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

Proceeding	92051532
Party	Defendant Juan B. Melendez III
Correspondence Address	Juan B. Melendez III 2008 Grant Ave #1 Redondo Beach, CA 90278 UNITED STATES DNShogun@gmail.com, juan@digitalninja.us, shogun@digitalninja.us
Submission	Answer
Filer's Name	Juan Melendez
Filer's e-mail	juan@digitalninja.us, shogun@digitalninja.us, DNShogun@gmail.com
Signature	/Juan B. Melendez III/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

PICTURECODE, LLC,

Petitioner,

v.

JUAN B. MELENDEZ III

Respondent.

Cancellation No. 92051532

**RESPONDENT'S ANSWER TO  
PETITIONER'S FIRST-AMENDED  
PETITION TO CANCEL**

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

**ANSWER TO FIRST-AMENDED PETITION TO CANCEL**

Respondent Juan B. Melendez III ("Respondent"), as for his Answer to the First-Amended Petition to Cancel of Petitioner PictureCode, LLC ("Petitioner") alleges as follows:

1. With regard to the introductory paragraph, denies knowledge or information sufficient to form a belief as to Petitioner's citizenship and therefore denies those allegations, admits Petitioner filed the instant Petition to Cancel, and otherwise denies the remaining allegations in the introductory paragraph.

2. As to the allegations in Paragraph 1 of the instant Petition to Cancel, denies knowledge or information sufficient to form a belief as to the truth of the allegations and therefore denies those allegations.

3. As to the allegations in Paragraph 2 of the instant Petition to Cancel, admits Petitioner filed an Application to Register the mark PHOTO NINJA on April 9, 2009, and denies knowledge or information sufficient to form a belief as to the truth of the remaining allegations and therefore denies those allegations.

4. As to the allegations in Paragraph 3 of the instant Petition to Cancel, denies knowledge or information sufficient to form a belief as to the truth of the allegations and therefore denies those allegations.

5. As to the allegations in Paragraph 4 of the instant Petition to Cancel, admits that Petitioner filed an application to register its NOISE NINJA trademark on July 29, 2009, denies the allegation that said computer program edits images, and denies knowledge or information sufficient to form a belief as to the truth of the remaining allegations and therefore denies those allegations.

6. Admits the entirety of the allegations in Paragraph 5 of the instant Petition to Cancel.

7. Admits the entirety of the allegations in Paragraph 6 of the instant Petition to Cancel.

8. Admits the entirety of the allegations in Paragraph 7 of the instant Petition to Cancel.

9. As to the allegations in Paragraph 8 of the instant Petition to Cancel, admits the July 19, 2007 date of use for all 14 types of goods included in Respondent's application, and otherwise denies the remaining allegations in Paragraph 8.

10. Denies the entirety of the allegations in Paragraph 9 of the instant Petition to Cancel.

11. As to the allegations in Paragraph 10 of the instant Petition to Cancel, admits that Petitioner's Application to register PHOTO NINJA has been refused due to Respondent's registration of DIGITAL NINJA, and denies knowledge or information sufficient to form a belief as to the truth of the remaining allegations and therefore denies those allegations.

12. In response to Paragraph 11 of the instant Petition to Cancel, Respondent realleges and incorporates herein by reference Paragraphs 1 through 11 above.

13. Admits the entirety of the allegations in Paragraph 12 of the instant Petition to Cancel.

14. Denies the entirety of the allegations in Paragraph 13 of the instant Petition to Cancel.

15. Denies the entirety of the allegations in Paragraph 14 of the instant Petition to Cancel.

16. As to the allegations in Paragraph 15(A) of the instant Petition to Cancel, denies the entirety of this subparagraph. As to the allegations in Paragraph 15(B), admits to hiring Mr. Lauson, denies knowledge or information sufficient to form a belief as to the truth of when Ms. Madianos learned that Mr. Lauson was terminated as counsel, and denies the remainder of this subparagraph. As to the allegations in Paragraph 15(C), denies that the program sent to Petitioner was "packaged together or modified the night before...and not a finished, commercially ready software product", denies that the purchase order was a "mock-up", and agrees to the remainder of this subparagraph. As to the allegations in Paragraph 15(D), admits to Digital Ninja Photo Master product having been sold in 2008, denies that Photo Master was created in

2008, denies confirmation of any specifics as to the number of copies of Photo Master having been sold, and denies “only effort” made to promote software was via text message or email. As to the allegations in Paragraph 15(E), denies [www.digitalninja.us](http://www.digitalninja.us) does not make mention of goods for sale under the DIGITAL NINJA name, denies that the website details services, denies website has never mentioned other products, and admits website has never made products available for download. As to the allegations in Paragraph 15(F), denies knowledge or information sufficient to form a belief as to the truth of this subparagraph. As to the allegations in Paragraph 15(G), denies knowledge or information sufficient to form a belief as to the truth of this subparagraph. As to the allegations in Paragraph 15(H), denies the date as August 13, 2003, denies the deposition exchange occurred as stated as seen by the corrected deposition transcript, and denies “Mr. Melendez told the PTO examiner whatever he thought was necessary to push his DIGITAL NINJA trademark application through to registration”, and denies the remainder of this subparagraph.

17. As to Paragraph 16 of the instant Petition to Cancel, admits that Petitioner believes “Registrant’s claims of use in its Statement of Use were false at the time they were made in that, among other things, the only software for editing images, sound and video Registrant sold was not sold until 2008 and were not sold commercially”, and denies “Registrant’s claims of use in its Statement of Use were false at the time they were made in that, among other things, the only software for editing images, sound and video Registrant sold was not sold until 2008 and were not sold commercially.”

18. Denies the entirety of the allegations in Paragraph 17 of the instant Petition to Cancel.

19. Denies the entirety of the allegations in Paragraph 18 of the instant Petition to Cancel.

20. Denies the entirety of the allegations in Paragraph 19 of the instant Petition to Cancel.

21. Denies the entirety of the allegations in Paragraph 20 of the instant Petition to Cancel.

22. Denies the entirety of the allegations in Paragraph 21 of the instant Petition to Cancel.

23. In response to Paragraph 22 of the instant Petition to Cancel, Respondent realleges and incorporates herein by reference Paragraphs 1 through 21 above.

24. Denies the entirety of the allegations in Paragraph 23 of the instant Petition to Cancel.

25. As to the allegations in Paragraph 24 of the instant Petition to Cancel, admits that Respondent has used his DIGITAL NINJA mark in connection with behind-the-scenes production, directing, editing, animation and related services for motion pictures, music videos and commercials, and otherwise denies the allegations that the DIGITAL NINJA mark has been “solely” used in such a manner.

26. Denies the entirety of the allegations in Paragraph 25 of the instant Petition to Cancel.

27. In response to Paragraph 26 of the instant Petition to Cancel, Respondent realleges and incorporates herein by reference Paragraphs 1 through 26 above.

28. Denies the entirety of the allegations in Paragraph 27 of the instant Petition to Cancel.

29. Denies the entirety of the allegations in Paragraph 28 of the instant Petition to Cancel.

30. Denies the entirety of the allegations in Paragraph 29 of the instant Petition to Cancel.

31. In response to Paragraph 30 of the instant Petition to Cancel, Respondent realleges and incorporates herein by reference Paragraphs 1 through 30 above.

32. As to the allegations in Paragraph 31 in the instant Petition to Cancel, denies Respondent never used the DIGITAL NINJA trademark on or in connection with “computer programs for editing images”, and denies knowledge or information sufficient to form a belief as to the truth of the remaining allegations and therefore denies those allegations.

33. As to the allegations in Paragraph 32 of the instant Petition to Cancel, denies the NOISE NINJA mark is symbolic of extensive good will and consumer recognition, denies the computer programs sold in connection with the NOISE NINJA mark edits digital photographs and images, and denies knowledge or information sufficient to form a belief as to the truth of the remaining allegations and therefore denies those allegations.

34. As to the allegations in Paragraph 33 of the instant Petition to Cancel, admits to the extent that Respondent’s *original* Statement of Use indicates that the first use date for the DIGITAL NINJA mark is December 1, 2006, however, an amendment to said Statement of Use indicates an earlier date, and otherwise denies the remaining allegations.

35. As to the allegations in Paragraph 34 of the instant Petition to Cancel, denies the similarity of Petitioner's NOISE NINJA and Respondent's DIGITAL NINJA mark, the overlapping and related nature of the goods in connection with which such marks are registered and/or used, and denies knowledge or information sufficient to form a belief as to the truth of the remaining allegations and therefore denies those allegations.

36. As to the allegations in Paragraph 35 of the instant Petition to Cancel, denies knowledge or information sufficient to form a belief as to the truth of the allegations and therefore denies those allegations.

#### **AS AND FOR A FIRST AFFIRMATIVE DEFENSE**

37. Failure to State a Claim: Petitioner's First-Amended Petition to Cancel fails to state a claim upon which relief may be granted.

#### **AS AND FOR A SECOND AFFIRMATIVE DEFENSE**

38. Estoppel: Petitioner's claims are barred by the doctrine of estoppel as Petitioner has engaged in conduct and activities with respect to the subject of the Petition to Cancel, and by reason of such conduct and activities is estopped from asserting any claims or seeking damages from Respondent.

#### **AS AND FOR A THIRD AFFIRMATIVE DEFENSE**

39. Laches: Petitioner's claims are barred by the doctrine of laches as Petitioner waited an unreasonable period of time before asserting such claims.

#### **AS AND FOR A FOURTH AFFIRMATIVE DEFENSE**

40. Reservation: Respondent presently has insufficient knowledge or information on which to form a belief as to whether he may have additional, as yet unstated

affirmative defenses available. Respondent herein reserves the right to assert additional affirmative defenses in the event that discovery indicates that such defenses are appropriate.

WHEREFORE, Respondent respectfully requests that the Board dismiss this cancellation proceeding in its entirety.

Dated: February 7, 2010

Respectfully Submitted,  
/Juan B. Melendez III/  
Juan B. Melendez III, Respondent

**CERTIFICATE OF TRANSMITTAL**

I hereby certify that a true copy of the foregoing ANSWER TO FIRST-AMENDED PETITION TO CANCEL is being filed electronically with the TTAB via ESTTA on February 7, 2010.

/Juan B. Melendez III/  
Juan B. Melendez III, Respondent

**CERTIFICATE OF SERVICE**

Pursuant to C.R.F. § 2.111, and by agreement of the parties, I hereby certify that a true and correct copy of the foregoing Answer to First-Amended Petition to Cancel has been served on Petitioner, PICTURECODE, LLC via electronic mail on February 7, 2010, on the following:

1. Petitioner's Attorney, Katherine Klammer Madianos, Esq., at the following electronic mail address: [katherine@madianoslaw.com](mailto:katherine@madianoslaw.com)

Katherine Klammer Madianos, Esq.  
3606 Enfield Road  
Austin, TX 78703  
[katherine@madianoslaw.com](mailto:katherine@madianoslaw.com)

2. Petitioner's Co-Counsel, Kenneth G. Parker, Esq., at the following electronic mail address: [kparker@tlpfirm.com](mailto:kparker@tlpfirm.com)

Kenneth G. Parker, Esq.  
Teuton, Loewy & Parker, LLP  
3121 Michelson Drive, Suite 250  
Irvine, CA 92612  
[kparker@tlpfirm.com](mailto:kparker@tlpfirm.com)

/Juan B. Melendez III/  
Juan B. Melendez III, Respondent