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

Proceeding	91193133
Party	Defendant Revell, Graeme C., Revell, Ashley M.
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Signature	/Manali V. Dighe/
Date	01/26/2010
Attachments	65846-1001 Answer .Counterclaim.pdf (12 pages)(113727 bytes)

Registration Subject to the filing

Registration No	3264264	Registration date	07/17/2007
International Registration No.	NONE	International Registration Date	NONE
Registrant	Piggyback Interactive Limited 5 Westmont Court, Monmouth Road London, W2 4UU UNITED KINGDOM		

Goods/Services Subject to the filing

<p>Class 009. All goods and services in the class are requested, namely: Computer games, namely, computer game software, computer game programs; electronic game programs; games adapted for use with television receivers and computers, namely, computer game software for use with computers and video games for use with televisions; [apparatus for games adapted for use with television, namely, computer game joysticks and handheld joystick units for playing video game machines for use with television; game machines, namely, video game machines for use with televisions;] video games in the form of CD-ROMS, video games, namely, video game cartridges, [video game discs, apparatus for playing hand held video games, namely, video game joysticks for playing hand held games]; computer software for use in connection with games; and downloadable electronic publications, namely, books, magazines and manuals in the fields of computer games, computers, software, video games and entertainment</p>
<p>Class 016. All goods and services in the class are requested, namely: Printed matter, namely, printed guides, [newspapers, periodical publications, magazines,] books; and instructional and teaching materials, all the aforesaid relating to computer games; [photographs, pictures, prints; posters; greeting cards; postcards; note pads; address books; scrapbooks; folders; catalogues in the field of computer games; printed tickets;] calendars; [photographs albums; diaries;] booklets in the field of computers; [sleeves for holding and protecting postage stamps; stamp albums;] stickers; car stickers; [decalomania; blank cards and business cards; cardboard articles, namely, cardboard, cardboard packaging, cardboard boxes; stationery, pens, pencils, erasers, pencil sharpeners, pencil cases, rulers, namely, drafting rulers and drawing rulers; boxes for pens,] bookmarks; [drawing materials for blackboards, artist's materials, namely, artists' pens, artists' brushes, artists' pastels, artists'</p>

pencils; printed gift bags; carrier bags, namely, cardboard carrier bags, paper carrier bags; envelopes; blackboards; printed height charts; coasters made of papers and tablemats made of paper]

Class 041.

All goods and services in the class are requested, namely: Entertainment services;, namely, providing on-line computer games and on-line non-downloadable interactive games; providing on-line interactive computer games that may be accessed from databases or websites on the Internet; publication of books and other publications, namely, journals, brochures, [newspapers and periodicals] relating to computer games, computer game software, computer game software in the nature of video games, and interactive multimedia computer game programs

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

Piggyback Interactive Limited, Opposer, v. Graeme C. Revell and Ashley M. Revell, Applicants.	Opposition No.: 91193133 Application Serial No.: 77/525,392 Mark: PIGGEEBACK Published for Opposition: June 30, 2009 Atty. Ref. No.: 65846-9001
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Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

APPLICANTS' ANSWER TO NOTICE OF OPPOSITION AND APPLICANTS'
COUNTERCLAIM AGAINST OPPOSER

Applicants, Graeme C. Revell and Ashley M. Revell ("Applicants"), the owners of the above-referenced application, Serial No. 77/525,392 (the '392 application), by and through their attorneys, hereby submit their Answer to the Notice of Opposition filed by Piggyback Interactive Limited ("Opposer"). Unless indicated differently, each paragraph below corresponds with the paragraph of the Notice of Opposition bearing the same number. To the extent any unnumbered paragraphs, captions or headings in the Notice of Opposition are treated as allegations, such allegations are hereby denied.

1. Applicants lack sufficient knowledge and information regarding the allegations contained in Paragraph 1 of the Notice of Opposition to admit or deny and, on that basis, deny each and every allegation contained therein.

2. Applicants admit that U.S. Reg. No. 3,264,264 in all respects speaks for itself.

3. Applicants lack sufficient knowledge and information regarding the allegations contained in Paragraph 3 of the Notice of Opposition to admit or deny and, on that basis, deny each and every allegation contained therein.

4. Applicants lack sufficient knowledge and information regarding the allegations contained in paragraph 4 of the Notice of Opposition to admit or deny and, on that basis, deny each and every allegation contained therein.

5. Denied.

6. Applicants lack sufficient knowledge and information regarding the allegations contained in Paragraph 6 of the Notice of Opposition to admit or deny and, on that basis, deny each and every allegation contained therein.

7. Denied.

8. Denied.

9. Admitted.

10. Denied.

11. Denied.

12. Denied.

13. Denied.

AFFIRMATIVE DEFENSES

In addition to the foregoing, and as separate and distinct affirmative defenses to Opposer's claims, Applicants allege as follows:

FIRST AFFIRMATIVE DEFENSE

Opposer's Notice of Opposition is barred because Opposer has failed to state facts upon which the underlying relief may be granted.

SECOND AFFIRMATIVE DEFENSE

Opposer's Notice of Opposition is barred because the registration asserted by Opposer in support of its Opposition is invalid and/or unenforceable as it was filed and/or maintained fraudulently. On information and belief, Opposer did not have a bona fide intent to use the mark with all of the goods and services identified in the application as filed even though Opposer alleged 15 U.S.C. § 1051 (b) as a basis for filing. Moreover, as of the date of this Answer and Counterclaim, on information and belief, Opposer is not using the registered mark on all of the goods and services identified in the registration.

FURTHER AFFIRMATIVE DEFENSE

Applicants are without sufficient information to know at the present time whether additional affirmative defenses may be applicable to this action. Accordingly, Applicants expressively reserve the right to assert further affirmative defenses should they learn that any such defenses are available.

WHEREFORE, Applicants respectfully request that the Notice of Opposition be denied, that judgment be entered in favor of Applicants granting registration of PIGGEEBACK as shown in Application Serial No. 77/525,392.

COUNTERCLAIM

For their counterclaim in this action, Applicants/Counterclaimants Graeme C. Revell and Ashley M. Revell allege as follows:

Applicants/Counterclaimants believe they will be damaged by the continued registration of PIGGYBACK U.S. Trademark Registration No. 3,264,264 (the '264 Registration) for which the owner of record is identified as Piggyback Interactive Limited (Opposer/Counterdefendant). Applicants hereby petition for cancellation of said registration.

As grounds for cancellation, it is alleged that:

1. Opposer filed U.S. Trademark Application Serial No. 78/427,793 that issued to the '264 Registration on June 1, 2004 solely as an intent-to-use application under 15 U.S.C. § 1051(b) for the following goods and services: computer games; electronic games; games adapted for use with television receivers and computers; apparatus for games adapted for use with television receivers and computers; game machines, video machines; cd roms; video games; hand held video games; apparatus for playing hand held video games; coin operated games; computer hardware; computer software in Int. Cl. 9; printed matter, newspapers, periodical publications, magazines, books; instructional and teaching materials, all the aforesaid relating to computer games; photographs, pictures,

prints; posters; greeting cards; postcards; note pads; address books; scrapbooks; folders; catalogues; tickets; calendars; photograph albums; diaries; booklets; postage stamps; covers for postage stamps; stamp albums; stickers; car stickers; decalcomanias; cards; cardboard articles; stationery, pens, pencils, erasers, pencil sharpeners, pencil cases, rulers, boxes for pens, book markers; drawing materials, artist's materials; gift bags, carrier bags; envelopes; blackboards; height charts; coasters; table mats, in Int. Cl. 16; and entertainment services; entertainment services, games, interactive games, video games, provided on-line from databases or websites on the internet; publication of books and other publications relating to computer games; telecommunication of information (including web pages), computer programs and other data; electronic mail services; electronic delivery of software, information, data or publications; provision of telecommunications access and links to computer databses and internet, intranets or extranets; information, advisory and consultancy services, all relating to the aforesaid services, in Int. Cl. 41.

2. On information and belief, Opposer did not have a bona fide intent to use PIGGYBACK in connection with all of the goods and services identified in the application as filed at the time of filing the application, and thus obtained the '264 fraudulently.

3. To file an application under 15 U.S.C. § 1051(b), the applicant must have a bona fide intention to use the applied-for-mark in connection with all of the goods and services indentified in the application as filed.

4. Opposer filed the application only under 15 U.S.C. § 1051(b) on June 1, 2004. Opposer's registration was obtained fraudulently in that the formal application papers filed under oath it was stated that the applicant [Opposer] has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. The statement was made by an authorized agent of the Opposer with the knowledge and belief that the statement was false. The false statement was made with the intent to induce authorized agents of the U.S. Trademark Office to grant the registration, and, reasonably rely upon the truth of the false statements. The U.S. Trademark Office did, in fact, grant the registration to the Opposer.

5. Opposer added the 44(d) filing basis on June 17, 2004, based upon a foreign registration apparently filed on April 29, 2004. On November 29, 2006, Opposer added section 44(e) as a basis for registration, based upon a foreign registration that apparently issued in the European Community on December 21, 2005. The section 1(b) basis was maintained. On January 22, 2007, the Examiner issued an Examiner's Amendment, indicating that no statutory bars to registration exist, and reciting some amendments to the goods/services authorized by Opposer's attorney. Incidentally, that very same day, less than two hours later, Opposer's attorney authorized the Examiner to delete the section 1(b) basis and rely solely on the 44(e) basis for registration. On information and belief, since Opposer did not have a bona fide intent to use PIGGYBACK in connection with all of the goods/services in the application as filed, Opposer could not eventually

provide evidence of use of PIGGYBACK, should the application proceed to publication with the section 1(b) basis. Rather than delete those goods/services that Opposer did not have a bona fide intention to use PIGGYBACK in connection with prior to registration, Opposer decided to delete the section 1(b) basis so that the application could proceed to immediate registration based on the section 44(e) basis.

6. Therefore, on information and belief, Opposer's registration was obtained fraudulently, and, on that basis, should be cancelled.

7. On information and belief, Opposer has abandoned PIGGYBACK insomuch as it has not used PIGGYBACK in U.S. interstate commerce within a reasonable time after obtaining the '264 Registration.

8. Although it is not necessary for a Section 44 applicant to use the mark in U.S. interstate commerce in order to obtain a registration, it is necessary that within a reasonable time thereafter, the foreign applicant use the mark in U.S. interstate commerce. Thus, if a foreign registrant does not use the mark in the U.S. within a reasonable time, the registration is subject to cancellation on the ground of abandonment. Under the Lanham Act, non-use for three consecutive years is prima facie evidence of abandonment and is an evidentiary basis for the required use within a "reasonable time" after registration by a foreign resident.

9. The '264 Registration issued on July 17, 2007. Opposer filed a Section 7 amendment of registration on October 5, 2009, and an updated Registration Certificate based on the Section 7 amendment issued on December 22, 2009 having the following goods and services: computer games namely computer game software, computer game programs; electronic game programs; games adapted for use with television receivers and computers namely computer game software for use with computers and video games for use with televisions; video games in the form of CD-ROMS, video games, namely video game cartridges; computer software for use in connection with games; and downloadable electronic publications, namely, books, magazines and manuals in the fields of computer games, computers, software, video games and entertainment, in Int. Cl. 9; printed matter, namely printed guides, books, and instructional and teaching materials, all the aforesaid relating to computer games; calendars; booklets in the field of computers; stickers; car stickers; bookmarks, in Int. Cl. 16; and entertainment services; namely providing on-line computer games and on-line non-downloadable interactive games; providing on-line interactive computer games that may be accessed from databases or websites on the Internet; publication of books and other publications namely journals and brochures relating to computer games, computer game software, computer game software in the nature of video games, and interactive multimedia computer game programs, in Int. Cl. 41.

10. On information and belief, as of the date of this Answer and Counterclaim, Opposer is not using PIGGYBACK in connection with all of the goods and services

identified in the '264 Registration as issued on July 17, 2007, or as re-issued on December 22, 2009.

11. Therefore, on information and belief, Opposer's registration has been abandoned at least in part, and, on that basis, should be cancelled.

12. On information and belief, Opposer's alleged mark PIGGYBACK in the '264 Registration has not acquired secondary meaning and/or has not become distinctive of Opposer's goods and services in commerce, as Opposer's alleged mark is not used as a trademark in connection with all of the goods/services identified in the registration at the date of this Answer and Counterclaim.

13. Applicants believe they will be harmed by the continued registration of the '264 Registration. Applicants have a pending application, the '392 application, for PIGGEEBACK, in connection with computer e-commerce software to allow users to perform electronic business transactions in a globally integrated television, cable, film, videogame, internet, mobile phone, PDA and remote control environment, in Int. Cl. 9. Applicants' legal use and registration of its mark PIGGEEBACK, which is the subject of Opposer's Opposition, will be impaired by the continued registration of Opposer's mark, and thus, Applicants believe they will be damaged by the continuance of the registration.

14. If the Opposer is allowed to maintain the '264 Registration, it would thereby continue to maintain at least a *prima facie* exclusive right to use the PIGGYBACK mark.

Such a registration is and continues to be a source of damage and injury to Applicants as the mark was procured by fraud, has been abandoned, and has not achieved distinctiveness and/or secondary meaning. Therefore, Opposer's mark should not be maintained on the Register.

WHEREFORE, and in accordance with Section 14 of the Trademark Act, Applicant prays that this Counterclaim be sustained and that the '264 Registration for the mark PIGGYBACK be cancelled.

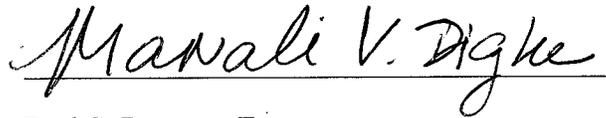
The Commissioner is hereby authorized to charge the required fee to Deposit Account No. 10-0440. Please charge any deficiency or credit any overpayments to Deposit Account No. 10-0440.

This Answer and Counterclaim is being filed by the undersigned attorney at law, duly authorized to represent Applicants in this proceeding pursuant to C.F.R. § 2.106.

Please recognize the undersigned Rod S. Berman, Esq., Attorney at Law admitted to practice before the highest court of the State of California, as Applicants' attorney of record in the above-referenced opposition. Please direct correspondence to the undersigned.

Respectfully submitted,

Dated: January 26, 2010



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CERTIFICATE OF SERVICE

It is hereby certified that on January 26, 2010, a copy of the foregoing APPLICANTS' ANSWER TO NOTICE OF OPPOSITION has been sent by first class mail, postage prepaid to the attorney of record for Opposer:

Mark H. Tidman
Baker & Hostetler LLP
1050 Connecticut Avenue,
N.W. Washington Square
Suite 1100
Washington, DC 20036

Dated: January 26, 2010

Mark H. Tidman

By: