

ESTTA Tracking number: **ESTTA729435**

Filing date: **02/25/2016**

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

Proceeding	91225900
Party	Defendant PERSIST MARKETING, LLC
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Attachments	PAGES 1 TO 8 OF RESPONSE.pdf(297790 bytes) SIGNED PAGE 9.pdf(254188 bytes) SIGNED SIGNATURE CERTIFICATION OF SERVICE.pdf(151888 bytes) EXHIBIT 1.pdf(185123 bytes) EXHIBIT 2.pdf(191240 bytes) EXHIBIT 3.pdf(186463 bytes) EXHIBIT A.pdf(361655 bytes) EXHIBIT B.pdf(593051 bytes) EXHIBIT C.pdf(278257 bytes)

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

In the Matter of Trademark Application :
Serial No. 86/619,403 :
VERO :
Published in the Official Gazette :
(Trademarks) on :
September 22, 2015 : **OPPOSITION NO. 91225900**
:
PNY TECHNOLOGIES INC., :
Opposer, :
:
v. :
:
PERSIST MARKETING LLC, :
Applicant. :

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

Applicant, Persist Marketing LLC (“Persist Marketing”, “Applicant”), for its answer to the Notice of Opposition filed by Opposer, PNY Technologies Inc. (“PNY Technologies”, “Opposer”) against application for registration of Persist Marketing’s trademark VERO, Serial No. 86/619,403 filed May 5, 2015, and published in the Official Gazette of September 22, 2015010 (the “Mark”), pleads and avers as follows:

1. Answering ¶ 1 of the Notice of Opposition, Applicant acknowledges that Opposer has provided information sufficient to form a belief as to the truth of the allegation in ¶ 1.

2. Answering ¶ 2 of the Notice of Opposition, Applicant admits to the truth of the Opposer’s allegation in ¶ 2.

3. Applicant makes no answer to the allegation in ¶ 3 to the extent the allegation states a legal conclusion rather than a fact. Further, Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegation in ¶ 3 and therefore denies the allegation.

4. Answering ¶ 4 of the Notice of Opposition, Applicant lacks knowledge and information sufficient to form a belief as to the truth of the allegations in ¶ 4.

5. Answering ¶ 5 of the Notice of Opposition, Applicant acknowledges Opposer has provided information sufficient to form a belief as to the truth of the Opposer's allegation of ownership. Further, Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations remaining in ¶ 5.

6. Answering ¶ 6 of the Notice of Opposition, Applicant lacks knowledge and information sufficient to form a belief as to the truth of the allegations in ¶ 6.

7. Answering ¶ 7 of the Notice of Opposition, Applicant denies the portion of the allegation that Persist Marketing, LLC filed an application Serial No. 86/619,403 for registration of VERO for [sic] “[d]ata processing equipment and computers for marketing purposes”. With respect to the remaining allegation of ¶ 7, Applicant admits the allegation that Persist Marketing LLC filed an application, Serial No.86/619,403, for registration of VERO is for [sic] “computer software for

Computer game programmes downloadable via the Internet; Computer game software for personal computers and home video game consoles; Computer game software for use on mobile and cellular phones; Computer gaming software for recreational game playing purposes; Computer programs for video and computer games; Downloadable computer game programs; Downloadable computer game software via a global computer network and wireless devices; Downloadable computer programs featuring positionable game piece figures for use in the field of computer games; Downloadable electronic game

programs; Downloadable electronic game software for use on MOBILE PHONE, COMPUTERS, GAMING APPARATUS, PC TABLETS; Electronic game programs; Electronic game software; Electronic game software for cellular telephones; Electronic game software for handheld electronic devices; Electronic game software for wireless devices; Game software; Interactive game programs; Interactive game software; Interactive video game programs; Video game cartridges and discs; Video game software,” in Class 9,

and that Applicant’s VERO application was published for opposition in the Official Gazette on September 22, 2015, and that Opposer was granted an extension of the time to oppose this application until January 20, 2016.

8. Answering ¶ 8 of the Notice of Opposition, Applicant admits to the truth of the Opposer’s allegation in ¶ 8.

9. Applicant makes no answer to the allegations in ¶ 9 to the extent the allegations state legal conclusions rather than facts. Further, Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations in ¶ 9 and therefore denies these allegations.

10. Applicant makes no answer to the allegations in ¶ 10 to the extent the allegations state legal conclusions rather than facts. Further, Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations in ¶ 10 and therefore denies these allegations.

11. Applicant makes no answer to the allegations in ¶ 11 to the extent the allegation states legal conclusions rather than facts. Further, Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations in ¶ 11 and therefore denies these allegations.

12. Answering ¶ 12 of the Notice of Opposition, Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegation in ¶ 12 and therefore denies the allegation.

13. Applicant makes no answer to the allegation in ¶ 13, other than Applicant lacks knowledge and information sufficient to form a belief as to the truth of the allegation that Opposer's VERTO Marks [sic] "became famous".

14. Applicant makes no answer to the allegations in ¶ 14 to the extent the allegations states legal conclusions rather than facts. Further, Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegation in ¶ 14 and therefore denies the allegations.

15. Applicant makes no answer to the allegation in ¶ 15 to the extent the allegation states a legal conclusion rather than a fact. Further, Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegation in ¶ 15 and therefore denies the allegation.

AFFIRMATIVE DEFENSES

First Affirmative Defense

Opposer's Mark VERTO, Reg. No. 2,602,761, Reg. Date July 30, 2002, for Goods [sic] "Computer graphics cards used to enhance the performance of computer games", Class 9, is *prima facie* evidence that the Opposer's VERTO Mark is for computer hardware, a physical device used in or with a machine, as evidenced by a copy of the TESS printout annexed as **Exhibit 1**.

Applicant's Mark VERO, Reg. Applicant's Mark VERO, Reg. No. 86/619,403, published in the Official Gazette September 22, 2015, is: application-specific software; a collection of code; for Class 9 Goods, "computer software for

Computer game programmes downloadable via the Internet; Computer game software for personal computers and home video game consoles; Computer game software for use on mobile and cellular phones; Computer gaming software for recreational game playing purposes; Computer programs for video and computer games; Downloadable computer game programs; Downloadable computer game software via a global computer network and wireless devices; Downloadable computer programs featuring positionable game piece figures for use in the field of computer games; Downloadable electronic game programs; Downloadable electronic game software for use on MOBILE PHONE, COMPUTERS, GAMING APPARATUS, PC TABLETS; Electronic game programs; Electronic game software; Electronic game software for cellular telephones; Electronic game software for handheld electronic devices; Electronic game software for wireless devices; Game software; Interactive game programs; Interactive game software; Interactive video game programs; Video game cartridges and discs; Video game software"

as evidenced by a copy of the TSDR printout annexed as **Exhibit 3**.

The cumulative effect of differences in the essential characteristics of the broad range goods and services contained within Class 9 supports the Applicant's valid submission of its Mark for registration.

Second Affirmative Defense

Opposer's Mark VERTO (Stylized) Reg. No. 3,370,106, Reg. Date January 15, 2008, Goods [sic] "Computer graphic cards used to enhance the video, speed and overall performance of computer games, personal computers, desktop computers and computer workstations", Class 9, is *prima facie* evidence that the Opposer's VERTO (Stylized) Mark is for computer hardware, a physical device used in or with a machine, as evidenced by a copy of the TESS printout annexed as **Exhibit 2**.

Applicant's Applicant's Mark VERO, Reg. No. 86/619,403, published in the Official Gazette September 22, 2015, is: application-specific software; a collection of code; for Class 9 Goods, "computer software for

Computer game programmes downloadable via the Internet; Computer game software for personal computers and home video game consoles; Computer game software for use on mobile and cellular phones; Computer gaming software for recreational game playing purposes; Computer programs for video and computer games; Downloadable computer game programs; Downloadable computer game software via a global computer network and wireless devices; Downloadable computer programs featuring positionable game piece figures for use in the field of computer games; Downloadable electronic game programs; Downloadable electronic game software for use on MOBILE PHONE, COMPUTERS, GAMING APPARATUS, PC TABLETS; Electronic game programs; Electronic game software; Electronic game software for cellular telephones; Electronic game software for handheld electronic devices; Electronic game software for wireless devices; Game software; Interactive game programs; Interactive game software; Interactive video game programs; Video game cartridges and discs; Video game software"

as evidenced by a copy of the TSDR printout annexed as **Exhibit 3**.

The cumulative effect of differences in the essential characteristics of the broad range goods and services contained within Class 9 supports the Applicant's valid submission of its Mark for registration.

Third Affirmative Defense

There is no likelihood of confusion, mistake or deception because, *inter alia*, the Mark and the trademarks of Opposer are not confusingly similar.

Fourth Affirmative Defense

Alternatively, any similarity between the Mark and Opposer's trademark is eliminated when viewed as annexed as **Exhibit A**, which is a print copy of search results in the Google Play Store showing the Mark being applied in the context of Class 9 Goods; as annexed as **Exhibit B**,

which is a print copy of the Mark's landing page displayed within the Google Play store; and as annexed as **Exhibit C**, which is a print copy of search results in the Opposer's website showing the Opposer's Mark being applied in the context of Class 9 Goods.

On such information and belief, the Applicant proffers that

- a. The consideration of **Exhibits A-B-C** invalidates the Opposer's claim ¶ 9 that the Applicant's mark [sic] "... is used on or in connection with goods closely related to and in the same class as Opposer's Goods, and is likely to be confused therewith and mistaken therefore", and "The Applicant's Mark is deceptively similar to Opposer's VERTO Mark so as to cause confusion and lead to deception as to the origin of Applicant's goods bearing the Applicant Mark."
- b. The consideration of **Exhibits A-B-C** invalidates the Opposer's claim ¶ 10 that [sic] "... confusion in the trade resulting in damage and injury to Opposer would be caused and would result by reason of the similarity between Applicant's VERO mark and Opposer's VERTO Marks. Accordingly, consumers will associate Applicant's goods with Opposer's Goods, and think Applicant's goods are provided or endorsed by, or otherwise affiliated with, Opposer."
- c. The consideration of **Exhibits A-B-C** invalidates the Opposer's claim ¶ 11 that [sic] "If the Applicant were granted the registration herein opposed... Such registration would be a source of damage and injury to the Opposer."
- d. The consideration of **Exhibits A-B-C** invalidates the Opposer's claim ¶ 14 that "Applicant's registration and/or use of its VERO mark is likely to blur or tarnish the positive associations of Opposer's VERTO marks among consumers and the trade."

- e. The consideration of **Exhibits A-B-C** invalidates the Opposer's claim ¶ 15 that [sic] "Thus, if Applicant is permitted to register and use its VERO mark, it is likely to cause dilution of the distinctive quality of Opposer's VERTO marks."

Fifth Affirmative Defense

Opposer has offered no basis of fact to substantiate Opposer's claim of ¶ 11 that granting Applicant's registration of its Mark would be a [sic] "source of damage and injury to the Opposer."

Sixth Affirmative Defense

Opposer has offered no basis of fact to substantiate Opposer's claim of ¶ 12 that [sic] "Through Opposer's extensive advertisement and promotion and substantial sales, Opposer's VERTO marks have become famous."

Seventh Affirmative Defense

The Opposer's Goods associated with the VERTO trademark are completely different from the Goods associated with the mark, VERO, of the Applicant.

Eighth Affirmative Defense

The Opposer's Goods associated with the VERTO trademark cannot and do not travel in the same channels of trade to the same classes of purchasers as Applicant's Goods, as Opposer's Goods in all forms are different from the Goods associated with the Mark, VERO, of the Applicant.

Ninth Affirmative Defense

The Opposer's Goods associated with the VERTO trademark are expensive and may be purchased with a great deal of care, whereas the cost of the Goods associated with the mark, VERO, of the Applicant, is low-priced and may be purchased impulsively.

Tenth Affirmative Defense

The Opposer's VERTO trademark and Applicant's VERO mark are so dissimilar in their overall commercial impression that confusion as to the source of the goods offered is unlikely to result. The recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks, would not fail to distinguish the inherent difference between the Opposer's trademark and Applicant's Mark.

WHEREFORE, Applicant Persist Marketing, LLC prays that this Opposition be dismissed and that Serial No. 86/619,403 for the mark VERO be granted registration for the goods in International Class 9 therein specified.

Respectively submitted,

PERSIST MARKETING, LLC

Dated: February 25, 2016

By:



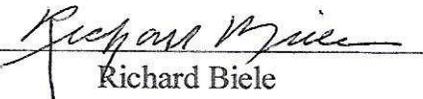
Richard Biele
Persist Marketing, LLC
10633 Hickory Crest Lane
Columbia, MD 21044-4558
(410) 884-5553

CERTIFICATION OF SERVICE

I hereby certify that a true and complete copy of the foregoing Answer to Notice of Opposition, Affirmative Defenses, has been served on opposing counsel for PNY Technologies, Inc., Jonathan Short, Esq., by mailing said copy on February 25, 2016, via First-Class Mail with Certified Mail and Return Receipt, to:

Jonathan Short, Esq.
McCarter & English, LLP
Four Gateway Center
100 Mulberry Street
Newark, NJ 07102-4096

Dated: February 25, 2016


Richard Biele

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VERTO

Word Mark VERTO
 Goods and Services IC 009. US 021 023 026 036 038. G & S: Computer graphic cards used to enhance the performance of computer games. FIRST USE: 20010617. FIRST USE IN COMMERCE: 20010617
 Mark Drawing Code (1) TYPED DRAWING

EXHIBIT 1

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VERTO

Word Mark VERTO
 Goods and Services IC 009. US 021 023 026 036 038. G & S: Computer graphic cards used to enhance the video, speed and overall performance of computer games, personal computers, desktop computers and computer workstations. FIRST USE: 20070301. FIRST USE IN COMMERCE: 20070301
 Mark Drawing Code (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

EXHIBIT 2

STATUS	DOCUMENTS	?	Download ▲	Print Preview
Generated on: This page was generated by TSDR on 2016-02-23 07:59:08 EST				
Mark: VERO		VERO		
US Serial Number:	86619403	Application Filing Date:	May 05, 2015	
Filed as TEAS Plus:	Yes	Currently TEAS Plus:	Yes	
Register:	Principal			
Mark Type:	Trademark			
Status:	An opposition after publication is pending at the Trademark Trial and Appeal Board. For further information, see TTABVue on the Trademark Trial and Appeal Board web page.			
Status Date:	Jan. 19, 2016			
Publication Date:	Sep. 22, 2015			
▼ Mark Information				▼ Expand All
Mark Literal Elements:	VERO			
Standard Character Claim:	Yes. The mark consists of standard characters without claim to any particular font style, size, or color.			
Mark Drawing Type:	4 - STANDARD CHARACTER MARK			
Translation:	The English translation of "VERO" in the mark is "TRUE".			
▼ Goods and Services				
Note:	The following symbols indicate that the registrant/owner has amended the goods/services:			
	<ul style="list-style-type: none"> • Brackets [...] indicate deleted goods/services; • Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and • Asterisks *...* identify additional (new) wording in the goods/services. 			
For:	Computer game programmes downloadable via the Internet; Computer game software for personal computers and home video game consoles; Computer game software for use on mobile and cellular phones; Computer gaming software for recreational game playing purposes; Computer programs for video and computer games; Downloadable computer game programs; Downloadable computer game software via a global computer network and wireless devices; Downloadable computer programs featuring positionable game piece figures for use in the field of computer games; Downloadable electronic game programs; Downloadable electronic game software for use on MOBILE PHONE, COMPUTERS, GAMING APPARATUS, PC TABLETS; Electronic game programs; Electronic game software; Electronic game software for cellular telephones; Electronic game software for handheld electronic devices; Electronic game software for wireless devices; Game software; Interactive game programs; Interactive game software; Interactive video game programs; Video game cartridges and discs; Video game software			
International Class(es):	009 - Primary Class	U.S Class(es):	021, 023, 026, 036, 038	

EXHIBIT 3

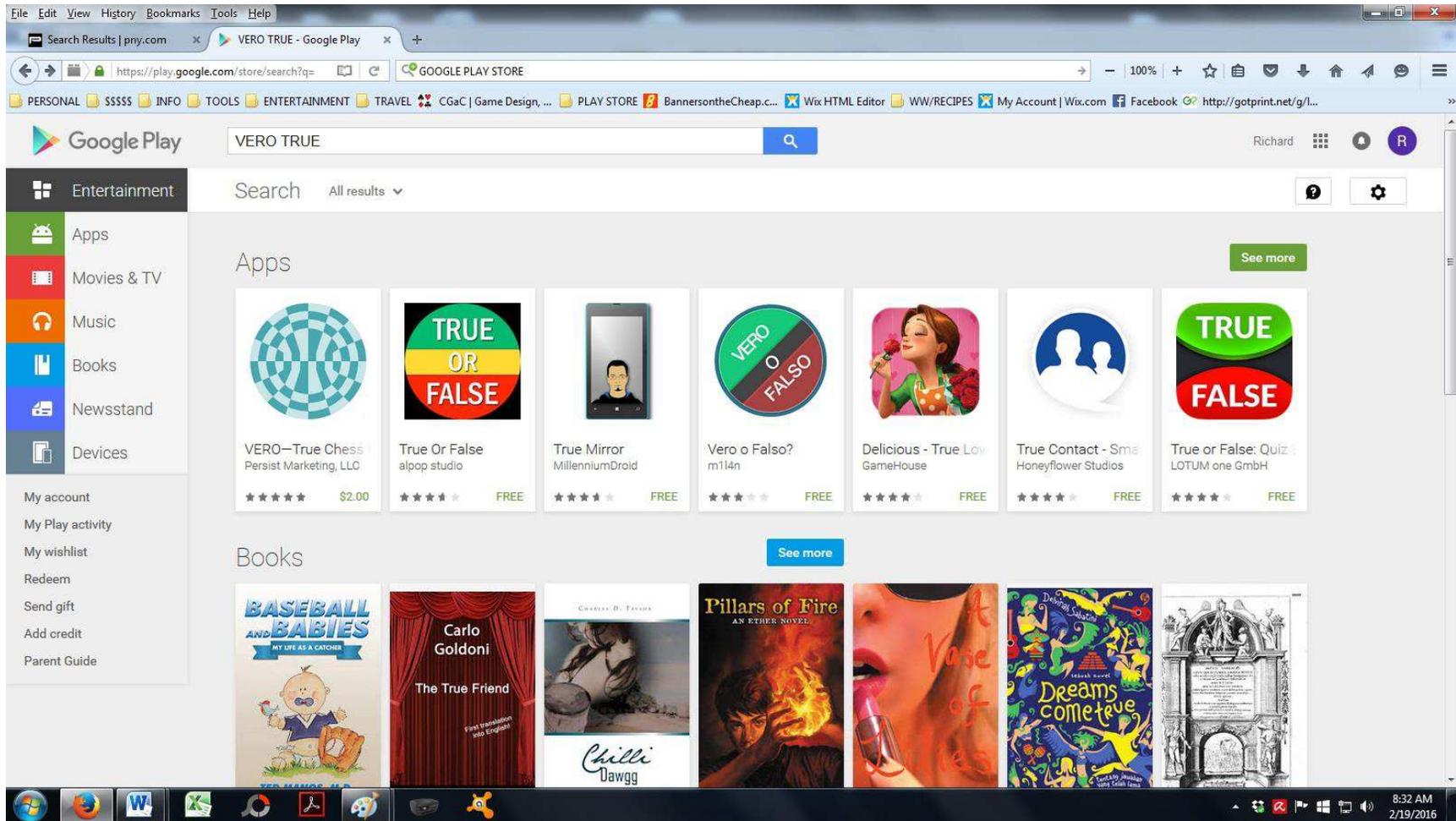


EXHIBIT A: PAGE RESULT OF SEARCH FOR APPLICANT'S MARK, VERO, IN GOOGLE PLAY STORE

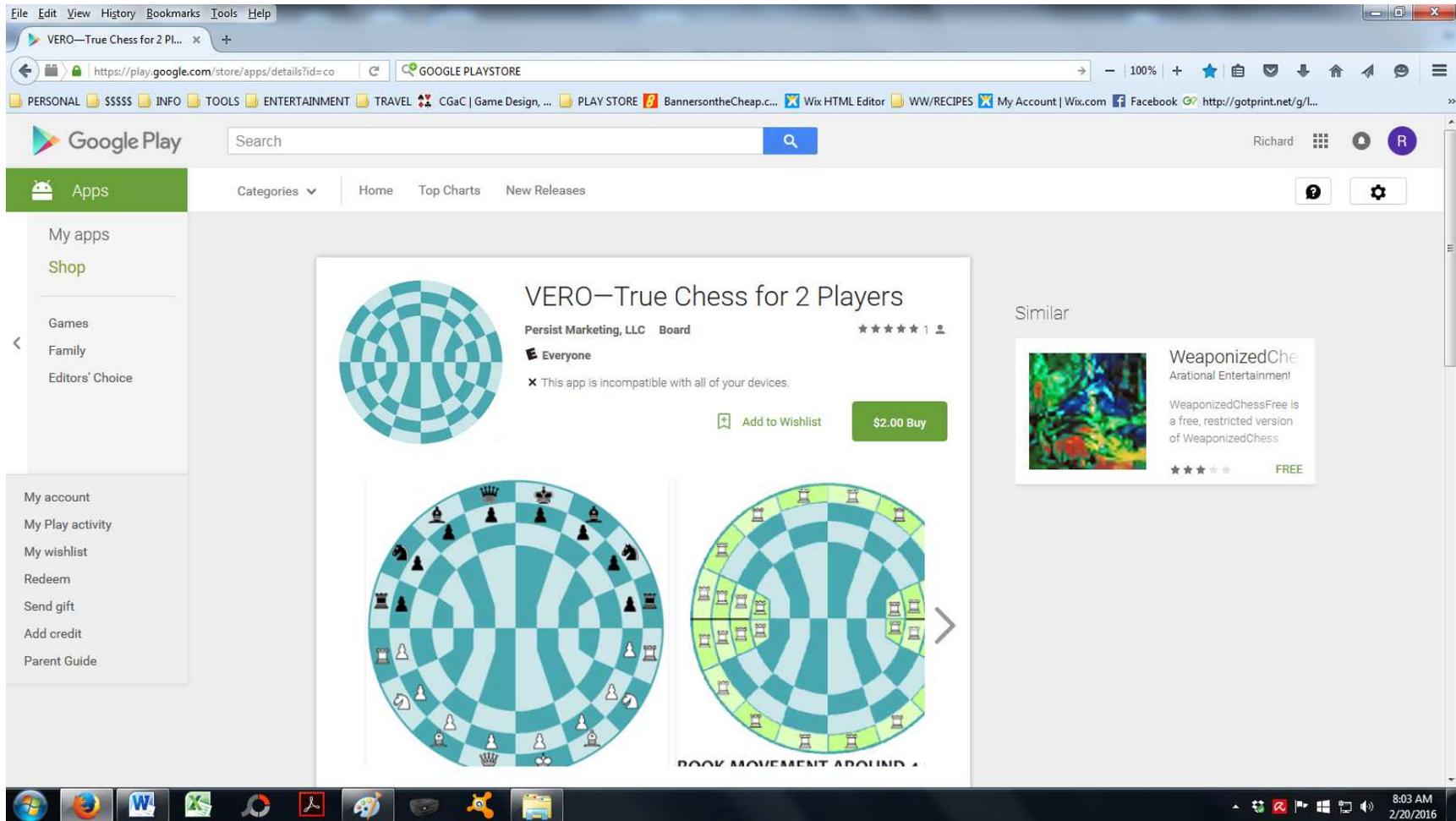


EXHIBIT B: PAGE RESULT OF LIVE LINK FOR APPLICANT'S MARK, VERO, IN GOOGLE PLAY STORE

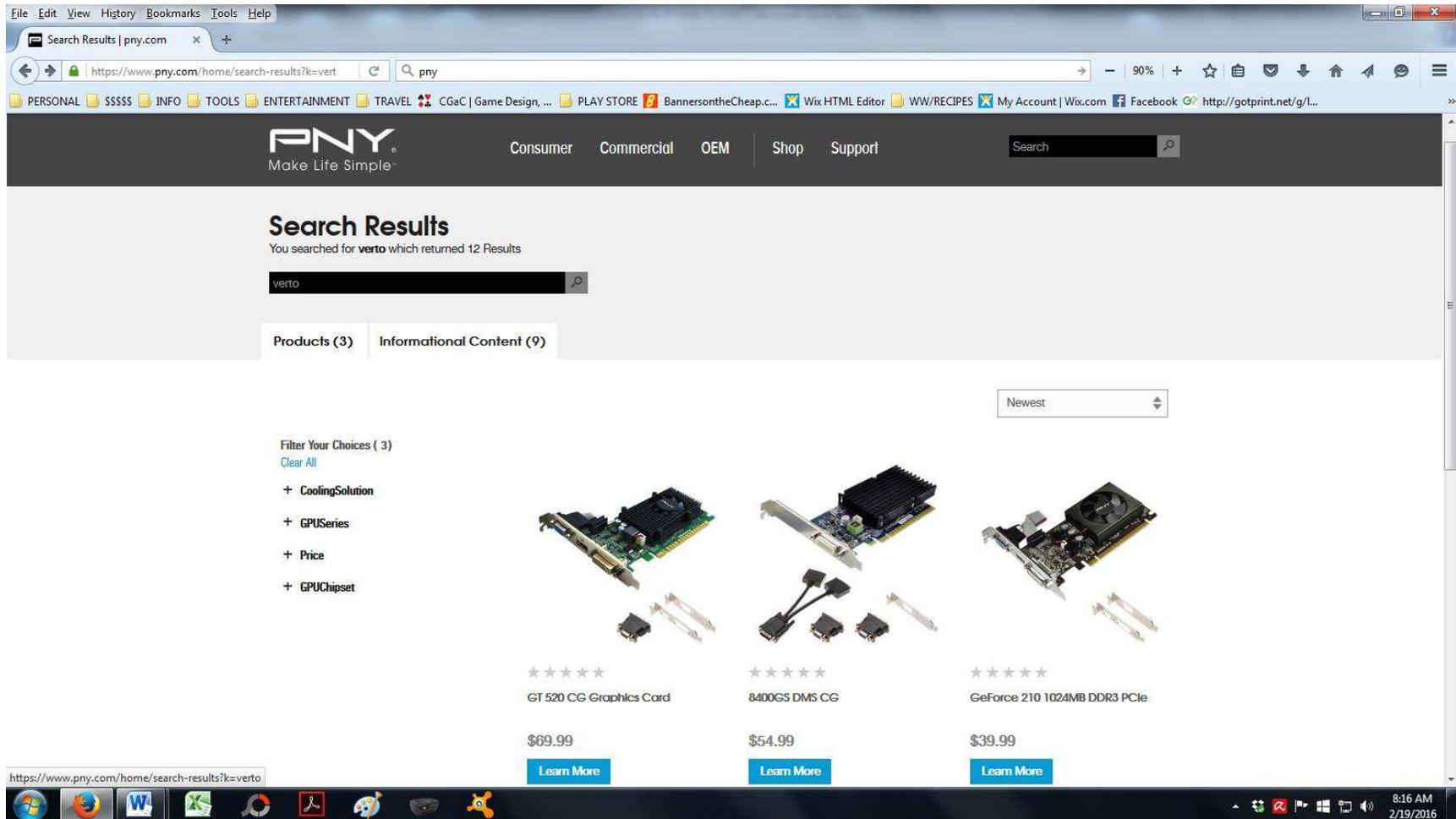


EXHIBIT C: PAGE RESULT OF SEARCH FOR OPPOSER'S MARK, VERTO, WITHIN OPPOSER'S WEBSITE