identification of goods cannot be amended to ‘compact discs.’ of changes to technology” *See* TMEP § 1609.03. Here Registrant is trying to broaden the goods and services description:

Current Goods and Services	Proposed Goods and Services
<u>Class 009</u> Pre-recorded DVDs featuring computer game programs	<u>Class 009</u> Downloadable apps for games <u>Class 042</u> interactive games available for streaming, composed of a non-downloadable apps accessories, used with or without a physical board game or card accessories

The addition of a completely separate class 042, and the total mutilation of goods and services in class 009 is clearly invalid under current law. Petitioner's motion should be denied on this ground alone.

IV. THE REGISTRANT'S POSITION SHOULD BE SUBJECT TO CROSS-EXAMINATION

On a more basic level, the Registrant's positions should be tested. Loading the application to which Registrant points out to the Board in claiming use causes the following screen to be displayed:



As far as Petitioner is aware, Gamestar is not affiliated with the Registrant. As should be appreciated by the Board, the “Family Feud” game is provided under license. Gamestar is likely the new licensee, as opposed to the Registrant. When Petitioner sought to purchase the DVD and/or board game online, only resellers of “used” DVD games were found. That Petitioner once sold a DVD game many years ago does not mean that it has not ceased use now. Likewise, Registrant is making an affirmative use-based claim that the mark is currently in use on an app

that, upon loading, immediately pops up a notice to use a different app. This appears again to not actually be current use of the mark, even in connection with the improperly broadened goods sought through amendment by the Registrant. If nothing else, Petitioner should be afforded the opportunity to explore both the prior use, if any, and the alleged ongoing use of the Registered mark in connection with all of these services, any associated licenses, their terms – are they expired? – and what other use that Registrant may have. Because Petitioner has been afforded no opportunity to cross examine the Registrant’s claims, the Board should deny this motion as well.

V. THIS MOTION IS PREMATURE

Even if the Board were to conclude that amendment is proper – which it is not – the Parties are in the midst of a cancellation. Registrant seeks to short-circuit the entire process, precluding any discussion of their abandonment, which seems incredibly likely in view of the declarations and other documents filed in Registrant’s motion, or the support underlying the alleged use in connection with an application and/or non-downloadable application. At a minimum, Petitioner is entitled to inquire as to the use of the registered goods, the use of the proposed goods and services, and the extent and kind of that use. Registrant seeks to foreclose all of that process at the outset by resetting the table before the baseline set of facts have been established and before Petitioner has any opportunity to discover those facts.

Petitioner has served requests for production, and requests for admissions to Registrant to which it has not yet responded. Those responses are due May 9, 2021 and May 16, 2021. Based upon the Registrant’s refusal to share any evidence of use outside of the formalities of discovery, and the poor evidence of use provided even in support of the instant motion, Petitioner expects that Registrant has no evidence of use. So, the discovery process in this matter may require some effort to adduce those facts. Three months after filing this cancellation, that Registrant submits only the barest of materials in support of its motion, and none that actually appears to include

trademark use of the mark IMAGINATION on even the proposed amended goods is telling about the level of support for use that discovery will produce.

VI. CONCLUSION

Registrant should not be allowed to game the system by entirely circumventing the registration process through amendment of a Registration for a mark that is no longer in use. Registrant's deceptive attempt at filing a request for amendment for a registration that is clearly invalid for nonuse should not be rewarded. Petitioner respectfully requests that the motion be denied because (1) the motion impermissibly broadens the goods and services description of the Registration, (2) even the specimen submitted by Registrant fails to use the mark or fails to demonstrate current use of the mark since it is a deprecated app that points to the application of another entity, and (3) the motion is premature. Furthermore, because facts asserted and sworn to in Registrant's own motion demonstrate abandonment, Petitioner further requests that the Registration be cancelled. The Board should order Registrant to immediately produce all evidence showing use with the mark in connection with the registered DVD goods in the past five years. If Registrant cannot show use of the registered goods, then the Petitioner will file its anticipated motion for summary judgment.

May 7, 2021

Respectfully submitted,

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Imagination Games Inc. ,
Petitioner,
v.
Imagination Holdings Pty Ltd.
Registrant.

Cancellation No. 92076233
Registration No. 4001241
Mark: IMAGINATION
Registration date: July 26, 2011

Certificate of Service

I hereby certify that on May 7, 2021, I served a true and complete copy of the foregoing “PETITIONER’S OPPOSITION TO REGISTRANT’S REQUEST FOR AMENDMENT OF REGISTRATION AND REQUEST FOR SANCTIONS” on attorneys for Registrant by forwarding a copy by email to:

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May 7, 2021

/s/ Anneliese Lomonaco
Anneliese Lomonaco