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

Proceeding	91223142
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Attachments	007 - Zyis Memo in Opp to Cross MSJ and Rule 56D Motion.pdf(475424 bytes ) Exhibit 1 to Memo in Opp - Decl of James McDonald with Exhibits -.pdf(1191629 bytes ) Exhibit 2 Decl of Brian Tucker iso Mot for Rule 56D Relief.pdf(191176 bytes )

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

<p style="text-align:center">Javier Rodriguez, LLC</p> <p style="text-align:center">Opposer,</p> <p style="text-align:center">v.</p> <p style="text-align:center">Zyis Ltd.,</p> <p style="text-align:center">Applicant.</p>	<p style="text-align:center">Opposition No: 91223142</p> <p style="text-align:center"><b>APPLICANT ZYIS LTD.’S MEMORANDUM IN OPPOSITION TO OPPOSER JAVIER RODRIGUEZ, LLC’S CROSS-MOTION FOR SUMMARY JUDGMENT OR, IN THE ALTERNATIVE, MOTION FOR RULE 56(d) RELIEF</b></p> <p style="text-align:center">Marks: FRIV Serial Nos. 86/562,665 &amp; 86/566,285 Published August 4, 2015</p>
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Pursuant to Federal Rule of Civil Procedure (the “Rule” or “Rules”) 56 and Trademark Rules 2.116, 2.126 and 2.127, Applicant Zyis Ltd. (“Applicant”), by and through undersigned counsel, hereby respectfully submits this Memorandum in Opposition (the “Opposition”) to Opposer Javier Rodriguez, LLC’s (“Opposer”) Cross-Motion for Summary Judgment (Opposer’s “Cross-Motion,” 11 TTABVUE).

In the alternative, pursuant to Rules 7(b) and 56(d) and Trademark Rules 2.116, 2.126 and 2.127, Applicant, by and through undersigned counsel, hereby respectfully moves the Trademark Trial and Appeal Board (the “Board”) to defer consideration of the Cross-Motion or deny the Cross-Motion in order to permit Applicant a sufficient opportunity to conduct discovery necessary to fully oppose the Cross-Motion. The following combined memorandum in opposition to the Cross-Motion and in support of Rule 56(d) relief (hereinafter, the “Rule 56(d) Motion”) embodies the brief of Applicant in support of the Rule 56(d) Motion.

As a preliminary matter, Applicant previously filed a Renewed Motion to Dismiss or, in the Alternative, Motion for Summary Judgment (the “Motion to Dismiss,” 10 TTABVUE). The Motion to Dismiss remains pending. (*See id.*) Opposer’s instant Cross-Motion was filed together with Opposer’s

response to Applicant's Motion to Dismiss (11 TTABVUE). For purposes of clarity, Applicant has concurrently filed (1) the instant Opposition memorandum and Rule 56(d) Motion and (2) a separate reply memorandum in further support of Applicant's Motion to Dismiss.<sup>1</sup> By this reference, Applicant incorporates its reply memorandum in further support of Applicant's Motion to Dismiss filed concurrently herewith.

### **INTRODUCTION**

Applicant's previously-filed Motion to Dismiss is not coextensive with Opposer's Cross-Motion. Simply put, the Motion to Dismiss is premised on Opposer's lack of standing as Opposer has neither pleaded nor shown any damage which it will suffer if Applicant's FRIV marks are registered. (*See* 10 TTABVUE.) This is a jurisdictional issue which cannot be waived, can be raised at any time, and must be addressed and resolved before proceeding to the merits of the Opposer's claim for relief. Opposer's Cross-Motion, on the other hand, is drawn to an entirely different issue: the alleged genericness of Applicant's FRIV marks. (*See* 11 TTABVUE.) This is a factually intensive issue which necessarily requires an in-depth analysis of the merits of Opposer's claim for relief. Thus, as a threshold matter, Opposer's Cross-Motion is neither related to nor necessary to the Board's resolution of Applicant's Motion to Dismiss. Put otherwise, the Motion to Dismiss must be decided first and independently. Moreover, as Opposer lacks standing to maintain this action, the Notice of Opposition must be dismissed and the Cross-Motion correspondingly denied.

Further to this point, Opposer's Cross-Motion is essentially a red herring designed to distract the Board. As discussed in detail below, Opposer's entire case rests on alleged injuries to Opposer's former friv.co domain. Now, however, through a proper proceeding under the Uniform Domain-Name Dispute-Resolution Policy (the "UDRP"), Opposer's former friv.co domain has been irrevocably transferred to Applicant extinguishing Opposer's standing. To this end, Opposer's Cross-Motion is a last-ditch and

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<sup>1</sup> *See* TBMP § 502.02(b) ("In general, all motions should be filed separately, or at least captioned separately, to ensure they receive attention. A party should not embed a motion in another filing that is not routinely reviewed by the Board upon submission.").

desperate attempt to cast aspersions on Applicant in the hopes of forestalling the inevitable and disguising the truth: Opposer is a cyber squatter who has been illegally trading on Applicant's goodwill in the FRIV mark and seeks to now legitimize this illegal conduct through opposing Applicant's FRIV marks. The Board should not be distracted by the Cross-Motion. Applicant's FRIV marks are not generic; all evidence of record supports this axiom. Accordingly, Opposer's attempt to muddy the waters of otherwise simple issues should be rejected and Applicant's FRIV marks should proceed to registration.

#### **APPLICANT'S RESPONSE TO OPPOSER'S "STATEMENT OF FACTS"**

As a threshold matter, Opposer, in moving for summary judgment, is obligated to "specify, in its brief in support of the Cross-Motion, the material facts that are undisputed." TBMP § 528.01; *see* FED. R. CIV. P. 56(a) and (c)(1). Indeed, "[a] party asserting that a fact cannot be ... genuinely disputed must support the assertion by: (A) citing to particular parts of materials in the record ... or (B) showing that the materials cited do not establish the ... presence of a genuine dispute...." FED. R. CIV. P. 56(c)(1)(A)-(B).

In this case, Opposer's so-called "Statement of Facts" does neither of these things. (*See* 11 TTABVUE at 2-4.) Specifically, Opposer's Statement of Facts fails to specify "*material* facts that are undisputed" or support any such assertion by "citing to particular parts of materials in the record." *See* TBMP § 528.01; FED. R. CIV. P. 56(c)(1)(A). Instead, Opposer provides nothing more than a historical summary of events, most of which are wholly immaterial and irrelevant and others of which are unsupported by admissible evidence or otherwise vehemently disputed, discussed *infra*. Either way, "[i]f a party fails to properly support an assertion of fact ... as required by Rule 56(c), the court may[, *inter alia*,] ... issue any ... appropriate order[.]" including denying the motion for summary judgment. *See* FED. R. CIV. P. 56(e); *see also* TBMP §§ 528.01 and 528.05. For these reasons alone, as discussed in greater detail below, Opposer's Cross-Motion should be denied.

In responding to Opposer's Cross-Motion for summary judgment, Applicant, as the non-movant, is both obligated and permitted to "specify, in its brief in opposition to the motion, the material facts that are in dispute." *E.g.*, TBMP § 528.01. Moreover, Applicant may show that a fact "is genuinely disputed

... by showing that the materials cited do not establish the absence ... of a genuine dispute, or that the adverse party cannot produce admissible evidence to support the fact.” FED. R. CIV. P. 56(c)(1)(B); *see also id.* at 56(c)(2) & 56(e); TBMP §§ 528.01 and 528.05; *Opryland USA Inc. v. The Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992) (non-movant not required to present entire case but just sufficient evidence to show an evidentiary conflict as to the material fact in dispute). To this end, Applicant has prepared the following responses to each paragraph of Opposer’s Statement of Facts, which paragraphs are restated below for convenience. Applicant has also prepared a subsequent statement of additional relevant facts.

**Opposer’s Statement of Facts, Paragraph 1:** *On October 25, 2013, Applicant applied for registration on the Principal Register for the mark FRIV (the “Mark”) for “Entertainment services, namely, providing on-line computer games; Entertainment services, namely, providing temporary use of non-downloadable video games.” On March 18, 2014, the Mark was published for opposition. On May 5, 2014, and after an extension of time to oppose was granted, Opposer filed its Notice of Opposition on the grounds that FRIV is a generic term and that the relevant purchasing public understands the designation FRIV to primarily refer to the genus of short computer games playable on the Internet. Also on May 5, 2014, the United States Patent and Trademark Office’s Trademark Trial and Appeal Board issued a letter to the parties notifying them of the Notice of Opposition and setting forth a schedule of dates.*

**Applicant’s Response:**

Immaterial and irrelevant but disputed. To begin with, Opposer’s first sentence is both disputed and unsupported by the evidence upon which Opposer relies. First, while Applicant previously applied for registration on the Principal Register for a FRIV mark in International Class 009 on October 25, 2013 (Application Serial No. 86/101,423, the “Class 009 Application”), Applicant’s former Class 009 Application is not at issue or otherwise relevant to the above-captioned proceeding. Instead, the above-captioned proceedings concerns Trademark Application Serial Nos. 86/562,665 & 86/566,285 for the FRIV marks in International Class 041 (the “Class 041 Applications”). Further to this point, and contrary to Opposer’s first sentence, Applicant’s Class 009 Application concerned goods, not services, i.e., “Computer game programs; video game programs; downloadable software for playing on-line games; interactive computer game programs; computer game software for use on mobile and cellular phones,

handheld computers, computers, video game consoles and wireless devices.” (*See* Application Serial No. 86/101,423; *see also* 11 TTABVUE at Ex. A.) Thus, Opposer’s first sentence is disputed. Moreover, the evidence upon which Opposer relies supports Applicant’s dispute of fact. (*See id.*) As such, the materials cited do not support Opposer’s first sentence and the Cross-Motion can be denied. *See* FED. R. CIV. P. 56(c)(1)(B) & (e).

While irrelevant, Applicant does not dispute that Opposer’s Notice of Opposition to Applicant’s former Class 009 Application was filed on May 5, 2014 premised on allegations of genericness. Nevertheless, Applicant vehemently disputes “that FRIV is a generic term and that the relevant purchasing public understands the designation FRIV to primarily refer to the genus of short computer games playable on the Internet.” To begin with, Opposer’s lone support in the Statement of Facts for this portion of Opposer’s sentence three is Opposer’s Notice of Opposition to Applicant’s former Class 009 Application. Aside from being irrelevant to the instant Class 041 Applications, pleadings are not evidence, they are merely allegations; pleadings are not admissible evidence upon which summary judgment can be based. *See* FED. R. CIV. P. 56(c); *see also Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 & 256 (1986) (in the context of summary judgment litigants “may not rest upon the mere allegations ... of his pleadings, but must set forth specific facts...”). As such, the materials cited do not and cannot support this portion of Opposer’s third sentence. *See* FED. R. CIV. P. 56(c)(1)(B); 56(c)(2); 56(e). Moreover, and more importantly, James Ian McDonald, the principal and Company Director for Applicant, has testified as follows:

[I]n May 2004 ... I elected to pursue and was able to acquire ... the “friv.com” domain name. At the time, “friv” was simply a made-up, non-sense word which I created on the belief that it would be easy to pronounce, remember, and type, regardless of age, gender, nationality, or language. Simply put, I created the “friv.com” domain name from whole cloth—it was a wholly made-up name. This is further evidenced by the fact that, at the time I acquired the friv.com domain, there was a statistically insignificant number of Internet searches for “friv.” .... Due to the made-up nature of “friv,” and the insignificant number of searches for “friv,” I was able to acquire the friv.com domain with virtually no competition and for very little money, from memory, less than \$100. Even then, I knew I would be taking a risk using and investing in the friv.com domain, not knowing how the domain name would be received worldwide, including the risk that “friv” could potentially sound like an offensive word in various languages or countries around the

world. In short, “friv” was completely made-up. Moreover, the FRIV marks do not and never have referred to computer games; rather, the FRIV marks are and always have been a source identifier for the domain friv.com.

(See Declaration of James Ian McDonald in Support of Applicant’s Memorandum in Opposition to Opposer’s Motion for Summary Judgment, attached hereto as **Exhibit “1”** (the “McDonald Decl.”), incorporated herein by this reference in its entirety, at ¶ 8.)

Further to this point, Opposer’s Notice of Opposition to Applicant’s Class 041 Applications alleges that “‘friv’ has referred to the genius of frivolous, short computer games playable on the Internet ... [s]ince the early 2000s...” 1 TTABVUE 2 (¶ 12). This allegation is also disputed. Indeed, as set forth in Mr. McDonald’s Declaration, Mr. McDonald did not start using the FRIV marks or the friv.com website as a source for consumers to access computer games until late 2006 and the number of Internet searches for “friv” remained statistically insignificant at that time. (See Ex. 1 (McDonald Decl.) at ¶¶ 4 – 14 & Ex. A.) In any event, as the materials cited do not support the implications of Opposer’s third sentence, this fact must be treated as disputed and Opposer’s Cross-Motion should be denied on this basis alone. See FED. R. CIV. P. 56(c)(1)(B); 56(c)(2); 56(e).

Applicant does not dispute the remainder of Opposer’s Paragraph 1 concerning the irrelevant Class 009 Application matter, which is of no consequence given its immateriality and irrelevance.

***Opposer’s Statement of Facts, Paragraph 2:*** *On August 7, 2014, Opposer served discovery requests on Applicant, including Requests to Admit, Interrogatories, and Requests for Production of Documents. Applicant failed to timely provide responses to Opposer’s discovery responses. Opposer sought in good faith to resolve the matter and provided Applicant with an extension to provide discovery answers. Applicant failed to do so. Opposer then filed a Motion to Deem Admissions Admitted. Applicant failed to respond. On November 18, 2014, the Board granted Opposer’s Motion to Deem Admissions Admitted.*

**Applicant’s Response:** Immaterial and irrelevant but disputed. To begin with, Opposer’s entire Paragraph 2 again provides nothing more than a wholly irrelevant recital of procedural history in the previous Class 009 Application matter. This recital has nothing to do with the substantive merits of this case, let alone disputes of fact. Indeed, Opposer has yet to serve *any* discovery in this matter. Worse, Opposer only supports one of the seven sentences comprising Paragraph 2 with citation to materials of

record. (See 11 TTABVUE at 3.) As such, the remaining portions of Opposer’s Paragraph 2 fail to comply with the requirements of Rule 56 and should be ignored. See FED. R. CIV. P. 56(c). Regardless, as discussed in greater detail, *infra*, Opposer’s historical recitation of irrelevant procedural “facts” do not demonstrate the absence of a genuine dispute of substantive fact or otherwise entitle Opposer to summary judgment as a matter of law. See FED. R. CIV. P. 56(a); *see also* TBMP § 528.01 (“a dispute over a fact that would not alter the Board’s decision on the legal issue” is of no significance in the context of a motion for summary judgment).

Regardless of Opposer’s failure to comply with Rule 56, Applicant does not substantively dispute Opposer’s Paragraph 2 as it relates to the Class 009 Application matter; nevertheless, it is wholly irrelevant to this matter, which is limited to the Class 041 Applications. Further to this point, and critically for purposes of Opposer’s Cross-Motion, Rule 36 explicitly states that “[a] party may serve on any other party a written request to admit, **for purposes of the pending action only**, the truth of any matters within the scope of Rule 26(b)(1). . . .” FED. R. CIV. P. 36(a)(1) (emphasis added). Rule 36 continues: “**An admission under this rule is not an admission for any other purpose and cannot be used against the party in any other proceeding.**” *Id.* at 36(b) (emphasis added). The plain meaning of Rule 36 is beyond cavil—Opposer is forbidden from using Applicant’s admissions in the Class 009 Application matter as evidence of record in this matter. *Id.* Support for his legal maxim is legion.<sup>2</sup> Accordingly, Applicant disputes Opposer’s Paragraph 2 in its entirety; the Board is obligated under Rule 36 to ignore and disregard the substance of Opposer’s Paragraph 2 as it recites nothing more than

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<sup>2</sup> See also TBMP § 407.02 (Scope and Nature of Requests for Admission); TBMP § 407.04 (Effect of Admission); 7 JAMES WM. MOORE ET AL., *Moore’s Federal Practice* § 36.03[3] (3d ed. 2013) (“An admission made under Rule 36 is for the purpose of the pending action only, and cannot be used as an admission in any other proceeding,” thus “admissions made in accordance with Rule 36 have no collateral estoppel effect.”); *In re Pizante*, 186 B.R. 484, 489 (9th Cir. 1995), *aff’d without op.*, 107 F.3d 878 (9th Cir. 1997) (limiting use of admissions deemed admitted by operation of law solely to the matter in which the requests for admission were issued and excluding use of such admissions in a related matter – “Rule 36 encourages admissions, and thus reduces the burden of litigation, by limiting the effect of those admissions to the pending action only.”); *Kohler v. Leslie Hindman, Inc.*, 80 F.3d 1181, 1185 (7th Cir. 1996) (“a statement made [under Rule 36] in one lawsuit cannot be a judicial admission in another”); *Kolar, Inc. v. United States*, 650 F.2d 256, 263 (Ct. Cl. 1981) (“Plaintiff’s attempt to make the admissions made in district court [under Rule 36] binding in this action is utterly devoid of merit”).



irrelevant history incapable of being supported by cognizable evidence or record.

***Opposer's Statement of Facts, Paragraph 3:*** *On March 17, 2015, presumably in an attempt to avoid its failure to prosecute its application for registration of FRIV (Serial No. 86101423), Applicant filed two additional applications for registration of FRIV under Serial Nos. 86566285 (design plus words mark) and 86562665 (character mark). In response, Opposer filed the instant opposition proceeding on August 5, 2015. Applicant's '285 and '665 marks seek registration in International Class 041 for use in association with providing online computer games, which is in contrast to its initial '423 application, which sought registration in International Class 009 for use in association with computer game programs.*

**Applicant's Response:** Immaterial and irrelevant but disputed in part. To begin with, akin to its prior "factual" statements, Opposer neglects to support any of the information set forth in Paragraph 3 with citation to materials of record. (See 11 TTABVUE at 3.) As such, Opposer's Paragraph 3 fails to comply with the requirements of Rule 56 and should be ignored in its entirety. See FED. R. CIV. P. 56(c). Further to this point, while totally irrelevant, there is absolutely no support in the record or elsewhere for Opposer's conclusory assertion that Applicant's former Class 009 Application was withdrawn "in an attempt to avoid" an alleged "failure to prosecute." Indeed, there is no evidence of record supporting the notion that Applicant had somehow failed to prosecute the Class 009 Application. This Opposer apparently makes up whole cloth. Worse, Opposer's speculation as to why the Class 009 Application was ultimately withdrawn is pure conjecture. This so-called "fact" is nothing of the sort and requires no response as it is wholly irrelevant and premised on unsupported allegations, not facts.

Applicant further disputes Opposer's Paragraph 3 inasmuch as it improperly conflates the *goods* at issue in the irrelevant Class 009 Application with the *services* at issue in the Class 041 Applications. Specifically, the mark at issue in the irrelevant Class 009 Application was applied for under International Class 009. (See Serial No. 86/101,423.) The marks at issue in the Class 041 Applications currently being opposed have been applied for under International Class 041. (See Serial Nos. 86/562,665 and 86/566,285.) These international classes are decidedly different, one pertaining to "Goods," including "Electrical and scientific apparatus[es]," while the other pertains to "Services," including "Education and

entertainment.”<sup>3</sup> The entire point of the International Classification system is to separately classify differing goods and services. (See, e.g., TMEP § 1401.02.) Accordingly, at the most root level, the Class 009 Application and the Class 041 Applications concern different subject matter.

This truism further supported by an examination of the goods and services identified in the underlying applications, respectively. Specifically, the goods identified in association with the Class 009 Application are as follows: “Computer game programs; video game programs; downloadable software for playing on-line games; interactive computer game programs; computer game software for use on mobile and cellular phones; handheld computers, computers, video game consoles and wireless devices.” (See Serial No. 86/101,423.) Conversely, the goods identified in association with the Class 041 Applications are as follows: “Entertainment services, namely, providing on-line computer games; Entertainment services, namely, providing temporary use of non-downloadable video games.” (See Serial Nos. 86/562,665 and 86/566,285.)

Applicant does not dispute the remainder of Opposer’s Paragraph 3, much of it, however, is immaterial and irrelevant.

***Opposer’s Statement of Facts, Paragraph 4:*** *On March 16, 2015, Applicant filed an application for registration of FRIV with the Office for Harmonization in the Internal Market’s Trade Marks and Designs Office (Application No. 013839287) to obtain a EU Community Mark. This EU Community Mark was registered on July 2, 2015 See Exhibit U, Printout of EU Community Mark. This mark was filed for use in association with “[e]ntertainment services, namely, providing on-line computer games; [e]ntertainment services, namely, providing temporary use of non-downloadable video games.”*

**Applicant’s Response:** Undisputed. Applicant has also received Australian Certificate of

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<sup>3</sup> E.g. 37 C.F.R. § 6.1:

9. Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire extinguishing apparatus.

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41. Education; providing of training; entertainment; sporting and cultural activities.

See also TMEP § 1401.02.

Registration No. 1,722,365 for the FRIV marks in International Class 041, registered on January 15, 2016 in the Intellectual Property Office of Australia. (See 10 TTABVUE at Ex. D.)

**Opposer's Statement of Facts, Paragraph 5:** *While these subsequently filed applications were pending, and on January 9 and 13, 2015, respectively, Applicant filed a Motion to Extend Discovery and to Withdraw and Amend Admissions and Reopen the Time to Respond to Discovery Requests. The Board denied Applicant's request to withdraw its admissions. Applicant then filed a Motion for Reconsideration and a Petition for Supervisory Review. Applicant's Motion was denied on October 30, 2015. Subsequently, on November 6, 2015, Applicant withdrew its application for registration. The Board entered judgment against Applicant on November 10, 2015.*

**Applicant's Response:** Immaterial and irrelevant but disputed. Applicant responds by incorporating its Response to Paragraph 2, *supra*, as if fully set forth in response to Paragraph 5.

**Opposer's Statement of Facts, Paragraph 6:** *While the instant opposition proceeding was pending, and on November 20, 2015, Applicant filed an arbitration proceeding with the National Arbitration Forum, which sought the transfer of the <friv.co> domain name from Opposer to Applicant under the limited terms of the Uniform Domain Name Dispute Resolution Policy ("UDRP"). See Exhibit V, UDRP Complaint. The sole basis for Applicant's request was its EU Community Mark registration, and Applicant deceptively failed to inform the UDRP panel of the ongoing proceedings with any factual specificity. Opposer filed a response, which argued that the dispute between the parties was outside of the limited scope of the UDRP. See Exhibit W, UDRP Response. On January 11, 2016, the Panel ruled in Applicant's favor, ignoring Opposer's arguments. Subsequently, the <friv.co> domain name was transferred to Applicant. See Exhibit Y, Notice of Decision..*

**Applicant's Response:** Disputed in part. Applicant does not dispute that, owing to Applicant's prior common law rights in the FRIV marks, on November 23, 2015 Applicant filed a complaint against Opposer's "friv.co" domain pursuant to the UDRP and sought to have Opposer's friv.co domain transferred to Applicant. (See, e.g., 10 TTABVUE at Ex. G; see also 11 TTABVUE at Ex. Y.) Likewise, Applicant does not dispute that the UDRP panel granted Applicant the remedy sought: "it is Ordered that the <friv.co> domain name be TRANSFERRED from [Opposer] to [Applicant]." (10 TTABVUE at Ex. G at 9). Finally, Applicant does not dispute that the UDRP panel found that (a) Opposer's friv.co domain is identical to Applicant's FRIV trademark in which Applicant has common law rights, (b) Opposer has no rights or legitimate interests in the friv.co domain name, and (c) that Opposer's friv.co domain name has been registered and is being used in bad faith. (See *id.* at 5.)

While the parties agree as to the foregoing, Applicant disputes the remainder of Opposer's

Paragraph 6. Specifically, Applicant disputes Opposer’s characterization of the UDRP proceeding as somehow “limited” or “outside of the limited scope of the UDRP.” Specifically, as recognized by the UDRP panel, in registering its knockoff friv.co domain, Opposer voluntarily agreed to be bound by the registration agreement, including “agree[ing] to resolve domain disputes brought by third parties in accordance with [the UDRP].” (*See id.* at 1.) This is precisely what the UDRP proceeding did—the UDRP panel resolved the dispute between Applicant and Opposer as to the friv.co domain. Not only is this legal and lawful in every sense, Opposer, of its own volition, contractually agreed to this exact procedure. Opposer cannot now be heard to complain about its own contractual agreements, least of all before the Board which lacks jurisdiction to resolve such matters. Likewise, Opposer had the right and every opportunity to challenge the UDRP panel decision through an appropriate jurisdiction. (*See id.* at 11.) Opposer, however, deliberately elected not to do so. (*See* 10 TTABVUE at Ex. H.) This was Opposer’s choice. Opposer cannot now be heard to complain about the adequacy of the UDRP procedure when it willingly waived the right to challenge the UDRP’s decision, least of all before the Board which again lack jurisdiction over such matters.

The foregoing is equally true of Opposer’s unsupported conjecture that the UDRP panel somehow “ignor[ed] Opposer’s arguments,” which is flatly false and unsupported by the record. (*See* 10 TTABVUE at Ex. G (carefully considering all of Opposer’s arguments)). In addition, Applicant disputes Opposer’s related conjecture that Applicant somehow failed to fully inform the UDRP panel of the underlying facts—the issues were fully briefed both legally and factually and the UDRP panel fully considered them. (*See id.*)

Finally, Applicant disputes Opposer’s suggestion that Applicant’s FRIV EU Community Mark Registration is the “sole basis for Applicant’s [UDRP] request....” Indeed, this is false. The UDRP panel decision itself explicitly states that it is based on Applicant’s common law rights, not the FRIV EU Community Mark Registration. (*See id.* at 6 (“The Panel notes that the registration of the disputed [friv.co] domain name predates [Applicant’s FRIV EU Community Mark Registration]. However,

[Applicant] may demonstrate rights through common law. .... The Panel finds that [Applicant] has common law rights in the [FRIV] mark....”).

### **APPLICANT’S STATEMENT OF ADDITIONAL RELEVANT FACTS**

In addition to the disputed facts discussed, *supra*, the following facts are also material to Opposer’s Cross-Motion:

1. Mr. McDonald, in order to set forth the facts surrounding his initial creation, selection and use of the FRIV marks starting in early 2004, has testified as follows:

a. Initially, I was self-employed and personally created, selected and began using the FRIV marks independent of any corporate organization. In 2010, however, I incorporated my business, Zyis Ltd., which business entity is the Applicant in the above-captioned proceeding and the current owner of the FRIV marks.

b. Before creating, selecting or using the FRIV marks, I had decided to create a universal entertainment / educational website with the aim of it becoming a trusted source for families and educators worldwide. By the spring of 2004, the Internet was well-established, and many recognizable and existing words had long-since been utilized within Internet domain names. As many recognizable and existing words were no longer available for use as new and unique domain names, or were otherwise prohibitively expensive, I began to consider various alternatives.

c. More specifically, at that time, I was self-employed and could not afford to pay the very high costs to acquire sought-after and / or recognizable domain names, or domain names based on words with a pre-defined meaning, which names / words inherently attract valuable organic search traffic.

d. In these circumstances, as I began to consider a unique domain name that I could afford, I was cognizant of the success of “Google” and other websites utilizing fanciful, arbitrary, or wholly made-up names / words as source identifiers.

e. Based on this awareness, I elected to pursue and was able to acquire in May 2004 the “friv.com” domain name. At the time, “friv” was simply a made-up, non-sense word which I created on the belief that it would be easy to pronounce, remember, and type, regardless of age, gender, nationality, or language. Simply put, I created the “friv.com” domain name from whole cloth—it was a wholly made-up name. This is further evidenced by the fact that, at the time I acquired the friv.com domain, there was a statistically insignificant number of Internet searches for “friv.” .... Due to the made-up nature of “friv,” and the insignificant number of searches for “friv,” I was able to acquire the friv.com domain with virtually no competition and for very little money, from memory, less than \$100. Even then, I knew I would be taking a risk using and investing in the friv.com domain, not knowing how the domain name would be received worldwide, including the risk that “friv” could potentially sound like an offensive word in various languages or countries around the world. In short, “friv” was completely made-up. Moreover, the FRIV marks do not and never have referred to computer games; rather, the FRIV marks are and always have been a source identifier for the domain friv.com.

f. Before using the FRIV marks, in early 2006, I began volunteering for Belmont Infant School, located in Durham, North-East England. As a volunteer, I worked alongside teachers assisting elementary age students in various scholastic activities and tasks.

g. As part of my volunteering experiences, I assisted students with various online activities, including educational games offered over the Internet. In doing so, I often encountered a need within the educational setting for a trusted source of family / classroom friendly online games and educational activities. Specifically, I frequently witnessed students that were routinely and repeatedly tricked by highly monetized websites into inadvertently clicking on ads rather than being easily allowed to access educational content and activities online, including games.

h. By late 2006, I had begun providing access to games via the website friv.com. In connection with making games available on the website friv.com, I adopted trade dress generally comprised of a purple background (mixing pink for females and blue for males), an “egg” shape incorporating the FRIV logo which “floated” over the game icons, a very enlarged or oversized mouse pointer, a green “up” arrow incorporating the number “250,” signifying the fact that 250 top rated games were offered via the “friv.com” website, and a green “return to menu” back arrow. Moreover, to appeal to users of all ages and languages, the friv.com website had no text on the home screen except the source identifier, comprising the FRIV marks.

i. At the time when I first began making computer games available through the friv.com website, promotion of the site was still prohibitively expensive and beyond my budget, particularly in U.S. and U.K. markets. As a result, I initially started marketing and promoting the friv.com website primarily in non-English-speaking countries, and particularly countries newer to the Internet with the hope of fostering viral growth. Notwithstanding my limited budget, I expended and invested considerable resources to market and promote the FRIV marks and brand and the friv.com website.

j. In January 2007, the friv.com website was independently discovered and promoted by stumbleupon.com, a popular sharing website devoted to discovering and promoting new websites. .... The notoriety gained in connection with the independent promotion offered through stumbleupon.com and other positive, third-party online reviews aided the growth and popularity of the friv.com website and consumer recognition of the FRIV marks and brand. I also began to expend and invest considerable sums of money to market and promote the FRIV marks and brand and the friv.com website.

k. By the end of 2010, Google listed “friv” as one of that year’s fastest rising search queries, alongside “iPad” and “Twitter.”

l. With the valuable brand recognition and attendant search traffic I had created in the FRIV brand, I first noticed in June 2008 that an individual had posted online that he / she wished to engage the services of a programmer stating, “I need a clone of friv.com.” From that point onwards, a number of copycat websites utilizing “friv” within their domain names began appearing with increasing frequency, sometimes blatantly including the FRIV logo, “friv.com,” “250,” and / or the FRIV trade dress in an effort to trick users into visiting the copycat websites, many of which are overloaded with banner ads, popups, adware, and other online monetization mechanisms (the “Infringing Websites”). Indeed, many of the Infringing Websites are superficial, appearing like “friv.com” upon first glance but failing to provide users with easy access to the games allegedly offered through the Infringing Websites, instead tricking users into inadvertently

clicking on ads rather than being able to access entertaining content and activities online, including games.

m. As a result of the continued success of friv.com, by early 2011, numerous websites with made-up four-letter names and designs closely mimicking the friv.com trade dress were cropping up with increasing frequency, with kizi.com and yepi.com being among the first. It appears that the brands “Kizi” and Yepi” are now themselves victims of numerous copycat websites – a list of websites that might run into hundreds.

n. As such Infringing Websites have become more and more pervasive, I have sought and have continued to work to register the FRIV marks throughout the world in an effort to protect the valuable brand recognition I have created therein and as a means of policing the FRIV marks. Nevertheless, limited resources have made it difficult to pursue and stop every infringement of the FRIV marks to date.

(See Ex. 1 (McDonald Decl.) at ¶¶ 4 – 17 & Exs. A – D.)

2. In view of Applicant’s original motion to dismiss (5 TTABVUE), the Board’s suspension of proceedings in view thereof (6 TTABVUE), and Applicant’s pending renewed Motion to Dismiss (10 TTABVUE) which will presumably result in an additional suspension of proceedings pursuant to Trademark Rule 2.127,<sup>4</sup> neither party has conducted any discovery to date whatsoever, including written discovery, deposition discovery, third party discovery, and so forth. (See Declaration of Brian Tucker in Support of Applicant’s Motion for Rule 56(d) Relief, attached hereto as **Exhibit “2”**, incorporated herein by this reference in its entirety.)

3. While entirely missing from Opposer’s “Statement of Facts,” the sole substantive evidence upon which Opposer’s Cross-Motion relies comprises various screen captures of materials obtained from the Internet. (See 11 TTABVUE at Exs. F-Q.)

4. Opposer’s various Internet materials, however, do not demonstrate genericness of the FRIV marks and brand from the outset or subsequent genericide of the FRIV marks; rather, such materials, at best, uniformly demonstrate (a) ongoing infringement of the FRIV marks and/or (b) use (whether legitimate or infringing) of either the FRIV marks or the letters “friv” in combination with other words/letters as source identifiers (including, but not limited to, uniform resource locators “URLs”), not as a synonym for the goods or services provided via such sources. (See *id.*) For example, Opposer’s Exhibit

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<sup>4</sup> See also TBMP § 528.03.

F denotes that “Friv.com is A Popular Free Games Network with Super Easy Games,” i.e., the FRIV marks, source identifiers for “friv.com,” points to *a source* for a popular free games network and super easy games. (11 TTABVUE at Ex. F.) Opposer’s Exhibit F continues throughout its body to refer to “friv.com” as “a free online gaming *site*” which offers access to various games—never once does it indicate that a “friv” is a “computer game.” (*Id.* (emphasis added)). The same is true of Opposer’s Exhibit G: “Friv” is “[a] gaming *site* dedicated to a page of mini games ranging in type, style and content.” (*Id.* at Ex. G (emphasis added)). Again, Opposer’s Exhibit G denotes that the FRIV marks points to a source (the site friv.com) for mini games—nowhere does it define a “friv” as a “computer game.” (*Id.*) The same analysis is true of each and every one of Opposer’s remaining Internet material exhibits—each and every exhibit demonstrates (a) ongoing infringement of the FRIV marks and/or (b) use (whether legitimate or infringing) of either the FRIV marks or the letters “friv” in combination with other words/letters as source identifiers, not as a synonym for the goods or services provided via such sources. (*Id.* at Ex. H-Q.)

5. Aside from the foregoing, some of Opposer’s Internet materials are unauthenticated inadmissible evidence upon which Opposer is prohibited from relying in order to establish the alleged absence of a dispute of material fact. *See* FED. R. CIV. P. 56(c)(1)(B); 56(c)(2); 56(e); *see also* TBMP 528.05(e). For example, Opposer’s Exhibit G neglects to provide either a URL or the date on which it was either published or last accessed. (11 TTABVUE at Ex. G.) As such, Exhibit G is un-authenticated and inadmissible and cannot be relied on for purposes of summary judgment. *See* FED. R. CIV. P. 56(c)(1)(B); 56(c)(2); 56(e); TBMP 528.05(e). The same is true of Opposer’s Exhibits I, O and Q. (11 TTABVUE at Exs. I, O and Q.)

6. Regardless, “printed publications are only admissible for what they show on their face, and not as proof of any facts asserted therein.” TBMP 528.05(e); *see also* *Boyd’s Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017, 2020 n.8 (TTAB 2008). As such, all of Opposer’s substantive exhibits derived from the Internet (11 TTABVUE at Exs. F-Q) are inadmissible to show anything beyond what they facially state—any “facts” presented in all such materials are inadmissible and cannot be used



to establish the alleged absence of a dispute of material fact. *See* TBMP 528.05(e); *see also* *Boyd's Collection*, 65 USPQ2d at n.8; FED. R. CIV. P. 56(c)(1)(B); 56(c)(2); 56(e). To this end, many of Opposer's substantive exhibits derived from the Internet are both inadmissible and meaningless inasmuch as they don't facially state anything beyond showing infringement of the FRIV marks, such as Opposer's Exhibit I, K, O, P, and Q, and, albeit indirectly, Opposer's Exhibits H, J, L, M, and N. (11 TTABVUE at Exs. H, I, J, K, L, M, N, O, P and Q.)

7. Simply put, none of Opposer's exhibits, or "evidence," if even admissible, shows the use of the FRIV marks in a generic way; rather, all such exhibits, at most, show use of the FRIV marks in URLs, i.e., as source identifiers. (*Id.* at Exs. F-Q.) And, the mere fact that there exists copycats and infringement of the FRIV marks (*id.*) does not equate to genericness—indeed, were it otherwise, many (if not all) famous marks would be generic as such marks are routinely knocked-off or copied via unauthorized domain names, particularly in other countries, which is the type of routine infringement that The UDRP was created to combat.<sup>5</sup> The mere fact that Applicant cannot afford to immediately shut down every infringing website has no bearing on the alleged genericness of the FRIV marks.

8. Regardless, Opposer has failed to offer any actual evidence that the FRIV marks are used generically—there is no evidence before the Board whatsoever that consumers think a "friv" is a "computer game" and *vice versa*. Indeed, Opposer has failed to offer even a single piece of evidence showing any use of the word "friv," let alone as a generic term for a computer game, before Applicant created the friv.com website in 2004 and established valuable brand recognition in the FRIV marks over the ensuing years. (*See* Ex. 1 (McDonald Decl.) at ¶¶ 4 – 17.) Indeed, Opposer has failed to identify even a single website which used the FRIV marks or the word "friv" prior to Applicant's creation of the FRIV marks and establishment of valuable brand recognition therein, including, but not limited to, Opposer's former knockoff "friv.co" website, which has been transferred to Applicant. (*See id.* at ¶ 15.)

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<sup>5</sup> The Board may take judicial notice of the existence of the UDRP; *see also, e.g.*, Ex. 1 (McDonald Decl.) at ¶¶ 15 – 17.

9. Moreover, some of the infringing websites Opposer relies on not only infringe the FRIV marks, the websites fail (or make it very difficult) to even access a game, often tricking users into inadvertently clicking on ads rather than being able to access entertaining content and activities online, including games. (*See id.*)

10. Beyond the exhibits attached to Opposer's Cross-Motion, the United States Patent and Trademark Office (the "USPTO") has already conducted a preliminary examination of the FRIV marks and, by virtue of publishing the Class 041 Applications, the USPTO has already made a threshold determination that the FRIV marks are not generic. (*See* Application Serial Nos. 86/562,665 and 86/566,285.)

11. Moreover, Applicant's FRIV marks are not generic as evidenced by at least (1) European Community Certificate of Registration No. 013839287 for the FRIV marks in International Class 041, registered on July 2, 2015 in the Office for Harmonization in the Internal Market, Trade Marks and Designs Office, and (2) Australian Certificate of Registration No. 1,722,365 for the FRIV marks in International Class 041, registered on January 15, 2016 in the Intellectual Property Office of Australia. (*See* 10 TTABVUE at Exs. C and D.)

## **ARGUMENT**

### **I. OPPOSER'S CROSS-MOTION MUST BE DENIED WHERE THE BOARD LACKS JURISDICTION TO RESOLVE THE SAME**

As discussed above, Applicant has filed a Motion to Dismiss which currently remains pending. (*See* 10 TTABVUE.) Critically, Applicant's Motion to Dismiss is not coextensive with Opposer's Cross-Motion; instead, Applicant's Motion to Dismiss pre-empts Opposer's Cross-Motion. Specifically, the Motion to Dismiss is premised on Opposer's lack of standing as Opposer has neither pleaded nor shown any damage which it will suffer if Applicant's FRIV marks are registered. (*See id.*) As the Motion to Dismiss presents a jurisdictional issue which cannot be waived and can be raised at any time, Applicant's Motion to Dismiss must be addressed and resolved before the Board could even consider the merits of the Opposer's claim for relief. Indeed, for the reasons set forth within the Motion to Dismiss, Opposer's

Notice of Opposition should either be dismissed or summarily adjudicated in Applicant's favor thereby terminating this proceeding and allowing the Class 041 Applications to register. Thus, to the extent the Board grants Applicant's Motion to Dismiss, Opposer's Cross-Motion must be denied.

## **II. OPPOSER'S CROSS-MOTION MUST BE DENIED WHERE ALL OF THE EVIDENCE OF RECORD BELIES OPPOSER'S "GENERICNESS" ARGUMENTS**

Assuming *arguendo* that the Board considers the merits of Opposer's Cross-Motion, the central and sole premise of Opposer's Cross-Motion (and Notice of Opposition) is that Applicant's FRIV marks are generic. (*See* 1 & 11 TTABVUE.) Accordingly, absent a finding of genericness, not only should Opposer's Cross-Motion be denied, Opposer's entire case should be dismissed. Simply put, Opposer's entire case rises and falls based solely on an analysis of genericness. (*See id.*) Indeed, Opposer has not even pleaded genericide over time; rather, Opposer's case requires a showing of genericness from the outset. (*See id.*)

To this end, the parties agree that "[a] name of a thing cannot be a trademark for that thing." (11 TTABVUE at 10 (citing 2 McCarthy on Trademarks and Unfair Competition § 12:1)). Moreover, the parties agree that the test for determining genericness is a two-step inquiry: "First, what is the genus of goods or services at issue? Second, is the term sought to be registered .... understood by the relevant public primarily to refer to that genus of goods or services?" *H. Marvin Ginn Corp. v International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986).

In the context of summary judgment, the parties also agree that it is only appropriate where there are no genuine disputes as to *any* material facts, thus allowing the case to be resolved as a matter of law. FED. R. CIV. P. 56(a). Moreover, the party seeking summary judgment bears the burden of demonstrating the absence of any genuine dispute of material fact, and that it is entitled to a judgment under the applicable law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). And, this burden is greater than the evidentiary burden at trial. *See* TBMP § 528.01. Finally, evidence on summary judgment must be viewed in a light most favorable to the non-movant, with all justifiable inferences drawn in the non-movant's favor and the Board's resolution limited to ascertaining whether genuine factual disputes exist

(as opposed to resolving such disputes). *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993).

Under the foregoing standards, Opposer's Cross-Motion should be denied and Opposer's entire case should be dismissed. Specifically, as set forth in Applicant's Response to Opposer's "Statement of Facts" ("Response" or "Responses") and Applicant's Statement of Additional Relevant Facts ("Additional Facts"), *supra*, Applicant vehemently disputes "that FRIV is a generic term and that the relevant purchasing public understands the designation FRIV to primarily refer to the genus of short computer games playable on the Internet." (*See* Response, ¶1.) To begin with, Opposer's so-called "facts" fail to set forth even a single shred of evidence of genericness. (*See id.*) This alone mandates denial of Opposer's Cross-Motion. *See* FED. R. CIV. P. 56(c) & (e); *see also Anderson*, 477 U.S. at 248 & 256 (in the context of summary judgment litigants "may not rest upon the mere allegations ... of his pleadings, but must set forth specific facts....").

Moreover, and more importantly, Mr. McDonald, has testified as follows:

[I]n May 2004 ... I elected to pursue and was able to acquire ... the "friv.com" domain name. At the time, "friv" was simply a made-up, non-sense word which I created on the belief that it would be easy to pronounce, remember, and type, regardless of age, gender, nationality, or language. Simply put, I created the "friv.com" domain name from whole cloth—it was a wholly made-up name. .... In short, "friv" was completely made-up. Moreover, the FRIV marks do not and never have referred to computer games; rather, the FRIV marks are and always have been a source identifier for the domain friv.com.

(*See* Ex. 1 (McDonald Decl.) at ¶ 8; *see also id.* at ¶¶ 4-7.) Mr. McDonald's testimony clearly evidences a dispute of fact as to the alleged genericness of Applicant's FRIV marks. (*See id.*) Thus, not only does Mr. McDonald's testimony alone require denial of Opposer's Cross-Motion, Mr. McDonald's testimony shows, on the contrary, that the FRIV marks are not generic, least of all from when Mr. McDonald first coined the word "friv." (*See id.*) As such, Opposer's case should be dismissed.

In addition, while conspicuously absent from Opposer's alleged facts, the only substantive evidence upon which Opposer's Cross-Motion relies comprises clandestine screen captures of materials obtained from the Internet. (*See* 11 TTABVUE at Exs. F-Q.) Opposer's various Internet materials,

however, do not demonstrate genericness of the FRIV marks. (*See* Additional Facts, ¶¶ 4-9.) Instead, Opposer’s alleged evidence of genericness actually shows that the FRIV marks are never used generically to refer to computer games or associated services. For example, Opposer’s Exhibit F denotes that “Friv.com is A Popular Free Games Network with Super Easy Games,” i.e., the FRIV marks, source identifiers for “friv.com,” points to *a source* for a popular free games network and super easy games. (11 TTABVUE at Ex. F.) Opposer’s Exhibit F continues throughout its body to refer to “friv.com” as “a free online gaming *site*” which offers access to various games—never once does it indicate that a “friv” is a “computer game.” (*Id.* (emphasis added)). The same is true of Opposer’s Exhibit G: “Friv” is “[a] gaming *site* dedicated to a page of mini games ranging in type, style and content.” (*Id.* at Ex. G (emphasis added)). Again, Opposer’s Exhibit G denotes that the FRIV marks points to a source (the site friv.com) for mini games—nowhere does it define a “friv” as a “computer game.” (*Id.*) The same analysis is true of each and every one of Opposer’s remaining Internet material exhibits.

Moreover, regardless of what appears on Opposer’s Internet material exhibits, such evidence is unauthenticated, inadmissible, and may not be used as proof of any “facts” allegedly found therein. (*See* Additional Facts, ¶¶ 5-6.)

At bottom, none of Opposer’s exhibits, or “evidence,” if even admissible, show use of the FRIV marks in a generic way; rather, all such exhibits, at most, show use of the FRIV marks in URLs, i.e., as source identifiers. (11 TTABVUE at Exs. F-Q.) The mere fact that there exists copycats and infringement of the FRIV marks (*id.*) does not equate to genericness. Were it otherwise, every robust mark would be “generic” immediately upon any infringement thereof. This is not the law. Regardless, Opposer has failed to offer any actual evidence that the FRIV marks are used generically—there is no evidence before the Board whatsoever that consumers think a “friv” is a “computer game” and *vice versa*. And, the non-genericness of Applicant’s FRIV marks is further evidenced by the records of the USPTO as well as registrations granted in Europe and Australia. (*See* Additional Facts, ¶¶ 10-11.) Conclusory attorney argument cannot sustain Opposer’s burden of proving genericness.

In view of the foregoing, Opposer’s Cross-Motion must be denied. At a minimum, there exists a dispute of fact as to the alleged genericness of Applicant’s FRIV marks. In reality, Applicant’s evidence coupled with Opposer’s best evidence, all show that FRIV is not generic. Accordingly, not only should the Cross-Motion be denied based on a dispute of fact, it must be denied on the merits as well and Opposer’s Notice of Opposition should be summarily dismissed.<sup>6</sup>

**III. OPPOSER’S RELIANCE ON PROCEDURAL MATTERS IN THE CLASS 009 APPLICATION ARE UNAVAILING AND SHOULD BE DISREGARDED ENTIRELY**

**A. Opposer’s Reliance on Admissions Under Rule 36 in the Class 009 Application Matter is Expressly Forbidden Under the Express Terms of Rule 36**

Beyond the absence of any evidence in support of genericness, discuss *supra*, Opposer’s Cross-Motion relies exclusively on alleged admissions in the Class 009 Application matter, both for their own merit and in order to support Opposer’s issue/claim preclusion argument. This approach is fundamentally flawed and must be rejected.

To begin with, the Class 009 Application matter, itself, is wholly irrelevant to this matter, which is limited to the Class 041 Applications. Further to this point, and critically for purposes of Opposer’s Cross-Motion, Rule 36 explicitly limits the use of admissions thereunder to “purposes of the pending action only.” FED. R. CIV. P. 36(a)(1). Rule 36 continues: “An admission under this rule is not an admission for any other purpose and cannot be used against the party in any other proceeding.” *Id.* at 36(b). The plain meaning of Rule 36 cannot be dispute—Opposer is forbidden from using admissions in another matter as evidence of record in this matter. *Id.* Support for his legal maxim abounds.<sup>7</sup>

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<sup>6</sup> For the identical reasons, Opposer’s entire “acquired distinctiveness” argument (11 TTABVEU at 18-19) is moot.

<sup>7</sup> See also TBMP § 407.02 (Scope and Nature of Requests for Admission); TBMP § 407.04 (Effect of Admission); 7 JAMES WM. MOORE ET AL., *Moore’s Federal Practice* § 36.03[3] (3d ed. 2013) (“An admission made under Rule 36 is for the purpose of the pending action only, and cannot be used as an admission in any other proceeding,” thus “admissions made in accordance with Rule 36 have no collateral estoppel effect.”); *In re Pizante*, 186 B.R. 484, 489 (9th Cir. 1995), *aff’d without op.*, 107 F.3d 878 (9th Cir. 1997) (limiting use of admissions deemed admitted by operation of law solely to the matter in which the requests for admission were issued and excluding use of such admissions in a related matter – “Rule 36 encourages admissions, and thus reduces the burden of litigation, by limiting the effect of those admissions to the pending action only.”); *Kohler v. Leslie Hindman, Inc.*, 80 F.3d 1181, 1185 (7th Cir.

Opposer's Cross-Motion does not rely on a single admission (or other discovery response) in this matter. Indeed, neither party has engaged in any discovery in this case to date. (*See* Additional Facts, ¶ 2; *see also* Responses, ¶ 2.) As such, the admissions on which Opposer relies come solely from the Class 009 Application matter. Thus, under the plain and strict requirements of Rule 36, the Board is obligated to ignore and disregard the "admissions" evidence upon which Opposer improperly attempts to rely. Such evidence is inadmissible.

**B. Aside from Opposer's Improper Reliance on Unrelated Admissions, Opposer's "Issue Preclusion" Arguments are Without Merit Where Genericness Was Never Litigated and Adjudicated in the Class 009 Application Matter**

Not only must the Board ignore and disregard the "admission" evidence, Opposer's issue/claim preclusion arguments are equally without merit. To begin with, as recited in Opposer's Cross-Motion, issue preclusion only applies when (1) the issue to be determined is identical to the issue involved in the prior litigation, (2) the issue was raised, litigated, and actually adjudged in the prior action, (3) the determination of the issue was necessary and essential to the resulting judgment, and (4) the party precluded was fully represented in the prior action. *See Mother's Restaurant, Inc. v. Mama's Pizza, Inc.*, 723 F.2d 1566, 1569-70 (Fed. Cir. 1983). At least the first three of these requirements are not met here mandating rejection of this argument.

Specifically, as discussed above, the central and sole premise of Opposer's Cross-Motion is that Applicant's FRIV marks are generic. While "genericness" was pleaded in the Class 009 Application matter, it was not and could not be identical to the issue involved in this matter. Specifically, the Class 041 Applications at issue in this matter relate to *services* while the Class 009 Application, on the other hand, relate to *goods*. (*See* Responses, ¶ 3.) As such, the alleged "genericness" of the FRIV marks as it pertains to services was never at issue in the Class 009 Application matter. More importantly, "genericness," even if at issue broadly in the Class 009 Application matter, was certainly never litigated

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1996) ("a statement made [under Rule 36] in one lawsuit cannot be a judicial admission in another"); *Kolar, Inc. v. United States*, 650 F.2d 256, 263 (Ct. Cl. 1981) ("Plaintiff's attempt to make the admissions made in district court [under Rule 36] binding in this action is utterly devoid of merit").

or actually adjudged in the Class 009 Application matter. Rather, as acknowledged by Opposer, the Class 009 Application was simply withdrawn. The Board never entered a judgment making any findings of fact or conclusions of law about the issue of genericness. Indeed, as to the third element of the relevant legal test, the issue of genericness is never addressed in the Board's judgment in the Class 009 Application matter and was neither necessary nor essential to that judgment.

Simply put, the central issue—the alleged genericness of the FRIV marks—has never been litigated or adjudged and issue preclusion does not attach here.

**IV. IF OPPOSER'S CROSS-MOTION IS NOT DENIED, APPLICANT IS ENTITLED TO RELIEF UNDER RULE 56(d) IN THE FORM OF ADDITIONAL DISCOVERY NECESSARY TO MORE FULLY OPPOSE THE CROSS-MOTION**

Rule 56(d) provides as follows:

(d) WHEN FACTS ARE UNAVAILABLE TO THE NONMOVANT. If a nonmovant shows by affidavit or declaration that, for specified reasons, it cannot present facts essential to justify its opposition, the court may: (1) defer considering the motion or deny it; (2) allow time to obtain affidavits or declarations or to take discovery; or (3) issue any other appropriate order.

FED. R. CIV. P. 56(d). Similarly, Section 528.06 of the TBMP states that “A party that believes that it cannot effectively oppose a motion for summary judgment without first taking discovery may file a request with the Board for time to take the needed discovery.”

This case is in its virtual infancy. Specifically, Opposer's Notice of Opposition was filed on August 5, 2015. (1 TTABVUE.) Shortly thereafter, Applicant answered the Notice of Opposition on September 14, 2015 and quickly moved to dismiss. (4 & 5 TTABVUE.) Owing to Applicant's original motion to dismiss, proceedings were suspended. (6 TTABVUE.) Shortly after proceedings were resumed, Applicant filed the dispositive renewed Motion to Dismiss, which was followed by Opposer's Cross-Motion for summary judgment. (10 & 11 TTABVUE.) While a second suspension order has yet to be entered, Trademark Rule 2.127 requires a suspension of proceedings while these dispositive motions are resolved. *See also* TBMP § 528.03. As such, the opening of discovery has been forestalled and neither party has conducted any discovery in this case to date. (*See* Additional Facts, ¶ 2.) However, if Opposer's



Cross-Motion is not dismissed, Applicant is both entitled to conduct discovery and will require additional discovery to more fully oppose the Cross-Motion. (*See* Ex. 2.) For example, Opposer's Cross-Motion relies on a single declaration from J. Nader. (*See* 11 TTABVUE at Ex. X.) Applicant has never had the opportunity to depose Mr. Nader in this matter, let alone about the topics specifically addressed in his declaration. (*See* Ex. 2.) Likewise, Applicant has never had the opportunity to take discovery related to any of Opposer's so-called internet materials. (*See id.*) Discovery related to such documents is essential for Applicant to more fully address disputes of fact related thereto, including even authenticating such evidence. (*See id.*)

In short, if Opposer's Cross-Motion is not denied or the Notice of Opposition Dismissed, Applicant respectfully requests that the Board defer consideration of the Cross-Motion or deny the motion without prejudice in order to permit discovery to proceed according to the normal course of litigation.

#### **CONCLUSION**

For all of the foregoing reasons, Opposer's Cross-Motion should be denied. First, as Opposer lacks standing to maintain this action from the outset, the Board no longer has jurisdiction to resolve the Cross-Motion. Regardless, on its merit, the Cross-Motion fails. Simply put, all evidence of record belies Opposer's conclusory allegations of genericness of the FRIV marks. However, if the Cross-Motion is not denied, Applicant respectfully requests continuance of its resolution pending discovery and additional briefing.

DATED this 1<sup>st</sup> day of March, 2016.

Respectfully submitted,

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*Attorneys for Applicant Zyis Ltd.*

**CERTIFICATE OF SERVICE**

I hereby certify that on this the 1<sup>st</sup> day of March, 2016, I caused a copy of the foregoing **APPLICANT ZYIS LTD.'S MEMORANDUM IN OPPOSITION TO OPPOSER JAVIER RODRIGUEZ, LLC'S CROSS-MOTION FOR SUMMARY JUDGMENT OR, IN THE ALTERNATIVE, MOTION FOR RULE 56(d) RELIEF** to be (1) filed utilizing the ESTTA filing system which provides service to all counsel registered thereon and (2) served on the attorneys of record for Opposer, as designated below, via email pursuant to the parties' agreement to accept email service:

John Di Giacomo  
Eric Misterovich  
Revision Legal, PLLC  
109 E. Front St., Suite 309  
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[eric@revisionlegal.com](mailto:eric@revisionlegal.com)

*/Brian D. Tucker/*  
\_\_\_\_\_

Opposition No. 91223142  
*Javier Rodriguez, LLC v. Zyis LTD*

# Exhibit 1

Exhibit 1 to Applicant's Motion for Rule 56(d) Relief

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

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JAVIER RODRIGUEZ, LLC,

OPPOSER,

v.

ZYIS LTD.,

APPLICANT.

OPPOSITION NO. 91223142

Marks: FRIV

Serial Nos. 86/562,665 & 86/566,285

Published August 4, 2015

**DECLARATION OF JAMES IAN MCDONALD IN SUPPORT OF  
APPLICANT'S MEMORANDUM IN OPPOSITION TO OPPOSER'S CROSS-  
MOTION FOR SUMMARY JUDGMENT**

I, James Ian McDonald, hereby declare and state under penalty of perjury under the laws of the United States of America as follows:

1. I am a citizen of the United Kingdom, am over the age of twenty-one, and am competent to testify as to the matters set forth herein and would do so truthfully if so called upon.

2. I am currently the Company Director of Applicant, Zyis Ltd. ("Applicant").

3. I have prepared this declaration in support of Applicant's Memorandum in Opposition to Opposer Javier Rodriguez, LLC's ("Opposer") Cross-Motion for Summary Judgment (the "Cross-Motion"), which Cross-Motion is premised solely on Opposer's allegations that the FRIV marks at issue (Serial Nos. 86/562,665 & 86/566,285, collectively the "FRIV" marks) are allegedly "generic."

4. More specifically, I have prepared this declaration to set forth my testimony regarding my initial creation, selection and use of the FRIV marks starting in early 2004. Initially, I was self-employed and personally created, selected and began using the FRIV marks independent of any corporate

organization. In 2010, however, I incorporated my business, Zyis Ltd., which business entity is the Applicant in the above-captioned proceeding and the current owner of the FRIV marks.

5. Before creating, selecting or using the FRIV marks, I had decided to create a universal entertainment / educational website with the aim of it becoming a trusted source for families and educators worldwide. By the spring of 2004, the Internet was well-established, and many recognizable and existing words had long-since been utilized within Internet domain names. As many recognizable and existing words were no longer available for use as new and unique domain names, or were otherwise prohibitively expensive, I began to consider various alternatives.

6. More specifically, at that time, I was self-employed and could not afford to pay the very high costs to acquire sought-after and / or recognizable domain names, or domain names based on words with a pre-defined meaning, which names / words inherently attract valuable organic search traffic.

7. In these circumstances, as I began to consider a unique domain name that I could afford, I was cognizant of the success of “Google” and other websites utilizing fanciful, arbitrary, or wholly made-up names / words as source identifiers.

8. Based on this awareness, I elected to pursue and was able to acquire in May 2004 the “friv.com” domain name. At the time, “friv” was simply a made-up, non-sense word which I created on the belief that it would be easy to pronounce, remember, and type, regardless of age, gender, nationality, or language. Simply put, I created the “friv.com” domain name from whole cloth—it was a wholly made-up name. This is further evidenced by the fact that, at the time I acquired the friv.com domain, there was a statistically insignificant number of Internet searches for “friv.” (See [www.google.co.uk/trends/explore?q=friv](http://www.google.co.uk/trends/explore?q=friv), screen capture attached as **Exhibit “A”** hereto.) Due to the made-up nature of “friv,” and the insignificant number of searches for “friv,” I was able to acquire the friv.com domain with virtually no competition and for very little money, from memory, less than \$100. Even then, I knew I would be taking a risk using and investing in the friv.com domain, not knowing how

the domain name would be received worldwide, including the risk that “friv” could potentially sound like an offensive word in various languages or countries around the world. In short, “friv” was completely made-up. Moreover, the FRIV marks do not and never have referred to computer games; rather, the FRIV marks are and always have been a source identifier for the domain friv.com.

9. Before using the FRIV marks, in early 2006, I began volunteering for Belmont Infant School, located in Durham, North-East England. As a volunteer, I worked alongside teachers assisting elementary age students in various scholastic activities and tasks.

10. As part of my volunteering experiences, I assisted students with various online activities, including educational games offered over the Internet. In doing so, I often encountered a need within the educational setting for a trusted source of family / classroom friendly online games and educational activities. Specifically, I frequently witnessed students that were routinely and repeatedly tricked by highly monetized websites into inadvertently clicking on ads rather than being easily allowed to access educational content and activities online, including games.

11. By late 2006, I had begun providing access to games via the website friv.com. In connection with making games available on the website friv.com, I adopted trade dress generally comprised of a purple background (mixing pink for females and blue for males), an “egg” shape incorporating the FRIV logo which “floated” over the game icons, a very enlarged or oversized mouse pointer, a green “up” arrow incorporating the number “250,” signifying the fact that 250 top rated games were offered via the “friv.com” website, and a green “return to menu” back arrow. Moreover, to appeal to users of all ages and languages, the friv.com website had no text on the home screen except the source identifier, comprising the FRIV marks.

12. At the time when I first began making computer games available through the friv.com website, promotion of the site was still prohibitively expensive and beyond my budget, particularly in U.S. and U.K. markets. As a result, I initially started marketing and promoting the friv.com website

primarily in non-English-speaking countries, and particularly countries newer to the Internet with the hope of fostering viral growth. Notwithstanding my limited budget, I expended and invested considerable resources to market and promote the FRIV marks and brand and the friv.com website.

13. In January 2007, the friv.com website was independently discovered and promoted by stumbleupon.com, a popular sharing website devoted to discovering and promoting new websites. (See <http://www.stumbleupon.com/content/8RRVph>, screen capture attached as **Exhibit “B”** hereto.) The notoriety gained in connection with the independent promotion offered through stumbleupon.com and other positive, third-party online reviews aided the growth and popularity of the friv.com website and consumer recognition of the FRIV marks and brand. I also began to expend and invest considerable sums of money to market and promote the FRIV marks and brand and the friv.com website.

14. By the end of 2010, Google listed “friv” as one of that year’s fastest rising search queries, alongside “iPad” and “Twitter.” (See <http://www.google.com/intl/en/press/zeitgeist2010/#queries>, screen capture attached as **Exhibit “C”** hereto.)

15. With the valuable brand recognition and attendant search traffic I had created in the FRIV brand, I first noticed in June 2008 that an individual had posted online that he / she wished to engage the services of a programmer stating, “I need a clone of friv.com.” (See [http://www.getacoder.com/projects/friv\\_clone\\_79415.html](http://www.getacoder.com/projects/friv_clone_79415.html) and [http://www.getacoder.com/requests/all\\_requests\\_0.htm?advancedsearch=0&t=friv+clone&b=0](http://www.getacoder.com/requests/all_requests_0.htm?advancedsearch=0&t=friv+clone&b=0), screen captures collectively attached as **Exhibit “D”** hereto.) From that point onwards, a number of copycat websites utilizing “friv” within their domain names began appearing with increasing frequency, sometimes blatantly including the FRIV logo, “friv.com,” “250,” and / or the FRIV trade dress in an effort to trick users into visiting the copycat websites, many of which are overloaded with banner ads, popups, adware, and other online monetization mechanisms (the “Infringing Websites”). Indeed, many of the Infringing Websites are superficial, appearing like “friv.com” upon first glance but failing to provide



users with easy access to the games allegedly offered through the Infringing Websites, instead tricking users into inadvertently clicking on ads rather than being able to access entertaining content and activities online, including games.

16. As a result of the continued success of friv.com, by early 2011, numerous websites with made-up four-letter names and designs closely mimicking the friv.com trade dress were cropping up with increasing frequency, with kizi.com and yepi.com being among the first. It appears that the brands “Kizi” and Yepi” are now themselves victims of numerous copycat websites – a list of websites that might run into hundreds.

17. As such Infringing Websites have become more and more pervasive, I have sought and have continued to work to register the FRIV marks throughout the world in an effort to protect the valuable brand recognition I have created therein and as a means of policing the FRIV marks. Nevertheless, limited resources have made it difficult to pursue and stop every infringement of the FRIV marks to date.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed on this 1<sup>st</sup> day of March, 2016.

BY: /s/James I. McDonald  
James I. McDonald

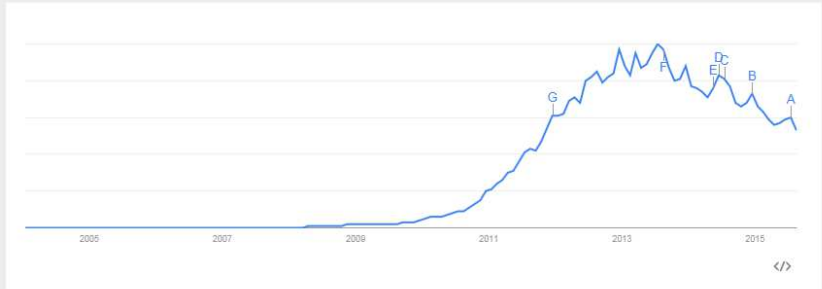
Opposition Number: 91223142  
*JAVIER RODRIGUEZ, LLC v. ZYIS LTD.*

# Exhibit A

Exhibit A to Declaration of James Ian McDonald in  
Support of Applicant's Memorandum in Opposition  
to Opposer's Cross-Motion for Summary Judgment

Compare

Interest over time  News headlines  forecast



Regional interest



Related searches

Topics	Top	Rising	Queries	Top	Rising
Games - TV Genre	100		friv juegos	100	
Barbie - Collection category	5		juegos	100	
Mario - Fictional Character	0		juegos de friv	40	
Kitchen - Accommodation feature	0		friv jogos	20	
			jogos	20	
			friv games	15	
			friv 2	10	

Opposition Number: 91223142  
*JAVIER RODRIGUEZ, LLC v. ZYIS LTD.*

# Exhibit B

Exhibit B to Declaration of James Ian McDonald in  
Support of Applicant's Memorandum in  
Opposition to Opposer's Cross-Motion for  
Summary Judgment



# Friv : ONLY THE VERY BEST FREE ONLINE GAMES!

517K views | friv.com

Interest

ONLINE GAMES



Discovered by ayse on Jan 22, 2007



40K Likes

361 Comments

23 Lists



## Stumblers Who Like This Page

Feedback


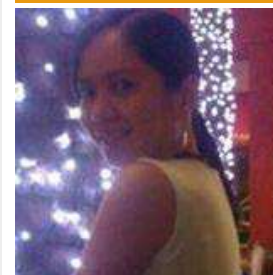
659 Likes  
0 Lists  
4 Followers

coraldrury  
coral



7 Likes  
1 Lists  
1 Followers

predragvesic31  
Predrag Vesic


2 Likes  
1 Lists  
3 Followers

lamPolet  
Polet Chiuco-Perez

328 Likes  
0 Lists  
4 Followers

hemz120  
hemi  
young fun outgoing down to earth party animal!




1,644 Likes



2,001 Likes



109 Likes



536 Likes



0  
Lists  
18  
Followers

**madman514**

madman514



0  
Lists  
3  
Followers

**zorduk**

Marco



1  
Lists  
4  
Followers

**GeneralGist**

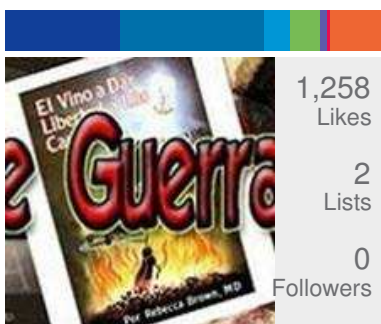
GeneralGist  
drummer from oz



0  
Lists  
5  
Followers

**davon84**

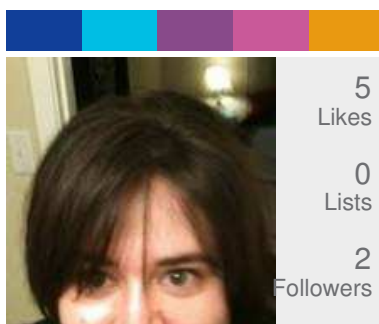
Adrian



1,258  
Likes  
2  
Lists  
0  
Followers

**freddyb21**

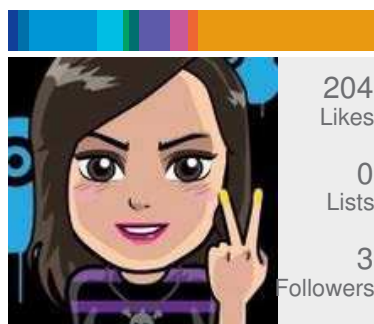
freddy  
como estan



5  
Likes  
0  
Lists  
2  
Followers

**ajbrinlee**

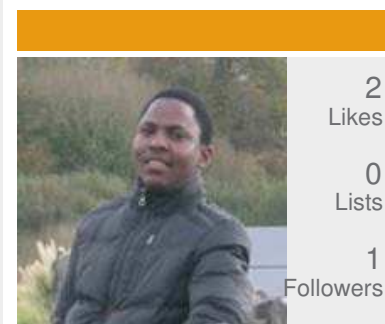
ajbrinlee



204  
Likes  
0  
Lists  
3  
Followers

**Hort24**

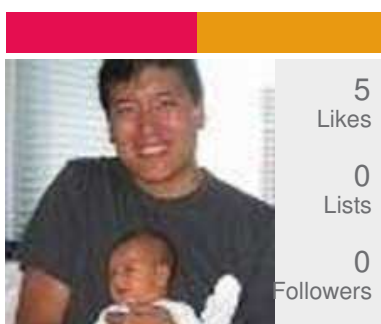
HR  
Simpatia  
sorria e finja q esta tudo bem ;



2  
Likes  
0  
Lists  
1  
Followers

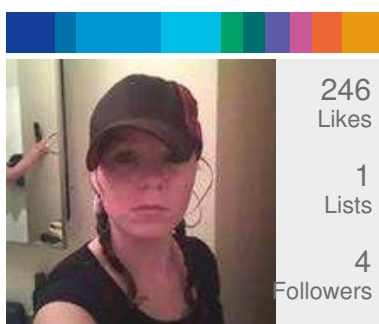
**GOODLUCK4EVER**

GOODLUCK4EVER



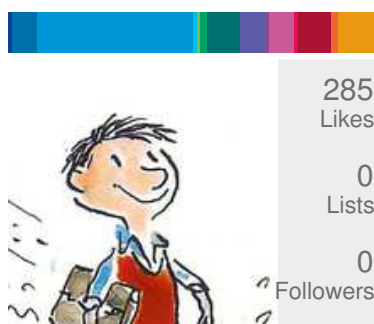
5  
Likes  
0  
Lists  
0  
Followers

**pokister**



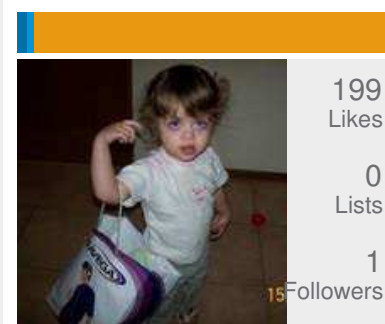
246  
Likes  
1  
Lists  
4  
Followers

**xdjsnowwhitex**



285  
Likes  
0  
Lists  
0  
Followers

**hamma77**



199  
Likes  
0  
Lists  
1  
Followers

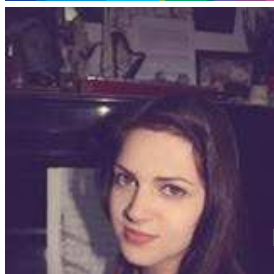
**alfredoj**

pokister

Tiffany

hamma77

alfredo



1,024 Likes

0 Lists

9 Followers

LadyCat83

LadyCat



88 Likes

2 Lists

1 Followers

koshars

koshars



1,305 Likes

0 Lists

9 Followers

jprader

J Patrick



882 Likes

0 Lists

5 Followers

tarroman

Tareq



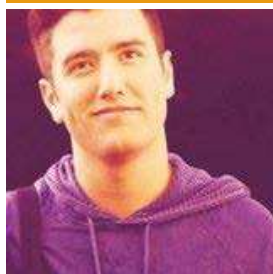
105 Likes

0 Lists

13 Followers

RyzRYthm09

Ryan Spear



2 Likes

0 Lists

0 Followers

dajanazrnic7

Dajana



113 Likes

1 Lists

2 Followers

ladyfire24

ladyfire24



73 Likes

0 Lists

2 Followers

sipylos

sipylos







20 Likes

1 Lists

0 Followers

**HUKENI4UGANI**

HUKENI4UGANI



72 Likes

0 Lists

0 Followers

**petercah**

petercah



932 Likes

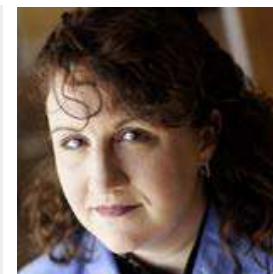
0 Lists

270 Followers

**natalince**

Natasha

The distinction between past, present and future is only a stubbornly persistent...



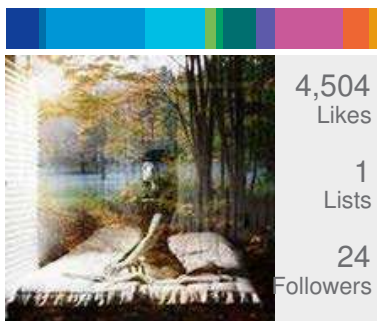
474 Likes

0 Lists

11 Followers

**keylocke**

Nicole



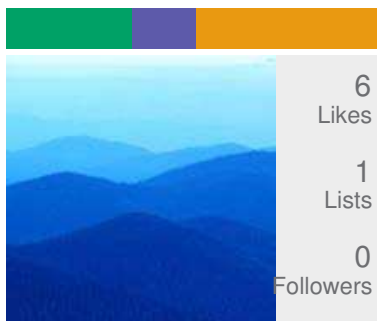
4,504 Likes

1 Lists

24 Followers

**brainsbeauty7**

Aaditi



6 Likes

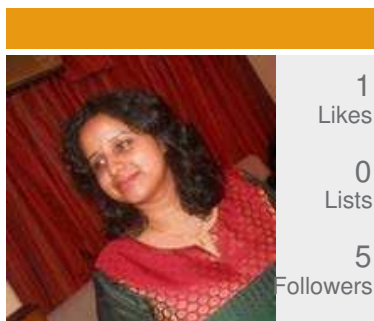
1 Lists

0 Followers

**sulejmanhasko**

sulejman

Hii i am a 11 years old boy. I am so happy and free in this website. xoxo



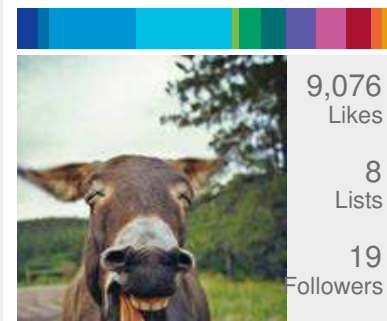
1 Likes

0 Lists

5 Followers

**sonasweety**

sonasweety



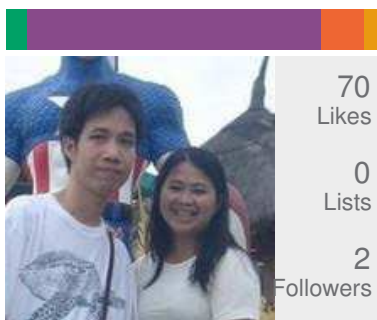
9,076 Likes

8 Lists

19 Followers

**mcmoazed**

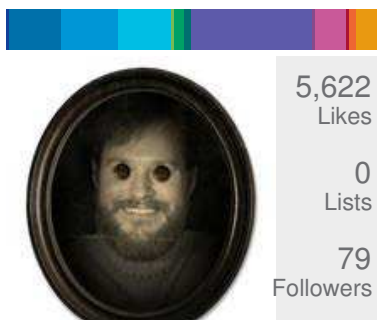
claire



70 Likes

0 Lists

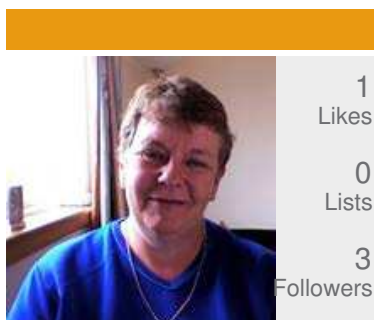
2 Followers



5,622 Likes

0 Lists

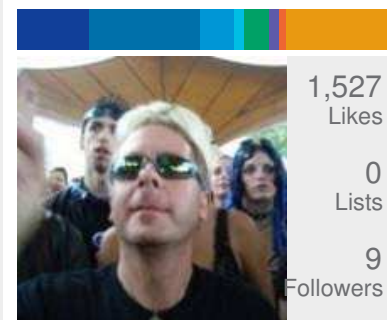
79 Followers



1 Likes

0 Lists

3 Followers



1,527 Likes

0 Lists

9 Followers



lordvellon

lordvellon

gregp228

gregp228

grannymac

grannymac

actalus

actalus



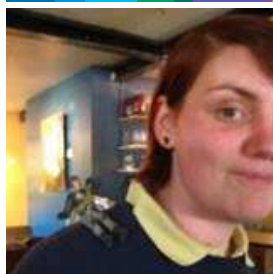
5 Likes

0 Lists

3 Followers

milorad5

milorad5



5,672 Likes

0 Lists

20 Followers

sgates6

Stacy



2,509 Likes

0 Lists

6 Followers

PathtoDegeneracy

CouchWarriors.net

<http://www.couchwarriors.net>



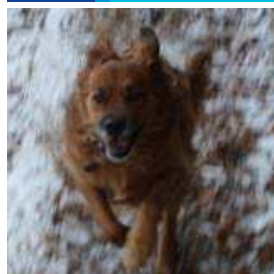
898 Likes

0 Lists

12 Followers

mthurnerdiaz

mthurnerdiaz



68 Likes

0 Lists

2 Followers

annajl

annajl



2,007 Likes

34 Lists

8 Followers

Selviyitiyat

Selviyitiyat



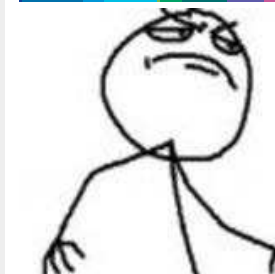
4,830 Likes

0 Lists

47 Followers

satanacio

Satanacio



1,030 Likes

1 Lists

6 Followers

hilldogg

hilldogg

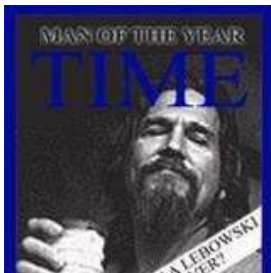
Hot diggity woofcat





39K Likes  
0 Lists  
87 Followers

**amar651**  
amar651



1,087 Likes  
0 Lists  
9 Followers

**buckethead8**  
kevin



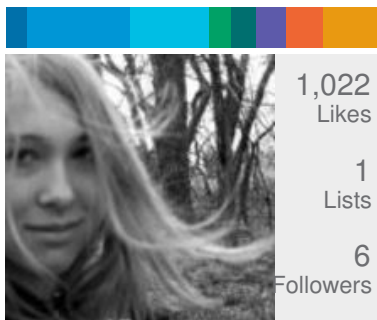
1,357 Likes  
1 Lists  
8 Followers

**frankslaunwhite**  
frankslaunwhite



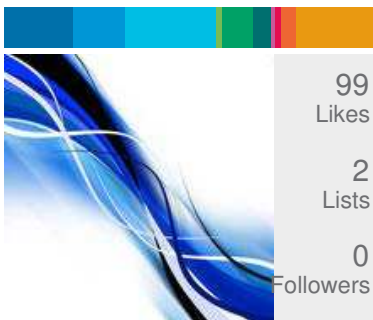
16K Likes  
0 Lists  
70 Followers

**iantom84**  
iantom84



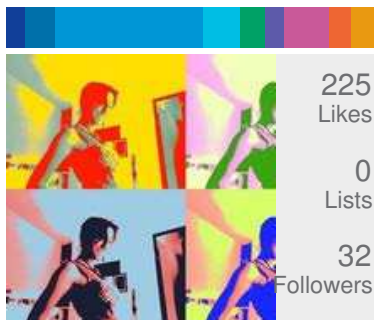
1,022 Likes  
1 Lists  
6 Followers

**Silverharp**  
Silverharp



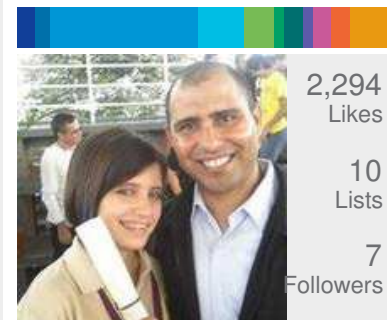
99 Likes  
2 Lists  
0 Followers

**mrspacpanda**  
mrspacpanda



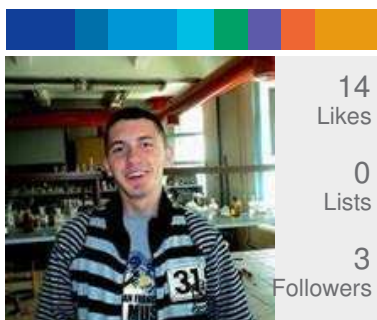
225 Likes  
0 Lists  
32 Followers

**lilikpa**  
Lya

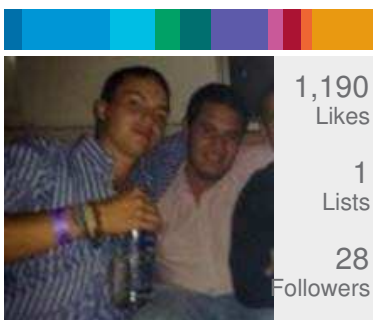


2,294 Likes  
10 Lists  
7 Followers

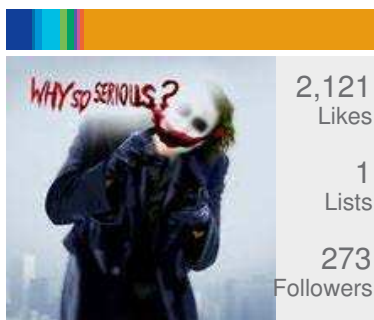
**karla-21**  
karla-21



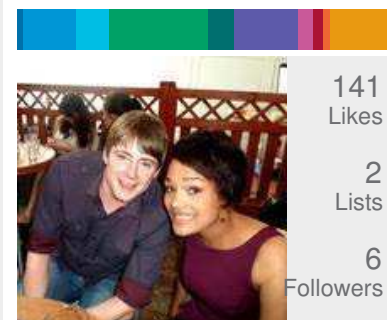
14 Likes  
0 Lists  
3 Followers



1,190 Likes  
1 Lists  
28 Followers



2,121 Likes  
1 Lists  
273 Followers



141 Likes  
2 Lists  
6 Followers

**hberisha3**

Habib

**pollo2010**

pollo2010

**alexandrumd23**

alexandrumd23

<http://www.pandasgames.com/>

**RollingStone204**

Aaron Cunnane



112  
Likes

1  
Lists

6  
Followers

**wabafactor**

wabafactor



18  
Likes

0  
Lists

1  
Followers

**Dom21**

Dom21



4,494  
Likes

0  
Lists

24  
Followers

**baltavilla**

baltavilla



815  
Likes

0  
Lists

3  
Followers

**robsocool**

robsocool

Opposition Number: 91223142  
*JAVIER RODRIGUEZ, LLC v. ZYIS LTD.*

# Exhibit C

Exhibit C to Declaration of James Ian McDonald in  
Support of Applicant's Memorandum in  
Opposition to Opposer's Cross-Motion for  
Summary Judgment



#### Fastest Rising

- [chatroulette](#)
- [ipad](#)
- [justin bieber](#)
- [nicki minaj](#)
- [friv](#)
- [myxer](#)
- [katy perry](#)
- [twitter](#)
- [gamezer](#)
- [facebook](#)

#### Fastest Falling

- [swine flu](#)
- [wamu](#)
- [new moon](#)
- [mininova](#)
- [susan boyle](#)
- [slumdog millionaire](#)
- [circvil city](#)
- [myspace layouts](#)
- [michael jackson](#)
- [national city bank](#)

#### Fastest Rising in Entertainment

- [justin bieber](#)
- [shakira](#)
- [eminem](#)
- [netflix](#)
- [youtube videos](#)
- [lady gaga](#)
- [keshi](#)
- [nicki minaj](#)
- [grooveshark](#)
- [transformers 3](#)

#### Fastest Rising in Sports

- [mundial 2010](#)
- [olympics](#)
- [espn3](#)
- [ffe 11](#)
- [randy moss](#)
- [miami heat](#)
- [mourinho](#)
- [wayne rooney](#)
- [cricket live score](#)
- [david villa](#)

#### Fastest Rising in Consumer Electronics

- [ipad](#)
- [iphone 4](#)
- [nokia 5530](#)
- [htc evc 4g](#)
- [nokia n900](#)
- [blackberry apps](#)
- [duracell myworld](#)
- [三星E](#)
- [otterbox](#)
- [pdanet](#)

#### Fastest Rising in Food & Drink

- [masterchef](#)
- [食べログ](#)
- [cupcakes](#)
- [limmy johns](#)
- [как приготовить курицу](#)
- [dominos pizza menu](#)
- [tudo gostoso receitas](#)
- [guacamole recipe](#)
- [applebees menu](#)
- [rachel ray](#)

#### Fastest Rising Maps Searches

- [anhembi carque](#)
- [wm ducken](#)
- [world cup](#)
- [bundeskanzleramt](#)
- [rio branco](#)
- [mt everest](#)
- [kew gardens](#)
- [tour eiffel](#)
- [oxford street](#)
- [nürburgring](#)

#### Fastest Rising People

- [justin bieber](#)
- [katy perry](#)
- [selena gomez](#)
- [kim kardashian](#)
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Opposition Number: 91223142  
*JAVIER RODRIGUEZ, LLC v. ZYIS LTD.*

# Exhibit D

Exhibit D to Declaration of James Ian McDonald in  
Support of Applicant's Memorandum in  
Opposition to Opposer's Cross-Motion for  
Summary Judgment




## Friv Clone

### Job Summary:

<b>Job Type:</b>	Project
<b>Budget:</b>	\$ 300-1000
<b>Required Skills:</b>	Gaming, Graphics / Multimedia, Javascript, Programming, Web Design / Development
<b>Attached Files:</b>	(None)
<b>Status:</b>	Closed for bidding

### Buyer Summary:

<b>Username:</b>	Qursan 
<b>Feedback Score:</b>	Rating: (No Feedback Yet)
<b>Award Reliability:</b>	1 posted 0 paid
<b>Location:</b>	Kuala lumpur, Malaysia
<b>Member Since:</b>	February 7, 2008

**Invited Users:** There are no invited users

### Description

Hello evry one ,  
I need a clone of friv.com .  
Graphic design should be similar to friv.com (, but with a different color theme  
Only bid if you know how it's done. Please take a look at the site before bidding

### Reminder

You may not start working in this and any request before your bid is accepted. Users who violate this policy may have their accounts permanently suspended.

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Bids Received (0)

Shortlist (0)

Declined Bids (0)

Average bid  
amount:**\$4,075.00**Average delivery  
time:**43  
Day(s)**[Place Bid](#) | [Post Similar Job](#) | [Send Request](#) | [Contact Qursan](#)Order by: 

Remember that contacting the other party outside the site (by email, phone, etc.) on all business jobs (before the request is awarded) is a violation of our terms of use. We supervise all site activity for such infringements and can immediately expel transgressors on the spot, so we thank you in advance for your cooperation. If you notice a violation please [help out the site and report it](#). Thank you for your help.

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One of the main advantages of GetACoder is the low labor cost. The typically rates are about seven times lower than the ones in the US or Europe. Posting a request at GetACoder allows the right professional or company to find you and to bid for your work. We are building a reputation for exceeding our customers' expectations and for becoming an extremely cost effective way to outsource work. Use GetACoder when you want to save money, increase efficiency or accelerate the development of your request. With GetACoder you focus on growing your business and let others do the tedious work. [Post your request](#) on GetACoder for free. Find out why people outsource jobs with us day after day.

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**JOB METER**

USD 2 0 6, 0 4 0  
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Title	Type	Average	# Bids	Category	Started	Status
<a href="#">Friv Clone</a>	Project	\$4,075	4	Gaming , Graphics / Multimedia , Javascript Programming , Web Design / Development	7 years ago	Estimated Value of Jobs Posted Since 2004

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One of the main advantages of GetACoder is the low labor cost. The typically rates are about seven times lower than the ones in the US or Europe. Posting a request at GetACoder allows the right professional or company to find you and to bid for your work. We are building a reputation for exceeding our customers' expectations and for becoming an extremely cost effective way to outsource work. Use GetACoder when you want to save money, increase efficiency or accelerate the development of your request. With GetACoder you focus on growing your business and let others do the tedious work. [Post your request](#) on GetACoder for free. Find out why people outsource jobs with us day after day.



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Opposition No. 91223142  
*Javier Rodriguez, LLC v. Zyis LTD*

# Exhibit 2

Exhibit 2 to Applicant's Motion for Rule 56(d) Relief

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

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JAVIER RODRIGUEZ, LLC,

OPPOSER,

v.

ZYIS LTD.,

APPLICANT.

OPPOSITION NO. 91223142

Marks: FRIV

Serial Nos. 86/562,665 & 86/566,285

Published August 4, 2015

**DECLARATION OF BRIAN D. TUCKER IN SUPPORT OF APPLICANT'S  
MOTION FOR RULE 56(d) RELIEF**

I, Brian D. Tucker, hereby declare and state under penalty of perjury under the laws of the United States of America as follows:

1. I am a partner in the law firm of Kirton McConkie and am lead counsel for the applicant Zyis, Ltd. ("Applicant") in the above-captioned matter. I am a member in good standing of the Utah State Bar. I have personal knowledge of the matters set forth herein, and if I am called upon to testify, I could testify competently thereto.

2. I have prepared this declaration in support of Applicant's Motion for Rule 56(d) Relief filed in part in response to Opposer Javier Rodriguez, LLC's ("Opposer") Cross-Motion for Summary Judgment (11 TTABVUE, the "Cross-Motion").

3. This case is in its infancy; Opposer's Notice of Opposition was filed on August 5, 2015 after which Applicant answered the Notice of Opposition and promptly moved to dismiss. (*See* 1, 4 & 5 TTABVUE.)

4. Owing to Applicant's original motion to dismiss, proceedings were suspended. (6 TTABUVE.)

5. Shortly after proceedings were resumed, Applicant filed a renewed motion to dismiss, which was followed by Opposer's Cross-Motion for summary judgment. (10 & 11 TTABVUE.)

6. Accordingly, the opening of discovery has been postponed and neither party has conducted any discovery in this case to date, including written discovery, deposition discovery, third party discovery, and so forth.

7. Nevertheless, Applicant is both entitled to conduct discovery and will require additional discovery to more fully oppose the Cross-Motion. For example, Opposer's Cross-Motion relies on a single declaration from J. Nader. (*See* 11 TTABVUE at Ex. X.) Applicant has never had the opportunity to depose Mr. Nader in this matter, let alone about the topics specifically addressed in his declaration. Likewise, Applicant has never had the opportunity to take discovery related to any of Opposer's so-called internet materials. Discovery related to such documents is essential for Applicant to more fully address disputes of fact related thereto, including even authenticating such evidence.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed on this 1<sup>st</sup> day of March, 2016.

BY: /s/Brian D. Tucker  
Brian D. Tucker