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

Proceeding	92051532
Party	Plaintiff PictureCode, LLC
Correspondence Address	Katherine Klammer Madianos 3606 Enfield Road Austin, TX 78703 UNITED STATES katherine@madianoslaw.com
Submission	Opposition/Response to Motion
Filer's Name	Kenneth G. Parker
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Signature	/Kenneth G. Parker/
Date	11/19/2009
Attachments	Opposition to Motion to Amend Registration.pdf ( 9 pages )(27192 bytes )

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

In re Registration No. 3,321,797  
Mark: DIGITAL NINJA  
Issued: October 23, 2007

PICTURECODE, LLC,

Petitioner,

v.

JUAN B. MELENDEZ III

Respondent

Cancellation No. 92051532

**PETITIONER'S BRIEF IN  
OPPOSITION TO  
RESPONDENT'S MOTION TO  
AMEND REGISTRATION;  
DECLARATION OF  
KATHERINE KLAMMER  
MADIANOS IN SUPPORT**

**TO ALL PARTIES AND THE BOARD:**

**PLEASE TAKE NOTICE** that PictureCode, LLC hereby submits this Brief in Opposition to Respondent's Motion to Amend Registration (this "Opposition"). This Opposition is based on this notice, the attached Memorandum, the attached Declaration of Katherine Klammer Madianos, the papers on file in this matter, the documents on file regarding the DIGITAL NINJA registration, and such other matters as the Trademark Trial and Appeal Board properly considers.

Dated: November 19, 2009

Respectfully Submitted,

/Kenneth G. Parker/

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## MEMORANDUM

### I. INTRODUCTION

Respondent Juan B. Melendez III submitted a motion to amend (the “Motion to Amend”) his DIGITAL NINJA trademark registration (Reg. No. 3,321,797) (labeled by Respondent as “Response to PictureCode LLC Attorney Letter”) to the Trademark Trial and Appeals Board (the “Board”) on October 30, 2009. In this Motion to Amend, Respondent has requested that his DIGITAL NINJA registration be amended to reflect earlier dates of first use than those included in his original application papers. Presumably, Respondent’s request to amend his first use dates is an effort to reduce his burden of proving use in the period before the dates of first use listed in his current DIGITAL NINJA registration. For the reasons discussed below, the Board should defer consideration of this motion until its final decision in the pending cancellation proceeding No. 92051532 involving the DIGITAL NINJA registration, and such motion ultimately should be denied.

### II. ARGUMENTS

#### A. The TTAB is the Proper Venue for Respondent’s Motion to Amend his Registration.

As set forth in the attached Declaration of Katherine Klammer Madianos, Petitioner’s Petition to Cancel was filed on October 1, 2009, not later than 11:51 a.m. U.S. Eastern Time, and the cancellation proceeding was instituted not later

than 12:36 U.S. Eastern Time. The time stamp contained on Respondent's Section 7 Request to Amend indicates that it was filed at 2:04:45 p.m. U.S. Eastern Time. Thus, the Petition to Cancel Respondent's DIGITAL NINJA registration was filed, and the instant proceeding instituted, before Respondent filed his Request to Amend the DIGITAL NINJA Registration with the Patent and Trademark Office.

However, even if Respondent had filed his Request to Amend hours before the cancellation proceeding was instituted, because there is now a cancellation proceeding pending with respect to the DIGITAL NINJA registration, any request to amend such registration must now be decided by the Board as part of the cancellation proceeding. As provided in 37 C.F.R § 2.133 (a), "a registration subject to a cancellation [may not] be amended or disclaimed in part, except with the consent of the other party or parties and the approval of the Trademark Trial and Appeal Board, or upon motion granted by the Board." In this case, Petitioner has not consented and does not consent to the amendment Respondent wishes to make to his DIGITAL NINJA registration. And, Respondent's DIGITAL NINJA registration is subject to a cancellation proceeding. Thus, pursuant to 37 C.F.R § 2.133 (a), Respondent's registration may only be amended "upon motion granted by the Board."

**B. Respondent's "Response to PictureCode, LLC Attorney Letter" is in Actuality a Motion to Amend His Registration.**

Respondent's filing containing his arguments in favor of his request to amend his registration are contained in a document entitled "Response to

PictureCode, LLC Attorney Letter.” Nevertheless, this filing should be considered a Motion to Amend Registration under 37 CFR § 2.133(a). Motions in inter partes proceedings should be considered for what they really are, not necessarily on the basis of the labels given to such filings by the parties. *Guardian Chemical Corp. v. International Dioxide, Inc.*, 162 U.S.P.Q. 267, 268 n.1 (T.T.A.B. 1969).

Labels appended to motions should not control, since the purpose of the Federal Rules of Civil Procedure is “to secure the just, speedy, and inexpensive determination of every action.” Fed. R. Civ. P. 1. *See D. & M. Antique Import Corp. v. Royal Saxe Corp.*, 146 U.S.P.Q. 618, 619 (T.T.A.B. 1965). To disregard the true nature of a filing would frustrate this goal by causing undue delay.

In his “Response to PictureCode, LLC Attorney Letter,” Respondent “formally asks that the Request to Amend be granted . . .” and includes arguments supporting such request. As such, despite the inaccurate label, Respondent’s “Response to PictureCode, LLC Attorney Letter” is in actuality a Motion to Amend Registration, and should be treated as such by the Board.

**C. Consideration of Respondent’s Motion Should Be Deferred Until Final Consideration of the Cancellation Proceeding.**

Consideration of and ruling on motions to amend the dates of first use of an application or registration subject to an inter partes proceeding should be deferred until after the final hearing. *Fort Howard Paper Co. v. G.V. Gambina Inc.*, 4 U.S.P.Q.2d 1552, 1554 (T.T.A.B. 1987), *Mason Engineering & Design Corp. v. Mateson Chemical Corp.*, 225 U.S.P.Q. 956, 957 n.4 (TTAB 1985). Further,

“such motions shall be granted only if the proposed amendment is established by, or is not inconsistent with, evidence adduced during the testimony period.” *Fort Howard Paper Co.*, supra, at 1554. Respondent’s Motion to Amend requests that the dates of first use and dates of first use in commerce of his DIGITAL NINJA registration be moved from December 1, 2006 and May 1, 2007, respectively, to August 12, 2003. Respondent has offered no evidence in support of such amendment. Presumably, Respondent will attempt to provide proof as of this earlier use date in the course of the discovery and trial in the pending cancellation proceeding. As such the Board’s consideration of the Motion to Amend should be deferred until the Board’s final consideration of the cancellation proceeding, when any evidence as to the appropriateness of the amendment will be of record.

**D. Respondent’s Motion to Amend Registration Should Be Denied.**

As set forth in the Petition to Cancel, Petitioner is confident that the evidence will show that Respondent did not use the DIGITAL NINJA mark in commerce on all of the goods included in his registration as of the first use date claimed in his original application papers, let alone as of the earlier first use date claimed in his Motion to Amend. Respondent’s declaration in his Motion to Amend is yet another attempt to commit fraud on the Patent and Trademark Office with respect to his DIGITAL NINJA registration. Respondent was no doubt advised by his former attorney that such an amendment would give him an advantage in any settlement negotiations with Petitioner. Respondent should not be allowed to use the amendment procedures of the Patent and Trademark Office

to his advantage in an effort to extort payment from Petitioner based on his fraudulently obtained trademark registration. Petitioner is confident that once the evidence has been submitted, the Board will agree that Respondent's Motion to Amend should be denied.

### **III. CONCLUSION**

Consideration of Respondent's Motion to Amend Registration should be deferred until the Board final decision of the instant cancellation proceeding, and Petitioner is confident that at such time the Board will agree that the Motion to Amend should be denied.

Dated: November 19, 2009

Respectfully Submitted,

/Kenneth G. Parker/

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Katherine Madianos, Esq.  
Attorneys for Petitioner

## **DECLARATION OF KATHERINE KLAMMER MADIANOS**

I, Katherine Klammer Madianos, declare as follows:

1. I am an attorney licensed to practice in Texas and California, counsel for PictureCode, LLC. I am an active member in good standing of the Bar of the State of Texas, and an inactive member in good standing of the Bar of the State of California. I make this declaration in support of Petitioner's Brief in Opposition to Respondent's Motion to Amend His Registration (Petitioner's "Opposition"). I make this declaration of my own personal knowledge and, if called as a witness, I could and would testify competently to the truth of the matters set forth herein.

2. On October 1, 2009, I filed via the Trademark Trial and Appeal Board's Electronic System for Trademark Trials and Appeals ("ESTTA") a Petition to Cancel Registration No. 3,321,797 for DIGITAL NINJA on behalf of PictureCode, LLC.

3. At 11:51 a.m., United States Eastern Time, on October 1, 2009, I received automatic e-mail from [estta-server@uspto.gov](mailto:estta-server@uspto.gov) confirming receipt of the above-described Petition to Cancel.

4. At 12:36 p.m., United States Eastern Time, on October 1, 2009, I received an e-mail from [ESTTA@uspto.gov](mailto:ESTTA@uspto.gov) attaching the TTAB order instituting the DIGITAL NINJA cancellation proceeding.

I declare under penalty of perjury that the foregoing is true and correct.

Executed this 19<sup>th</sup> day of November, 2009.

/Katherine K. Madianos/

Katherine Klammer Madianos

**Certificate of Service**

Pursuant to 37 C.R.F. § 2.119 (a), I hereby certify that a true and complete copy of the foregoing Petitioner's Brief in Opposition to Respondent's Motion to Amend Registration and accompanying Declaration of Katherine Klammer Madianos has been served on Respondent Juan B. Melendez III by mailing said copy on November 19, 2009, via overnight courier to the following address:

2008 Grant Ave #1  
Redondo Beach, CA 90278

/Kenneth G. Parker/\_\_\_\_\_

Kenneth G. Parker, Esq.  
Attorney for PictureCode, LLC