

ESTTA Tracking number: **ESTTA320247**

Filing date: **12/04/2009**

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

Proceeding	91192436
Party	Defendant Freeverse Corporation
Correspondence Address	FREEVERSE CORPORATION FREEVERSE CORPORATION 45 MAIN ST STE 506 BROOKLYN, NY 11201 UNITED STATES dino@freeverse.com
Submission	Answer
Filer's Name	Morgan E. Downer, Attorney for Applicant
Filer's e-mail	mdowner@mkramerlaw.com
Signature	/Morgan E. Downer/
Date	12/04/2009
Attachments	freeverse.moto.chaser.answer.cert.PDF ( 8 pages )(77035 bytes )

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

Applicant: Freeverse Corporation  
Serial No. 77553392  
Mark: MOTO CHASER  
Filed: August 22, 2008

Published in the *Official Gazette* on June 30, 2009

MOTOROLA, INC.	)	
	)	Opposition No. 91192436
Opposer,	)	
	)	
-v-	)	
	)	
FREEVERSE CORPORATION,	)	
	)	
Applicant.	)	

**APPLICANT’S ANSWER TO NOTICE OF OPPOSITION**

Applicant, Freeverse Corporation (“Applicant” or “Freeverse”), by its attorneys, Michael B. Kramer & Associates, as and for its Answer to the Notice of Opposition (the “Opposition”), filed by Motorola, Inc. (“Opposer” or “Motorola ”), against the application for registration of Freeverse’s trademark “Moto Chaser”, Serial No. 77553392, filed August 22, 2008 and published in the Official Gazette on June 30, 2009, pleads and avers as follows:

1. Answering Paragraph 1 of the Opposition, Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations therein and accordingly denies the allegations.

2. Answering Paragraph 2 of the Opposition, Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations therein and accordingly denies the allegations.

3. Answering Paragraph 3 of the Opposition, Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations therein and accordingly denies the allegations.

4. Answering Paragraph 4 of the Opposition, Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations therein and accordingly denies the allegations.

5. Answering Paragraph 5 of the Opposition, Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations therein and accordingly denies the allegations.

6. Answering Paragraph 6 of the Opposition, Applicant admits the allegations therein.

7. Answering Paragraph 7 of the Opposition, Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations therein and accordingly denies the allegations.

8. Answering Paragraph 8 of the Opposition, Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations therein and accordingly denies the allegations.

9. Answering Paragraph 9 of the Opposition, Applicant denies the allegations therein.

**AS TO COUNT I**

10. Applicant repeats and realleges each and every response to Paragraphs "1" through "9" of the Opposition as if more fully set forth herein at length.

11. Answering Paragraph 11 of the Opposition, Applicant denies the allegations therein.

**AS TO COUNT II**

12. Applicant repeats and realleges each and every response to Paragraphs "1" through "11" of the Opposition as if more fully set forth herein at length.

13. Answering Paragraph 13 of the Opposition, Applicant denies the allegations therein.

**AS TO COUNT III**

14. Applicant repeats and realleges each and every response to Paragraphs "1" through "13" of the Opposition as if more fully set forth herein at length.

15. Answering Paragraph 15 of the Opposition, Applicant denies the allegations therein.

**AS TO REQUEST FOR RELIEF**

16. Answering Paragraph 16 of the Opposition, Applicant denies the allegations therein.

**AFFIRMATIVE ALLEGATIONS OF APPLICANT**

17. Applicant affirmatively alleges that there is no likelihood of confusion because, inter alia, Applicant's mark and the pleaded marks of Opposer are not confusing similar.

18. Applicant further affirmatively alleges that there is no likelihood of confusion, because, inter alia, any similarity, if at all between Applicant's mark and the pleaded marks of Opposer is in the portion "Moto", which stands alone in Applicant's mark as part of the two word phrase "Moto Chaser" and as part of other larger words in the pleaded marks of Opposer, such as "Motorola" and "TryMeMoto".

19. Applicant further affirmatively alleges that there is no likelihood of confusion or false suggestion of a connection, because, inter alia, the portion "Moto" is a descriptive term of the nature of the game play, in that Applicant's mark "Moto Chaser" is a motocross racing game. "Moto" is not the name of a game company, character or some other unique entity, but a common shorthand for motocross racing. In fact, "moto" is simply the French translation of "motorcycle" or "motorbike." "Moto" also describes a single pass of all of the riders through the course. A rider's scores on a certain number of "mos" determine his or her overall placing in a race. Moto can also be shorthand for a small motorcycle or moped.

20. Applicant further affirmatively alleges that there is no likelihood of confusion or false suggestion of a connection, because, inter alia, Opposer does not look to the Applicant's mark as a whole, and such dissection of a mark is prohibited. Courts have consistently held that dissecting and focusing on the element that happens to share the most similarity with an applicant's mark is prohibited

21. Applicant further affirmatively alleges that there is no likelihood of confusion, false suggestion of a connection, or dilution, because, inter alia, even taking the Opposer's wrongful dissection of the Applicant's Mark into consideration, upon information and belief, the portion "Moto" has been used and registered by numerous

third parties in the electronic games market as well as other electronic products and businesses generally. Upon even a cursory examination of available games on Gamespot.com, there are a number of motocross racing games on the market; “Moto Racer,” “Jet Moto,” “Moto Maniacs,” “XS Moto” “Moto Rader,” the “MotoGP” series, the “Dirt Moto Racing”, “Moto X Mahem,” and “Moto Racing Fever,” to name a few.

22. Applicant further affirmatively alleges that there is no likelihood of confusion, false suggestion of a connection, or dilution, because, inter alia, the term “moto” and the sport of motocross are neither unique nor associated with one game or product. As a result, Opposer cannot base any similarity between its pleaded marks and the mark of the Applicant on the “Moto”.

23. Applicant further affirmatively alleges that there is no likelihood of confusion, false suggestion of a connection, or dilution, because, inter alia, to date, there are twenty-four (24) returns from a search of the United States Patent and Trademark Office’s (“USPTO”) website of searches for live marks containing the word “moto” in International Class 009. Further, without limitation, the marks “Moto Racer,” “Moto Loco” and “She-Moto” are directly related to moto racing. As such, the term “moto” lacks the uniqueness that should be required to limit registering trademarks goods which only share the common word “moto.”

24. Applicant further affirmatively alleges that there is no likelihood of confusion, false suggestion of a connection, or dilution, because, inter alia, a search of the USPTO’s website for live marks for the word “baseball” and for the word “football” in International Class 009 will confirm that no single company has a monopoly on the use of the either “baseball” or “football,” which, like moto racing, apply to a sport. To date,

“Baseball” has forty-five (45) records, and “football” has sixty-three (63). While Motocross is not as commonplace or well known in the United States as baseball or football, it is nevertheless a recognized sport as well as type of motorcycle.

25. Applicant further affirmatively alleges that there is no likelihood of dilution or false suggestion of a connection because Opposer’s marks are associated with actual mobile phones, while Moto Chaser is a game title for an electronic racing game that may be played on the iPhone.

### **AFFIRMATIVE DEFENSES**

#### **AS AND FOR A FIRST AFFIRMATIVE DEFENSE** **(Failure to State a Cause of Action)**

26. Opposer fails to state a cause of action upon which relief can be granted.

#### **AS AND FOR A SECOND AFFIRMATIVE DEFENSE** **(No Likelihood of Confusion, False Suggestion of a Connection, or Dilution)**

27. The goods of the Applicant and the Opposer are unlike, dissimilar and unrelated, and that the marks of the Applicant and the Opposer are not likely to cause confusion or mistake or to deceive potential purchasers.

#### **AS AND FOR A THIRD AFFIRMATIVE DEFENSE** **(Acquiescence and Estoppel)**

28. The word "Moto," as a trade-mark or a part thereof, cannot become the exclusive property of the Opposer, as “Moto” is in common use by persons and firms other than the Opposer and Applicant and that combinations containing the word " Moto"

have been permitted registration and are still registered in the USPTO as valid and subsisting marks by others than Opposer.

WHEREFORE, Applicant requests that the Opposer's Notice of Opposition be dismissed.

Respectfully submitted,

Freeverse Corporation

By: 

Morgan E. Downer

Michael B. Kramer & Associates

Attorneys for Applicant

150 East 58<sup>th</sup> Street, 12<sup>th</sup> Floor

New York, New York 10155

(212) 319-0304

Date: December 4, 2009

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

Applicant: Freeverse Corporation  
Serial No. 77553392  
Mark: MOTO CHASER  
Filed: August 22, 2008

Published in the *Official Gazette* on June 30, 2009

MOTOROLA, INC. )  
 ) Opposition No. 91192436  
 )  
 ) Opposer,  
 )  
 )  
 ) -v-  
 )  
 )  
 ) FREEVERSE CORPORATION,  
 )  
 )  
 ) Applicant.  
 )


**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing Applicant's Answer to Notice of Opposition has been served on counsel for Opposer, Motorola, Inc., upon consent, via email on December 4, 2009 to the following addresses:

Kristin J. Achterhof, Esq. at [kristin.achterhof@kattenlaw.com](mailto:kristin.achterhof@kattenlaw.com)  
Deborah Wing at [deborah.wing@kattenlaw.com](mailto:deborah.wing@kattenlaw.com)  
Breighanne A. Eggert, Esq. at [breighanne.eggert@kattenlaw.com](mailto:breighanne.eggert@kattenlaw.com)

As well as by first class mail on December 4, 2009 to counsel for Opposer, Motorola, Inc., at the following address:

Kristin J. Achterhof  
Breighanne A. Eggert, Esq.  
Katten Muchin Rosenman LLP  
525 West Monroe Street  
Chicago, IL 60661

  
Morgan E. Downer