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

Proceeding	91204345
Party	Plaintiff Studio Moderna S.A.
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Date	05/25/2012
Attachments	Answer to Counterclaim.pdf ( 6 pages )(18482 bytes )

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

In the Matter of Application Serial No. 85/319,799

**BIG FISH**

International Classes: 9, 38 and 41

Published in the *Official Gazette* of September 20, 2011

and

Registration Serial No. 3,936,214

**BIGFISH**

International Classes: 35, 41

Registered: March 29, 2011

STUDIO MODERNA SA, )  
)  
Opposer, )

v. )

BIG FISH GAMES, INC., )  
)  
Applicant. )

Opposition No.: 91/204,345

**OPPOSER AND  
COUNTERDEFENDANT STUDIO  
MODERNA SA'S ANSWER TO  
COUNTERCLAIM FOR  
CANCELLATION OF ASSERTED  
REGISTRATION**

\_\_\_\_\_ )  
)  
BIG FISH GAMES, INC., )  
)  
Counterclaimant, )

v. )

STUDIO MODERNA SA, )  
)  
Counterdefendant. )

\_\_\_\_\_ )

Opposer and counterdefendant Studio Moderna SA (“Studio Moderna”) hereby answers the Counterclaim included in the Answer to Notice of Opposition and Counterclaim for Cancellation of Asserted Registration (the “Counterclaim”) filed by applicant and counterclaimant Big Fish Games, Inc. (“BFG”) on April 25, 2012 as follows, wherein numbered paragraphs correspond to like numbered paragraphs in the Counterclaim.

As to the initial unnumbered paragraph at the start of the Counterclaim, Studio Moderna admits that: (a) it has opposed BFG’s application to register the mark BIG FISH, Serial No. 85/319,799, under Section 2(d) of the Trademark Act; (b) its Notice of Opposition relies upon, *inter alia*, Registration No. 3,936,214 (the “’214 Registration”) for the trademark “BigFish,” issued on the Principal Register to Studio Moderna on March 29, 2011; and (c) the ’214 Registration covers (i) “[o]n-line retail store services in the field of cycling, featuring bicycles; providing on-line advertising in the fields of bicycles and cycling; providing on-line consumer information regarding bicycles and cycling gear,” in International Class 35, and (ii) “[p]roviding on-line information regarding cycling and bicycle racing, for entertainment, recreation or as a sport,” in International Class 41. Studio Moderna denies the remaining allegations of the initial unnumbered paragraph, and in particular but without limitation denies that (a) BFG has priority over the priority date of the ’214 Registration, (b) the ’214 Registration is invalid, and (c) the ’214 Registration should be cancelled.

1. Studio Moderna is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 1 of the Counterclaim and therefore denies the same.

2. Answering the allegations of paragraph 2 of the Counterclaims, Studio Moderna denies that BFG holds registrations for “BIG FISH Marks”; BFG’s cited registrations are all for word marks or design marks containing the term “BIG FISH GAMES.” Studio Moderna admits

that the Certificate of Registration for the '214 Registration states a date of first use of May 2006. Studio Moderna is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations of paragraph 2 of the Counterclaim and therefore denies the same.

3. Studio Moderna is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 3 of the Counterclaim and therefore denies the same.

4. Answering the allegations of paragraph 4 of the Counterclaims, Studio Moderna admits that the marks, registration numbers, registration dates, and goods/services set forth in the table included in that paragraph accurately reflect the information provided on the Certificates of Registration issued by the United States Patent & Trademark Office and attached collectively as Exhibit A to the Counterclaim. Studio Moderna is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations of paragraph 4 of the Counterclaim and therefore denies the same.

5. Answering the allegations of paragraph 5 of the Counterclaims, Studio Moderna denies that BFG holds registrations for "BIG FISH Marks"; BFG's cited registrations are all for word marks or design marks for "BIG FISH GAMES." Studio Moderna is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations of paragraph 5 of the Counterclaim and therefore denies the same.

6. Answering the allegations of paragraph 6 of the Counterclaims, Studio Moderna denies that BFG holds registrations for "BIG FISH Marks," that it has acquired goodwill in the mark "BIG FISH," or that the mark "BIG FISH" is known to indicate, or recognized as indicating, source exclusively in BFG; BFG's cited registrations are all for word marks or design marks for "BIG FISH GAMES." Studio Moderna is without knowledge or information

sufficient to form a belief as to the truth of the remaining allegations of paragraph 6 of the Counterclaim and therefore denies the same.

7. Answering the allegations of paragraph 7 of the Counterclaims, Studio Moderna admits that in paragraph 5 through 7 of its Notice of Opposition, it alleges, *inter alia*, a likelihood of confusion and a likelihood of dilution between, *inter alia*, the '214 Registration and the BIGFISH mark, Serial No. 85/319,799, as to which BFG seeks registration based upon an intent-to-use application. Studio Moderna denies the remaining allegations of paragraph 7 of the Counterclaim, and in particular but without limitation denies that BFG holds registrations for "BIG FISH Marks."

As to a final unnumbered paragraph, Studio Moderna acknowledges BFG's request but denies that the '214 Registration should be cancelled.

#### **AFFIRMATIVE DEFENSES**

8. The Counterclaim fails to state a claim upon which relief may be granted.
9. The Counterclaim is barred by laches and acquiescence.
10. BFG waived its claims.
11. BFG is estopped from asserting its claims.

12. BFG's claims are barred due to unclean hands.

WHEREFORE, having fully answered, Studio Moderna requests that the Counterclaim be dismissed with prejudice.

Respectfully submitted,

Date: May 25, 2012

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**CERTIFICATE OF SERVICE**

I hereby certify that I served a true copy of the foregoing OPPOSER AND COUNTERDEFENDANT STUDIO MODERNA SA'S ANSWER TO COUNTERCLAIM FOR CANCELLATION OF ASSERTED REGISTRATION to the following attorneys via U.S. mail at the postal address set forth below.

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Date: May 25, 2012

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