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

Proceeding	91198929
Party	Defendant Resorb Networks, Inc.
Correspondence Address	RESORB NETWORKS, INC. RESORB NETWORKS, INC. 8 HEATHCOTE AVE EDISON, NJ 08817-4706 root@resorb.net
Submission	Answer
Filer's Name	Robert John Ianuale
Filer's e-mail	root@resorb.net
Signature	/Robert John Ianuale/
Date	04/18/2011
Attachments	Facepiles_answer3.pdf (11 pages)(189247 bytes)

internet users choose to use Facebook, and some internet users may be unfamiliar with Opposer.

2. Admitted.

3. Admitted.

4. Admitted.

5. Admitted.

6. Admitted.

7. Admitted.

8. Admitted.

9. Admitted.

10. Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 10, and consequently denies same.

11. Admitted.

FACEBOOK'S MARKS

12. Admitted.

13. Admitted.

14. Admitted.

15. Admitted.

16. Admitted.

17. Admitted.

18. Admitted.

19. Admitted.

20. Admitted.

21. Admitted.
22. Admitted.
23. Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 23 of Opposer's Notice of Opposition, and consequently denies same.
24. Denied.
25. Admitted.
26. Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 26, and consequently denies same.
27. Denied.
28. Denied.
29. Denied.

RESORB'S USE AND APPLICATION FOR THE FACEPILES MARK

30. Admitted.
31. Admitted.
32. Denied. The services covered by Resorb's FACPILES application substantially differ from the services provided by Facebook. Applicant's product offerings do not overlap with Opposer's product offerings.
33. Denied. Applicant's target market does not overlap with Opposer's market; a sizeable market exists for companies whose products and services do not overlap and are substantially different.
34. Denied.
35. Admitted.

36. Denied.

37. Denied.

38. Denied.

39. Denied.

40. Denied.

41. Denied.

FIRST GROUND FOR OPPOSITION: FAILURE TO USE MARK WITH ALL CLAIMED SERVICES

42. Applicant incorporates its responses to the allegations contained in Paragraphs 1 through 41, inclusive.

43. Applicant admits the allegations in Paragraph 43 of Opposer's Notice of Opposition

44. Admitted.

45. Denied.

46. Denied.

47. Denied.

**SECOND GROUD FOR OPPOSITION:
LIKELIHOOD OF CONFUSION**

48. Applicant incorporates its responses to the allegations contained in Paragraphs 1 through 47, inclusive.

49. Denied.

50. Denied.

51. Admitted.

52. Denied. Opposer fails to provide any evidence to support its belief that Applicant chose the FACEPILES mark with the intent to deceive or create confusion.

53. Denied. Opposer fails to demonstrate or provide evidence for its belief that consumers will actually be confused in the marketplace.

54. Denied.

55. Denied.

56. Admitted.

57. Denied.

58. Denied.

**THIRD GROUND FOR OPPOSITION:
DILUTION OF A FAMOUS MARK**

59. Applicant incorporates its responses to the allegations contained in Paragraphs 1 through 58, inclusive.

60. Denied.

61. Admitted.

62. Admitted.

63. Admitted.

64. Admitted.

65. Admitted.

66. Denied. Applicant notes that marks containing the word “face,” specifically in the field of internet-related networking, became famous before Opposer’s existence and Opposer’s first use of the mark FACEBOOK.

67. Denied.

68. Denied.

69. Denied.

70. Denied.

AFFIRMATIVE DEFENSES:

Applicant asserts the following affirmative defenses to Opposer's Notice of Opposition:

1. The Notice of Opposition fails to state any claim upon which relief may be granted.

Opposer does not enjoy priority over the use of the mark FACEPILES; Applicant had been using the mark in commerce since January 2010. It conducted marketing with the mark in forums, used the mark during the Beta-testing stage of the FACEPILES service, and contacted potential advertisers using the FACEPILES brand. Because of these uses, and as a result of settlement negotiations between Applicant and Opposer over the mark, Opposer was aware of Applicant's intended use of the mark in commerce.

2. There is no likelihood of confusion, mistake or deception because Applicant's and Opposers's marks are not confusingly similar. There are significant differences in appearance, sound, and consumer use between their respective marks. Consumers are not likely to confuse FACEPILES with FACEBOOK. FACEPILES is a video rating service that contains social networking ability. FACEBOOK is not a video rating service.

Consumers with an interest in Applicant's product are likely to be aware of the FACEBOOK mark, and are likely to be aware that applicant's FACEPILES mark does not

originate with, nor is associated with, Opposer's mark. Consumers are unlikely to believe that every mark containing the "face" prefix denotes an association with Opposers, as precedents exist demonstrating that not all marks containing the "face" prefix are associated with Opposer.

3. Opposer's marks are descriptive and/or generic with respect to the services for which they are utilized.
4. Opposer will not be damaged by the registration of Applicant's mark. The registration of the mark FACEPILES will not dilute or tarnish the FACEBOOK mark. Opposer fails to provide any evidence that the registration of the FACEPILES mark will dilute its marks. Applicant is a well-known and highly respected software company, not a company whose primary business is offering sexually themed software applications. On the contrary, Applicant's primary business focus is creating custom software and interactive internet applications for clients, including web-sites, hosting, search optimization, dedicated servers, and marketing.

Furthermore, Applicant strongly disagrees with Opposer's patently false and malicious description of applicant's services in Paragraphs 67, 68, and 69. Applicant requests that the Board take notice of Opposer's gratuitous denigration of Resorb Networks, a reputable and highly respected company that has conducted business worldwide since 1999. It has been firmly established as a media presence, and is highly regarded for its wide variety of services and consumer products.

Applicant further requests that the Board take notice of Opposer's history of trademark bullying in its penchant for using the court system, the United States Patent and Trademark Office, and the TTAB to stifle competition by opposing marks that are not likely to be confused

with nor dilute its marks. Opposer's wasting of taxpayer dollars and abuse of the court system should no longer be countenanced.

Opposer, by opposing nearly every registration that contains the words "face" and "book," is attempting to monopolize these generic terms and remove them from the public domain. Opposer has instituted unjustified trademark litigation against Lamebook LLC, Teachbook.com LLC, Femillionaires LLC, Vision Promotions, Inc., Applicant, and many others. Opposer has never used the word "face" in the context of a trademark apart from the word "book." The words "face" and "book" have been used in registered trademarks with the USPTO for decades before Opposer's existence. Opposing nearly every use of "face" and "book," generic words which can never acquire trademark protection, constitutes a callous disregard for the TTAB's resources and of taxpayer dollars.

COUNTERCLAIMS

Resorb Networks, Inc., a New York corporation organized and existing under the laws of New York, having its place of business at 303 W 42nd St., Suite 608, New York, NY 10036, has been and believes it will continue to be damaged by the continued registration of the mark shown in United States Trademark Registration No. 85261643, and hereby seeks cancellation of this registration. In addition, Resorb has been damaged, and will continue to be damaged, by the blatant and continued use by Opposer of the proposed mark shown in United States Trademark Serial 85261643. As grounds for such cancellation, Resorb alleges the following:

FIRST COUNTERCLAIM:

FRAUDULENT REGISTRATION

1. Opposer's allegation that Applicant lacks priority over the FACEPILES mark due to Opposer's prior use and attempted registration of the mark FACEPILE is premised upon Opposer's fraudulent use and registration of said mark.
2. Applicant delayed its launch of the FACEPILES service and its accompanying use of said mark due to settlement negotiations between Applicant and Opposer. Opposer thus knowingly submitted an application for the FACEPILE mark with the intent to co-opt Applicant's ability to use the mark and to infringe upon Applicant's mark.
3. Opposer knowingly submitted a fraudulent trademark application, as Opposer was aware of Applicant's FACEPILES mark, and therefore Opposer's signing of its trademark application declaration was false and constitutes fraud in obtaining a trademark registration.
4. Opposer's March 8, 2011 registration of the FACEPILE mark was thereby fraudulent. Opposer's opposition should be dismissed as a result of its fraud, and Opposer's 85261643 mark should be cancelled.

SECOND COUNTERCLAIM: REVERSE CONFUSION

1. Opposer, based upon information and belief, attempts to cause reverse confusion between its FACEPILE mark and Applicant's FACEPILES mark. Applicant is the senior user and enjoys priority over the FACEPILES mark as a result of its prior and intended use in commerce. Opposer's use of the FACEPILE mark is an unlawful attempt to confuse consumers into believing that FACEPILES infringes upon Opposer's marks.

2. Opposer, the junior user, attempts to claim Applicant's mark as its own by confusing consumers into associating FACEPILES with FACEBOOK. Such trademark bullying, where a more powerful junior user attempts to crush a small senior user through reverse confusion, is a violation of trademark law precedent as recognized by the TTAB and federal courts.

Requested Relief

1. Wherefore, Applicant respectfully prays that this Opposition be dismissed with prejudice.
2. Applicant prays that Application Serial No. 85/026,924 be granted and that applicant be issued an unrestricted registration on the Principal Register for its mark.
3. Applicant prays that Serial Number 85261643 be cancelled and removed from the Principal Register.
4. Applicant is granted such other relief as the Board deems just and equitable under the circumstances.

Respectfully submitted,

Dated: April 18, 2011

/Daniel R. Goodman ___ /
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Attorney for Applicant
Resorb Networks, Inc.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of APPLICANT'S ANSWER, AFFIRMATIVE DEFENSES AND COUNTERCLAIMS TO NOTICE OF OPPOSITION was served upon counsel for Petitioner via electronic mail and first class mail to:

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Dated: April 19, 2011

/Daniel Goodman _____/
Daniel Goodman