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

Proceeding	91222388
Party	Defendant Al Jazeera Media Network
Correspondence Address	ANN K. FORD DLA PIPER LLP (US) 500 8TH ST NW WASHINGTON, DC 20004-2131 dctrademarks@dlapiper.com
Submission	Answer
Filer's Name	Ashley H. Joyce
Filer's e-mail	ann.ford@dlapiper.com, john.nading@dlapiper.com, ashley.joyce@dlapiper.com, dctrademarks@dlapiper.com
Signature	/Ashley H. Joyce/
Date	07/27/2015
Attachments	Applicant's Answer and Affirmative Defenses for Opposition No. 91222388.pdf(41882 bytes)

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

In the matter of Service Mark
Application No. 86235375
Mark: BORDERLAND
Filing Date: March 28, 2014
Published for Opposition: February 17, 2015

GEARBOX SOFTWARE, L.L.C. AND IPERION LLC,)	
)	
Opposers,)	
)	
v.)	Opposition No. 91222388
)	
AL JAZEERA MEDIA NETWORK,)	
)	
Applicant.)	
)	

**APPLICANT’S ANSWER AND AFFIRMATIVE DEFENSES
TO NOTICE OF OPPOSITION**

Applicant Al Jazeera Media Network (“Applicant” or “AJMN”), by and through its undersigned counsel, hereby sets forth its Answer and Affirmative Defenses to Opposers Gearbox Software, L.L.C. (“Gearbox”) and IPerion LLC’s (“IPerion”) (Gearbox and IPerion, collectively, “Opposers”) Notice of Opposition in the above-captioned proceeding (“Notice of Opposition”) as follows:

Responding to the allegations contained in the first unnumbered paragraph of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to the truth, and therefore denies same. Applicant expressly denies the allegation that Gearbox will be damaged by registration of U.S. Service Mark Application Serial No. 86235375 for the mark BORDERLAND (“Application”).

Responding to the allegations contained in the second unnumbered paragraph of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to the truth, and therefore denies same. Applicant expressly denies the allegation that IPerion will be damaged by registration of the Application.

1. Responding to the allegations contained in Paragraph 1 of the Notice of Opposition, Applicant admits that IPerion is listed as the owner of U.S. Trademark Registration No. 3693183 for the mark BORDERLANDS (“Registration”), which underlying application was filed on August 1, 2007 and issued as a registration on October 6, 2009, for “software and electronic games, namely, software games recorded on CD-ROM, on digital video discs, and on blue laser discs, all for computers; software games recorded on CD-ROMs, on digital video discs, on blue laser discs, and on cartridges, all for console and individual, portable gaming systems; software games that are downloadable from a remote computer site; and software games for mobile phones, personal digital assistants, and handheld computers;” in International Class 9. Applicant also admits that, on or around March 19, 2015, IPerion filed a Declaration of Use and/or Excusable Nonuse of Mark in Commerce under Section 8 deleting the goods “software games recorded on CD-ROM for computers; software games recorded on CD-ROMs for console and individual, portable gaming systems; software games for personal digital assistants,” and declaring the following goods in use in commerce or for which owner claims excusable nonuse: “software and electronic games, namely, software games recorded on digital video discs, and on blue laser discs, all for computers; software games recorded on digital video discs, on blue laser discs, and on cartridges, all for console and individual, portable gaming systems; software games that are downloadable from a remote computer site; and software games for mobile phones and handheld computers.” Except as expressly admitted, Applicant

denies each and every allegation contained in Paragraph 1 of the Notice of Opposition, including the assertion that IPerion is the owner of the Registration, and puts Opposers upon strict proof of same.

2. Responding to the allegations contained in Paragraph 2 of the Notice of Opposition, Applicant denies that the Registration has been renewed under 15 U.S.C. § 1059. Applicant admits that the United States Patent and Trademark Office (“USPTO”) accepted a Section 8 declaration under 15 U.S.C. § 1058 for the Registration on or around March 25, 2015. Except as expressly denied and admitted, Applicant denies each and every allegation contained in Paragraph 2 of the Notice of Opposition.

3. Responding to the allegations contained in Paragraph 3 of the Notice of Opposition, Applicant admits that the USPTO acknowledged a Section 15 declaration under 15 U.S.C § 1065 for the following goods in the Registration on or around March 25, 2015: “Software and electronic games, namely, software games recorded on digital video discs, and on blue laser discs, all for computers; software games recorded on digital video discs, and on blue laser discs, all for console gaming systems; software games that are downloadable from a remote computer site; and software games for mobile phones and handheld computers.”

4. Responding to the allegations contained in Paragraph 4 of the Notice of Opposition, Applicant states that Exhibits A and B speak for themselves, and Applicant denies each and every factual allegation contained in Paragraph 4 of the Notice of Opposition. As to Exhibit A, Applicant notes that the goods recited on both Certificates of Registration do not reflect the current goods as renewed in March 2015. Applicant notes that Exhibit B as filed of record with the USPTO in this Opposition Proceeding is entirely blank, except for a date and title

at the top and URL at the bottom. Applicant also notes that Opposers served a different version of Exhibit B which included content, but which is not of record in this Opposition.

5. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 5 of the Notice of Opposition, and therefore denies the same.

6. Applicant denies each and every allegation contained in Paragraph 6 of the Notice of Opposition.

7. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 7 of the Notice of Opposition, and therefore denies the same.

8. Applicant denies each and every allegation contained in Paragraph 8 of the Notice of Opposition.

9. Applicant denies each and every allegation contained in Paragraph 9 of the Notice of Opposition.

10. Applicant denies each and every allegation contained in Paragraph 10 of the Notice of Opposition.

11. Applicant denies each and every allegation contained in Paragraph 11 of the Notice of Opposition.

12. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in the first sentence of Paragraph 12 of the Notice of Opposition, and therefore denies the same. Applicant denies each and every allegation contained in the second sentence of Paragraph 12 of the Notice of Opposition.

13. The allegations contained in Paragraph 13 of the Notice of Opposition are conclusions of law, not allegations of fact. Applicant denies any factual allegations contained in Paragraph 13 of the Notice of Opposition, including the argumentative assumption that the chain of ownership for the Registration is clean and proper.

14. Responding to the allegations contained in Paragraph 14 of the Notice of Opposition, Applicant admits that it filed the Application for the mark BORDERLAND for “entertainment services in the nature of an ongoing television program in the field of news” in International Class 41, as amended on or around December 22, 2014. Except as expressly admitted, Applicant denies each and every allegation contained in Paragraph 14 of the Notice of Opposition, including the argumentative assertion that BORDERLAND is “assertedly a mark.”

15. Responding to the allegations contained in Paragraph 15 of the Notice of Opposition, Applicant admits that Opposers do not provide the services recited in the Application. Applicant denies the argumentative assumption that Opposers’ authorization to use the BORDERLAND Mark depicted in the Application is necessary in the first place. Except as expressly admitted or denied, Applicant denies each and every allegation contained in Paragraph 15 of the Notice of Opposition.

16. Applicant denies each and every allegation contained in Paragraph 16 of the Notice of Opposition.

17. The allegations contained in Paragraph 17 of the Notice of Opposition are conclusions of law, not allegations of fact. Applicant denies any factual allegations contained in Paragraph 17 of the Notice of Opposition.

18. Paragraph 18 of the Notice of Opposition is a sentence fragment and neither a factual allegation nor even a conclusion of law; as such, it does not require a response. To the

extent a response is required, Applicant denies each and every allegation contained in Paragraph 18 of the Notice of Opposition

19. Applicant denies each and every allegation contained in Paragraph 19 of the Notice of Opposition.

20. Applicant denies each and every allegation contained in Paragraph 20 of the Notice of Opposition.

21. Applicant denies each and every allegation contained in Paragraph 21 of the Notice of Opposition.

22. Applicant denies each and every allegation contained in Paragraph 22 of the Notice of Opposition.

23. Applicant denies each and every allegation contained in Paragraph 23 of the Notice of Opposition.

24. Applicant denies each and every allegation contained in Paragraph 24 of the Notice of Opposition.

25. Applicant denies each and every allegation contained in Paragraph 25 of the Notice of Opposition.

26. Applicant denies each and every allegation contained in Paragraph 26 of the Notice of Opposition.

27. Responding to the allegations contained in Paragraph 27 of the Notice of Opposition, Applicant states that the USPTO Office Action, dated July 7, 2014, in connection with the Application, speaks for itself. Applicant denies any argumentative characterization contained in Paragraph 27 of the Notice of Opposition.

28. Responding to the allegations contained in Paragraph 28 of the Notice of Opposition, Applicant states that its Response to Office Action, dated December 22, 2014 in connection with the Application, speaks for itself. Applicant denies any argumentative characterization contained in Paragraph 28 of the Notice of Opposition.

29. Responding to the allegations contained in Paragraph 29 of the Notice of Opposition, Applicant states that Exhibit C speaks for itself. Applicant denies any argumentative characterization contained in Paragraph 29 of the Notice of Opposition.

30. Applicant denies each and every allegation contained in Paragraph 30 of the Notice of Opposition.

31. Applicant denies each and every allegation contained in Paragraph 31 of the Notice of Opposition.

32. Applicant denies each and every allegation contained in Paragraph 32 of the Notice of Opposition.

33. Applicant denies each and every allegation contained in Paragraph 33 of the Notice of Opposition.

34. Applicant denies each and every allegation contained in Paragraph 34 of the Notice of Opposition.

35. Applicant denies each and every allegation contained in Paragraph 35 of the Notice of Opposition.

36. Applicant denies each and every allegation contained in Paragraph 36 of the Notice of Opposition.

37. Applicant denies each and every allegation contained in Paragraph 37 of the Notice of Opposition.

38. Responding to the unnumbered paragraph immediately following Paragraph 37 of the Notice of Opposition, which constitutes Opposers' prayer for relief, Applicant denies each and every allegation contained therein and denies that Opposers are entitled to any of the requested relief.

AFFIRMATIVE DEFENSES

Applicant sets forth below its affirmative defenses. By setting forth these affirmative defenses, Applicant does not assume the burden of proving any fact, issue, or element of a cause of action where such burden properly belongs to Opposers. As separate and distinct affirmative defenses, Applicant alleges as follows:

FIRST DEFENSE

Opposers' Notice of Opposition should be dismissed on the ground that Opposers have failed to state a claim upon which relief can be granted.

SECOND DEFENSE

Opposers cannot demonstrate any likelihood that the public will be confused or misled as to the source of Applicant's services or that Applicant's services are associated with, or endorsed by, Opposers. Thus, no likelihood of confusion is caused by Applicant's use of its BORDERLAND Mark as depicted in the Application.

THIRD DEFENSE

Applicant's BORDERLAND Mark creates a different overall commercial impression from that of Opposers' BORDERLANDS Mark.

FOURTH DEFENSE

Applicant's services under the BORDERLAND Mark are distinct from Opposers' goods under the BORDERLANDS Mark and are encountered by the relevant public in different ways.

FIFTH DEFENSE

Opposers' Notice of Opposition and claims are barred, precluded, or limited insofar as Opposers do not hold a valid or enforceable trademark in the BORDERLANDS Mark and Registration.

SIXTH DEFENSE

Opposers' Notice of Opposition and claims therein are barred, precluded, or limited because, upon information and belief, there are third-party users of similar marks incorporating "BORDERLAND" and "BORDERLANDS" for a variety of goods and services. Therefore, the terms "BORDERLAND" and "BORDERLANDS" are not entitled to a wide scope of protection outside of the parties' respective goods and services, which are distinct from each other. Indeed, on Opposers' website at <http://borderlandsthegame.com/>, there is a disclaimer at the bottom which says: "If you are looking for Borderland Sciences Research Foundation, click here," which is a link that re-directs the user to <https://borderlandsciences.org/>. Likewise, at the bottom of Borderland Sciences' website, it says: "If you are looking for Borderlands the Game, click here," which then re-directs back to Opposers' website.

SEVENTH DEFENSE

Opposers' Notice of Opposition and claims for relief are barred in whole or in part by the doctrine of unclean hands because, upon information and belief, Opposers do not have a valid ownership interest in the Registration. Gearbox assigned an undivided part of its interest in the Registration to individuals Randy Pitchford, Brian Martel, and Stephen Bahl (collectively "Assignees"), on or around February 26, 2013, "excepting those rights necessary for Assignor [Gearbox] to comply with Assignor's existing publishing and development agreements." That same day, these Assignees, now as Assignors, then assigned the entire interest to IPerion,

“excepting those rights not assigned to Assignors from Gearbox . . . as being necessary for Gearbox to comply with Gearbox’s existing publishing and development agreements.” Further, in the Notice of Opposition, Opposers allege that IPerion owns the Registration and unregistered rights in BORDERLANDS, and that Gearbox is the exclusive licensee (*see* Paras. 1 and 5), but on their website at <http://borderlandsthegame.com//>, it says: “Borderlands, Gearbox Software, and the Gearbox logo are registered trademarks of Gearbox Software, LLC in the U.S. and other countries.” As such, Opposers appear to be at the least misrepresenting to the public as to which entity owns what trademark rights.

EIGHTH DEFENSE

Opposers’ Notice of Opposition and claims for relief are barred in whole or in part by Opposers’ bad faith because, upon information and belief, Opposers do not have a valid ownership interest in the Registration. Gearbox assigned an undivided part of its interest in the Registration to individuals Randy Pitchford, Brian Martel, and Stephen Bahl (collectively “Assignees”), on or around February 26, 2013, “excepting those rights necessary for Assignor [Gearbox] to comply with Assignor’s existing publishing and development agreements.” That same day, these Assignees, now as Assignors, then assigned the entire interest to IPerion, “excepting those rights not assigned to Assignors from Gearbox . . . as being necessary for Gearbox to comply with Gearbox’s existing publishing and development agreements.” Further, in the Notice of Opposition, Opposers allege that IPerion owns the Registration and unregistered rights in BORDERLANDS, and that Gearbox is the exclusive licensee (*see* Paras. 1 and 5), but on their website at <http://borderlandsthegame.com//>, it says: “Borderlands, Gearbox Software, and the Gearbox logo are registered trademarks of Gearbox Software, LLC in the U.S. and other

countries.” As such, Opposers appear to be at the least misrepresenting to the public as to which entity owns what trademark rights.

NINTH DEFENSE

Opposers will not be damaged and are not likely to be damaged by the registration of the Application.

TENTH DEFENSE

Applicant hereby reserves the right to amend its Answer and reserves any other defenses, at law or in equity, which become applicable after the substantial completion of discovery or otherwise in the course of the Opposition Proceeding.

WHEREFORE, Applicant requests dismissal with prejudice of Opposers’ Notice of Opposition and such other and further relief as may be just and proper.

Dated: July 27, 2015

Respectfully submitted,

DLA PIPER LLP (US)

By: /s/ John M. Nading
Ann K. Ford
John M. Nading
Ashley H. Joyce
500 8th Street, NW
Washington, D.C. 20004
Tel. 202-799-4157
Fax 202-799-5157

*Attorneys for Applicant
Al Jazeera Media Network*

CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing **APPLICANT'S ANSWER AND AFFIRMATIVE DEFENSES TO NOTICE OF OPPOSITION** was served via U.S. First Class mail, postage prepaid, and properly addressed to counsel of record:

Timothy G. Ackermann
The Ackermann Law Firm
701 Commerce Street, Suite 400
Dallas, Texas 75202

this 27th day of July, 2015.

/s/ Ashley H. Joyce

Ashley H. Joyce
Attorney for Applicant