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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
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Submission	Motion for Summary Judgment
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Attachments	DNmotion4summary.pdf (6 pages)(12325 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

**MOTION FOR SUMMARY JUDGEMENT
WITH PREJUDICE, RES JUDICATA**

I. Introduction

This is a cancellation proceeding initiated by PictureCode LLC (“Petitioner”) on October 1, 2009. Petitioner has alleged fraud, abandonment, non-use, and the likelihood of confusion in its claims toward the cancellation of the DIGITAL NINJA trademark registration (Reg. No. 3,321,797), possessed by Juan B. Melendez III (“Respondent”). Both parties, at the opening of Discovery in these proceedings had, in effect, entered into a contract to let this body decide the outcome of the Petitioner’s allegations and the Respondent’s defense of them. On March 19, 2010, Petitioner filed a complaint in the United States District Court in the Western District of Texas against Respondent. Respondent contends there are no genuine issues of material fact remaining for this or a district court case. This case now comes up on Respondent’s motion for

summary judgment in its favor and with prejudice *as the facts have been presented* by the Petitioner.

II. Qualifications for Summary Judgment

A. Laches

Since November 5, 2003 the Petitioner's mark has maintained the TM symbol and subsequently attempted to file for a the NOISE NINJA and PHOTO NINJA mark. Petitioner has too-long "slept on its rights", as the party knew or should have known it had a right of action, yet did not act to assert or protect its rights. The Respondent since August 12, 2003 and significantly prior to that date had invested significant amounts of time, money, and energy in checking the Federal Register, the internet, and copyright registrations for DIGITAL NINJA, finding no other entity or party laid claim to the name DIGITAL NINJA. Over time, DIGITAL NINJA has built up the name and company, where it has become famous, synonymous as an identifier of Respondent, Respondent's quality of work, and related products.

Respondent has definitively maintained its mark throughout the years, as evidenced through its payment of state and federal taxes, maintains of its domain name and website, product sales, promotion, and advertisement. Any admission by Petitioner as to a lack of knowledge is no excuse, as in *Turner v. Hops Grill & Bar Inc.*, 52 USPQ2d 1310, 1312 (TTAB 1999) states, "Because actual knowledge is not the appropriate measure, and the length is clearly substantial, petitioner's delay in objecting to respondent's registration is unreasonable."

B. Lack of a valid Fraud claim

The Petitioner's earlier Fraud claim was denied and subsequent Fraud claims continue to fail in presentation. The Petitioner's earlier Fraud claim was denied and subsequent Fraud claims continue to fail in presentation, as they are rooted in mere speculations. *In re Bose Corp.* (580 F.3d 1240 (Fed. Cir. 2009) states that the party alleging fraud must prove a willful intent to deceive the PTO through its material misrepresentations. The Petitioner has not provided any material that contradicts the Respondent's registration, testimony, or confidential documents provided.

C. Lack of Abandonment and Non-Use

The mark has (as admitted by Petitioner; see Ex Parte application,) been in use as of August 12, 2003 and continuously since. Additionally Petitioner has evidence the name DIGITAL NINJA, had been in use as early as 2000. Petitioner cannot provide any evidence to the contrary.

D. Un-Clean Hands

Respondent disclosed to the Petitioner (*clearly marked and highly confidential documents, in good faith, and protected by the TTAB's standard protective order.* The Petitioner has made mention of these (clearly marked) confidential documents without prior approval from this board or from Respondent, and shown said documents to numerous other outside parties not under agreement (as admitted by Petitioner; see Ex Parte application,).

E. Admission of Priority

Although, through Petitioner's abusive actions, *they have admitted (as admitted by Petitioner; see Ex Parte application,) knowledge of documentation of prior use and has acknowledged Respondent's DIGITAL NINJA mark possesses a senior date of use.*

The DIGITAL NINJA mark possesses senior date of first use, August 12, 2003 Those documents include a domain name purchase on July 25th, 2003, articles of incorporation on August 12th, 2003, invoices prior to and on August 12, 2003, and an additional DIGITAL NINJA mark application (Reg. No. 3,169,349), containing the DIGITAL NINJA name, filed on August 19, 2003 for related services associated with the DIGITAL NINJA products.

F. Common-law

Any common-law claims that Respondent has claimed would also apply to Respondent, as the mark was in use on such date (as admitted by Petitioner; see Ex Parte application).

G. Likelihood of Confusion

Federal registration provides prima facie evidence of trademark ownership and use.

III. Conclusion

One of the useful purposes of summary judgment is one of judicial economy; to save the United States government time and expense of a useless trial where no genuine issue of material fact remains, and more evidence than is already available in connection with the summary judgment motion, could not reasonably be expected to change the result. The Respondent asserts the TTAB is better suited for both parties to decide the validity of the Petitioner's cancellation claims and render judgment. A district court does not maintain the entire procedural history associated with these proceedings or the technological fluidity to which the TTAB provides in deciding matters of trademarks. Lack of a summary judgment, would in fact, lead to a longer, protracted, and inefficient use of government resources.

The Petitioner is attempting to “hit the reset button” (adding additional claims), open up a “second front” (in a district court) and “lay siege” (adding additional litigation, copy, and filing fees) to Respondent by taking case to a district court on their “home field” (Texas). These are blatant attempts against the Respondent to relinquish its substantially senior DIGITAL NINJA trademark rights, more specifically in regards to “computer programs that edit images.” The Petitioner should not be allowed to do so. Petitioner has shown a severe disregard for judicial procedures, in an obvious attempt to circumvent their obligations to the rule of law and to this judicial body. For the foregoing reasons, Respondent humbly asks the Members of the Board for a Motion of Summary judgment with Prejudice, Res Judicata, upholding the DIGITAL NINJA mark, Registration No. 3,321,797 and the rule of law. In the alternative of a summary judgment, Respondent request Petitioner be compelled to answer Respondent’s Request for Admissions.

Dated: April 12, 2010

Respectfully Submitted,

/Juan B. Melendez III/
Juan B. Melendez III
 (“Respondent”)
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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 response has been served on Petitioner's Attorneys via electronic mail on April 12, 2010:

1. Petitioner's Attorney, Kenneth G. Parker, Esq., at the following electronic mail address: kenneth.parker@haynesboone.com

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