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

Proceeding	91237356
Party	Defendant Dexter Kan
Correspondence Address	Morton J. Rosenberg Rosenberg Klein & Lee 3458 Ellicott Center DriveSuite 101 Ellicott City, MD 21043 UNITED STATES rkl@rklpatlaw.com 4104651254
Submission	Motion to Amend/Amended Answer or Counterclaim
Filer's Name	Morton J. Rosenberg
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Signature	/Morton J. Rosenberg/
Date	12/29/2018
Attachments	4861-2-APPLICANT-MOTION-TO-AMEND-ANSWER-DEC29-2018.pdf(125884 3 bytes)

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

ROCKET SPORTS, LLC,

Opposer,

vs.

DEXTER KAN,

Applicant.

Opposition No. 91237356

**APPLICANT'S MOTION FOR
LEAVE TO AMEND ANSWER TO
NOTICE OF OPPOSITION**

Pursuant to Rule 2.107 of the Trademark Rules of Practice, 37 C.F.R. § 2.106(b)(3) and 2.107, Trademark Board Manual of Procedure ("TBMP") §§ 313, 315, and 507, and Rule 15(a) of the Federal Rules of Civil Procedure, Dexter Kan ("Applicant") respectfully moves the Board for leave to amend its Answer to the Notice of Opposition to add a counterclaim that Registration No. 5,297,623 (for the "ROCKET SPORTS Mark") should be cancelled on the basis of likelihood of confusion with one or more marks which were used in commerce and/or registered prior to the ROCKET SPORTS Mark in International Class 35, as well as International Class 28. The proposed Amended Answer is attached hereto, in a clean and unmarked form as Exhibit A, and with markup as Exhibit B.

I. FACTS AND PROCEDURAL HISTORY

On March 25, 2017, Applicant filed Application No. 87385665 (for the "ROCKET MESH Mark") under 15 U.S.C. § 1051(b) for the goods "Lacrosse balls; Lacrosse sticks."

Opposer filed its Notice of Opposition on October 21, 2017, and amended the Notice of Opposition on November 11, 2017, based on ownership of the ROCKET SPORTS Mark.

(TTABVUE Doc. Nos. 1 and 4.) Applicant, appearing pro se, filed its Answer to the Amended Notice on November 16, 2017. (TTABVUE Doc. No. 6.) The Answer included among its defenses that “Opposer’s mark is weak and entitled to a narrow scope of protection,” and noted the existence of “similar marks for similar goods.” Nonetheless, as a pro se litigant, Applicant was not aware of the possibility of a counterclaim to cancel the ROCKET SPORTS Mark, or the process for doing so, and lacked the knowledge and appreciation to further evaluate these similar marks to explore this possibility.

The Opposition was suspended with mutual consent of the parties on June 26, 2018, pending settlement negotiations. (TTABVUE Doc. No. 16.) By mutually consented extensions, this suspension continued through to December 23, 2018 (TTABVUE Doc. Nos. 19, 21, 23, 27), and extended further through to December 26, 2018, as the U.S. Patent and Trademark Office was closed on December 23-25, 2018 for the weekend and the Christmas holiday.

Opposer has further moved to extend discovery for 60 days. (TTABVUE Doc. No. 30.) Opposer’s Motion is currently pending.

On October 16, 2018, during the suspension, Attorneys for Applicant made appearance in the Opposition. (TTABVUE Doc. No. 24.) As part of their due diligence, Attorneys for Applicant then conducted their own search and analysis as to the ROCKET SPORTS Mark. Attorneys for Applicant thereby discovered and evaluated Trademark Reg. No. 4,069,932 (for “ROCKET MEDIA” in Int. Class 35) and Trademark Reg. No. 2,734,981 (for “ROCKET” in Int. Class 28), among others. They concluded that each of these marks, and perhaps others, would raise far more likelihood of confusion with Opposer’s ROCKET SPORTS Mark than would Applicant’s ROCKET MESH Mark.

Having determined that either of the above registrations may therefore be sufficient to form the basis of a counterclaim, Attorneys for Applicant prepared an Amended Answer, and now submits the same for entry in these proceedings, in the event the Board grants this motion.

II. ARGUMENT AND CITATION OF AUTHORITY

Pleadings in an opposition proceeding may be amended in the same manner and to the same extent as in a civil action. 37 C.F.R. § 2.107. A party may amend its pleading by leave of court, which should be freely given “when justice so requires.” Fed. R. Civ. P. 15(a). The Board “liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties.” TBMP 507.02. The present standard for entering a counterclaim in a trademark opposition is elaborated in the precedential *Jive Software, Inc. v. Jive Communications, Inc.*, Opposition No. 91218826, 125 USPQ2d 1175 (TTAB 2017).

Here, justice requires that Applicant's amendment be entered. Additionally, granting Applicant leave to amend would neither violate settled law nor prejudice Opposer's rights.

A. Justice Requires that Applicant's Motion for Leave Be Granted.

As a rule, the Board will allow amendments except when it “is legally insufficient, or would serve no useful purpose.” TBMP 507.02. Here, the counterclaim added by amendment is legally sufficient and consistent with a valid defense to the Opposition.

Indeed, it is Opposer's emphatic position in the Opposition that their ROCKET SPORTS Mark and Applicant's ROCKET MESH Mark are confusingly similar due to the shared term “ROCKET,” and due to sufficient closeness in Opposer's services in Int. Class 35 and Applicant's goods in Int. Class 28. The legal standard for likelihood of confusion between

marks used in commerce remains the same, whether considered in the context of an Opposition proceeding or a Cancellation proceeding. *See, e.g.,* TBMP 309.03(c)(2)B (noting the factors for determining likelihood of confusion without specifying between types of proceedings). Consequently, for Opposer's position to hold true, it must necessarily be true that Opposer's ROCKET SPORTS Mark is confusingly similar to either or both of the prior registered marks, namely:

1. ROCKET MEDIA, for "Advertising agencies; Advertising, marketing and promotion services; Marketing and consulting services in the field of promoting and tracking the goods, services, and brands of others through all public communication means, particularly specializing in the use of mobile, social, on-line and print media to drive consumer interest, engagement and action; social media strategy and marketing consultancy focusing on helping clients create and extend their product and brand strategies by building virtually engaging marketing solutions" in Int. Class 35, and
2. ROCKET, for "Golf club shafts distributed exclusively to golf club manufacturers and golf club refitters" in Int. Class 28.

It would be highly *unjust* for the ROCKET MESH Mark to be successfully opposed by an opposing mark under one legal standard, if by the exact same standard valid registration of the opposing mark could not stand. Moreover, should the Board refuse to enter the counterclaim, Applicant may miss his only meaningful opportunity to challenge the ROCKET MESH Mark.

Also, the ability to counterclaim, and the appropriateness thereof, were not realized by Applicant until after he had retained counsel. That is, the lack of counterclaim in the original Answer was the result of Applicant's inexperience with the law as a *pro se* litigant, and in

particular his lack of familiarity with the need to examine the validity of the pled registration or the process for including an explicit counterclaim. The Board has shown particular leniency, in the interest of justice, in granting motions to correct the inadvertence of a pro se litigant. The same is respectfully requested here.

Accordingly, the proposed amendment would be in the interest of justice.

B. The Amendment is Within the Bounds of Settled Law.

Generally, TBMP 313.01 states that the Board may entertain “a counterclaim for cancellation of a registration owned by an adverse party.” 37 C.F.R. § 2.106(b)(3)(i) states: “If grounds for a counterclaim are learned during the course of the opposition proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned.”

The aforementioned *Jive Software* decision contemplates that a belated counterclaim may be entered even if originally omitted “through oversight, inadvertence, or excusable neglect” and even if it was “not based on newly-discovered evidence.” *Jive Software* at *11, internal quotes omitted. In *Jive Software*, a counterclaim was belatedly entered by amendment, without any allegation that the applicant omitted the counterclaim from the original answer for any reason other than simple oversight. In contrast, Applicant in the present case was unaware of grounds for a counterclaim for cancellation, nor that a counterclaim for cancellation could be added, until Attorneys for Applicant made appearance in the case. Indeed, any oversight would be more excusable here than in *Jive Software*, as the Applicant here was originally appearing pro se. The possibility of a counterclaim is now being promptly pursued.

When considering whether an amendment is “prompt,” suspension of proceedings should be accounted for. For example, in *Jive Software*, oppositions were suspended for over two years, and then counterclaims were added “within just a few weeks” of resumption of the proceedings.

Jive Software at *15. The Board declined to “penalize a party for taking no action while proceedings were suspended by the Board for settlement discussions upon agreement of the parties.” Id. Here, the counterclaim is being added by amendment less than a week after resumption of proceedings, with even more promptness than in *Jive Software*.

Accordingly, the proposed amendment is within the bounds of settled law.

C. Opposer Will Not Suffer Any Prejudice as a Result of the Amendment.

In *Jive Software*, it was found not prejudicial to add a counterclaim even after nearly two and a half years of opposition, including two years of negotiations and the prior service of discovery requests. *Jive Software* at *16, n.12. Here, by contrast, the Opposition is only fourteen months old.

Additionally, as Opposer was represented by counsel as of the filing of the Opposition, Opposer should have been aware of the possibility of a counterclaim. The duty to reasonably investigate prior to filing an action would have required that Attorney for Opposer conduct a reasonable search and analysis to confirm the validity of their own mark, which would have revealed at least some of the similar marks. Also, Attorney for Opposer would have been on notice as to the significance of the similar marks from the original Answer, and would have prepared for the possibility of a counterclaim. Indeed, Opposer demonstrated its awareness of such possibility of a counterclaim in Opposer's First Set of Interrogatories, which included Interrogatory No. 20: “Identify all trademarks, service marks or trade names other than Opposer's, which are known to the Applicant and which incorporate the terms ROCKET, ROCKET MESH or ROCKET SPORTS or any colorable variation thereof and identify each such corresponding registration or application.” The addition of a counterclaim upon the appearance of counsel for Applicant, therefore, would not have come as a surprise to Opposer.

Furthermore, to the extent that Opposer would be prejudiced by the addition of a counterclaim, the Board may resolve this prejudice by extending the appropriate due dates in the Opposition accordingly to allow Opposer to respond and serve additional discovery requests if needed. Opposer has already requested that the discovery deadlines be further postponed for 60 days, and has therefore demonstrated that delay will not be prejudicial to Opposer.

Accordingly, the proposed amendment will not prejudice the Opposer.

III. CONCLUSION

For the foregoing reasons, Applicant prays that this Motion to Amend be granted by the Board.

Respectfully submitted,
FOR: ROSENBERG, KLEIN & LEE

DATE: December 29, 2018

/Christopher Reaves/
Christopher Reaves

/Morton J. Rosenberg/
Morton J. Rosenberg

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MR4861-2
Opposition No. 91237356
Applicant's Motion to Amend Answer

CERTIFICATE OF SERVICE

I hereby certify that on December 29, 2018, I served a copy of the Document entitled
**APPLICANT'S MOTION FOR LEAVE TO AMEND ANSWER TO NOTICE OF
OPPOSITION** on Opposer by sending a true and correct copy of the Document by email to Paul
Koda at paul@kodafirm.com.

/Christopher Reaves/
Christopher Reaves

EXHIBIT A

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

ROCKET SPORTS, LLC,

Opposer,

vs.

DEXTER KAN,

Applicant.

Opposition No. 91237356

**APPLICANT'S AMENDED
ANSWER TO OPPOSER'S
AMENDED NOTICE OF
OPPOSITION**

COMES NOW applicant Dexter Kan (“Applicant”) herein answers the above indicated Amended Notice of Opposition (the “Notice”) brought by Rocket Sports, LLC (“Opposer”) as follows:

1. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 1 of the Notice, and therefore denies it.

2. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 2 of the Notice, and therefore denies it.

3. Admit in part. Applicant admits that the legal chain of title described in the first sentence of Paragraph 3 of the Notice appears to be consistent with the USPTO public record. Applicant avers that the allegations set forth in the second sentence of Paragraph 3 of the Notice call for a legal conclusion, which no response is required. To the extent any response is required to the allegations set forth in the second sentence of Paragraph 3 of the Notice, Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations set forth therein, and therefore denies it.

4. Admit.

5. Admit in part. Applicant admits that the file date set forth in the first sentence of Paragraph 5 of the Notice appears to be consistent with the USPTO public records. Applicant avers that the allegations set forth in the second sentence of Paragraph 5 of the Notice call for a legal conclusion, which no response is required. To the extent any response is required to the allegations set forth in the second sentence of Paragraph 5 of the Notice, Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations set forth therein, and therefore denies it.

6. Applicant avers that the allegation set forth in Paragraph 6 of the Notice calls for a legal conclusion, which no response is required. To the extent any response is required, Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegation set forth therein, and therefore denies it.

7. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 7 of the Notice, and therefore denies them.

8. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 8 of the Notice, and therefore denies them.

9. Applicant avers that the allegation set forth in Paragraph 9 of the Notice calls for a legal conclusion, which no response is required. To the extent any response is required, Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegation set forth therein, and therefore denies it.

All allegations of the Notice, whether explicit or implicit and including averments, which require an answer are denied to the extent that those allegations are not expressly and specifically admitted herein. Moreover, pursuant to Rule 8(b)(6) of the Federal Rules of Civil Procedure, allegations of the Notice to which no responsive pleading is required, shall be deemed as denied.

AFFIRMATIVE DEFENSES, AVOIDANCES, AND ARGUMENTS

1. FOR A FURTHER, SEPARATE, AND DISTINCT DEFENSE, Applicant is informed and believes, and thereupon alleges, that the Notice was filed without merit and for improper reasons, namely to adversely affect Applicant's application.

2. FOR A FURTHER, SEPARATE, AND DISTINCT DEFENSE, Applicant is informed and believes, and thereupon alleges, that the Notice is fraudulent and was filed to adversely affect Applicant's application.

3. FOR A FURTHER, SEPARATE AND DISTINCT DEFENSE, Applicant alleges it is informed and believes, and based upon such information and belief, that Opposer is barred from seeking any relief herein because third parties have used similar marks for similar goods, thus Opposer's mark is weak and entitled to a narrow scope of protection. 87 records appear when searching the USPTO Database for Live marks in Class 35; 160 records appear if the search is expanded to also include Class 28.

4. FOR A FURTHER, SEPARATE AND DISTINCT DEFENSE, Applicant alleges it is informed and believes, and based upon such information and belief, that Opposer is barred from seeking any relief herein because the channels of trade for the parties' respective goods are dissimilar. Applicant sells new goods and Opposer is a reseller of goods.

5. FOR A FURTHER, SEPARATE AND DISTINCT DEFENSE, Applicant alleges it is informed and believes, and based upon such information and belief, that Opposer is barred from seeking any relief herein because Opposer is currently not using its mark in connection with all of the goods or services, or in all of the trade channels, set forth in its registration.

6. FOR A FURTHER, SEPARATE AND DISTINCT DEFENSE, Applicant alleges it is informed and believes, and based upon such information and belief, that Opposer is barred from seeking any relief herein because Opposer has ceased using its mark in connection with one or more of the goods or services, or in all of the trade channels, set forth in its registration.

7. Applicant alleges that it is informed and believes, and based upon such information and belief, that it may have additional defenses not currently available and that may be available after completion of initial disclosures and discovery, and therefore reserves the right to set forth additional defenses as information becomes available.

COUNTERCLAIM

Counterclaimant Dexter Kan (Counterclaimant) is an individual residing at 3681 Hollyberry Drive, Huntingtown, Maryland 20639, doing business as “Rocket Mesh Lacrosse.”

The registrant and current owner (Registrant) of Trademark Reg. No. 5,297,623 (the Registration) for “ROCKET SPORTS” in International Class 35 (the ROCKET SPORTS Mark) is Rocket Sports, LLC, a Maryland limited liability company with a place of business located at 4 Baederwood Court, Derwood, Maryland 20855.

For the reasons provided below, Counterclaimant believes that he will be damaged by the Registration, and hereby petitions to cancel the same under 15 U.S.C. § 1064(1) and 37 CFR § 2.111 on the grounds of confusing similarity of the ROCKET SPORTS Mark with at least one prior mark.

1. Counterclaimant filed Trademark Application No. 87/385,665, for registration of “ROCKET MESH” in International Class 28 for “Lacrosse balls; Lacrosse sticks” (the ROCKET MESH Mark), on March 25, 2017.

2. Counterclaimant has invested in an inventory of goods relating to lacrosse balls and lacrosse sticks, bearing the ROCKET MESH Mark.
3. On October 21, 2017, Registrant filed Opposition No. 91237356 to oppose registration of the ROCKET MESH Mark, basing the Opposition on the Registration alleging prior use of the ROCKET SPORTS Mark in commerce.
4. Registrant has also threatened to bring an action of trademark infringement of the Registration if Counterclaimant continues to sell goods of any variety bearing the ROCKET MESH Mark.

On the basis of the allegations set forth above, Counterclaimant believes that Registrant's hostile assertion of the Registration against him will damage Counterclaimant, and Counterclaimant therefore has standing to petition for cancellation of the Registration.

5. Registrant filed for registration of the ROCKET SPORTS Mark on June 19, 2016, for the services of "Marketing services for the sports equipment of others; marketing services in the field of sports equipment; marketing services, namely, promoting or advertising the goods and services of others; marketing, promotional and advertising services provided by mobile telephone connections; marketing, advertising, and promoting the retail goods and services of others through wireless electronic devices; promoting and marketing the goods and services of others by distributing advertising material, coupons and discount offers via text messages; promoting and marketing the goods and services of others by websites and social media; promoting the goods and services of others by means of word-of-mouth and nontraditional marketing programs; promoting the sale of goods and services of others by websites and social media; advertising and marketing services, namely, promoting the goods and services

of others; advertising, marketing, and promoting the goods and services of others via websites and social media; on-line advertising and marketing services; providing marketing services for the sports equipment industry; reseller services, namely, distributorship services in the field of sports equipment.” The ROCKET SPORTS Mark was registered on September 26, 2017 in International Class 35, and alleges a first use in commerce of January 10, 2017.

6. On information and belief, and based upon Registrant's admissions in the Opposition, the Registration should have been barred by at least prior Trademark Reg. No. 4,069,932 for “ROCKET MEDIA” (the ROCKET MEDIA Mark).
 - a. The ROCKET MEDIA Mark was registered in International Class 35 on December 13, 2011, prior to both the alleged first use date and the filing date of the ROCKET SPORTS Mark Registration. Its registration is still live as of this filing.
 - b. The ROCKET MEDIA Mark is directed to the services of “Advertising agencies; Advertising, marketing and promotion services; Marketing and consulting services in the field of promoting and tracking the goods, services, and brands of others through all public communication means, particularly specializing in the use of mobile, social, on-line and print media to drive consumer interest, engagement and action; social media strategy and marketing consultancy focusing on helping clients create and extend their product and brand strategies by building virtually engaging marketing solutions.” These services encompass every service listed in the Registration for the ROCKET SPORTS Mark, and are expected to share the same trade

channels. Indeed, a consumer could easily draw the conclusion that “Rocket Sports” is a branch of “Rocket Media” specializing in the marketing of sports businesses.

c. Registrant alleged in its Notice of Opposition that Counterclaimant's ROCKET MESH Mark is confusingly similar to the ROCKET SPORTS Mark, although the two are registered in different International Classes selling different goods and services. This is an inherent admission by Registrant that the ROCKET SPORTS Mark is confusingly similar to the ROCKET MEDIA Mark, which is registered in the same International Class for very similar services, and which is at least equally similar to ROCKET SPORTS in appearance, sound, connotation, and commercial impression as ROCKET MESH is.

d. Therefore, consistent with Registrant's admissions, the ROCKET SPORTS Mark is confusingly similar to the prior ROCKET MEDIA Mark and thereby barred from registration.

7. On information and belief, and based upon Registrant's admissions in the Opposition, the Registration should have also been barred by at least prior Trademark Reg. No. 2,734,981 for “ROCKET” (the ROCKET Mark).

a. The ROCKET Mark was registered in International Class 28 on July 8, 2003, prior to both the alleged first use date and the filing date of the ROCKET SPORTS Mark. Its registration is still live as of this filing.

b. The ROCKET Mark is directed to the goods of “Golf club shafts distributed exclusively to golf club manufacturers and golf club refitters.”

- c. Registrant alleged in its Notice of Opposition that the ROCKET MESH Mark is confusingly similar to the ROCKET SPORTS Mark, although ROCKET MESH is registered for goods in International Class 28 directed to sports equipment rather than marketing services. This is an inherent admission by Registrant that the ROCKET SPORTS Mark is confusingly similar to the ROCKET Mark, which is also registered for goods in International Class 28 directed to sports equipment, and which is more similar to ROCKET SPORTS in appearance, sound, connotation, and commercial impression than ROCKET MESH is. Indeed, ROCKET SPORTS wholly incorporates the ROCKET Mark.
- d. Therefore, consistent with Registrant's admissions, the ROCKET SPORTS Mark is confusingly similar to the prior ROCKET Mark and thereby barred from registration.

On the basis of the allegations set forth above, Counterclaimant believes that the ROCKET SPORTS Mark should have been barred from registration, and therefore requests that Trademark Reg. No. 5,297,623 for the ROCKET SPORTS Mark be cancelled.

As it is unclear whether this counterclaim will be entered by the Board, the Cancellation fee is not included at this time. However, in the event the accompanying Motion is granted and the counterclaim entered, such that a fee for the filing of the counterclaim and/or any further fees are required, the Director of Patents and Trademarks is hereby authorized to charge such to Deposit Account 50-5298.

MR4861-2

Opposition No. 91237356

Applicant's Amended Answer to Opposer's Amended Notice of Opposition – Clean

WHEREFORE, Applicant/Counterclaimant prays that this Board find in favor of Applicant/Counterclaimant, cancel Opposer/Registrant's mark, and deny and dismiss with prejudice the Notice.

Respectfully submitted,
FOR: ROSENBERG, KLEIN & LEE

DATE: December 29, 2018

/Christopher Reaves/
Christopher Reaves

/Morton J. Rosenberg/
Morton J. Rosenberg

Attorneys for Applicant
3458 Ellicott Center Drive, Suite 101
Ellicott City, MD 21043
Phone: 410-465-6678
RKL@rklpatlaw.com

CERTIFICATE OF SERVICE

I hereby certify that on December 29, 2018, I served a copy of the Document entitled on **APPLICANT'S AMENDED ANSWER TO OPPOSER'S AMENDED NOTICE OF OPPOSITION** on Opposer by sending a true and correct copy of the Document by email to Paul Koda at paul@kodafirm.com.

/Christopher Reaves/
Christopher Reaves

EXHIBIT B

MR4861-2

Opposition No. 91237356

Applicant's Amended Answer to Opposer's Amended Notice of Opposition – Marked

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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3. FOR A FURTHER, SEPARATE AND DISTINCT DEFENSE, Applicant alleges it is informed and believes, and based upon such information and belief, that Opposer is barred from seeking any relief herein because third parties have used similar marks for similar goods, thus Opposer's mark is weak and entitled to a narrow scope of protection. 87 records appear when searching the USPTO Database for Live marks in Class 35; 160 records appear if the search is expanded to also include Class 28.

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7. Applicant alleges that it is informed and believes, and based upon such information and belief, that it may have additional defenses not currently available and that may be available after completion of initial disclosures and discovery, and therefore reserves the right to set forth additional defenses as information becomes available.

COUNTERCLAIM

Counterclaimant Dexter Kan (Counterclaimant) is an individual residing at 3681 Hollyberry Drive, Huntingtown, Maryland 20639, doing business as “Rocket Mesh Lacrosse.”

The registrant and current owner (Registrant) of Trademark Reg. No. 5,297,623 (the Registration) for “ROCKET SPORTS” in International Class 35 (the ROCKET SPORTS Mark) is Rocket Sports, LLC, a Maryland limited liability company with a place of business located at 4 Baederwood Court, Derwood, Maryland 20855.

For the reasons provided below, Counterclaimant believes that he will be damaged by the Registration, and hereby petitions to cancel the same under 15 U.S.C. § 1064(1) and 37 CFR § 2.111 on the grounds of confusing similarity of the ROCKET SPORTS Mark with at least one prior mark.

1. Counterclaimant filed Trademark Application No. 87/385,665, for registration of “ROCKET MESH” in International Class 28 for “Lacrosse balls; Lacrosse sticks” (the ROCKET MESH Mark), on March 25, 2017.

2. Counterclaimant has invested in an inventory of goods relating to lacrosse balls and lacrosse sticks, bearing the ROCKET MESH Mark.
3. On October 21, 2017, Registrant filed Opposition No. 91237356 to oppose registration of the ROCKET MESH Mark, basing the Opposition on the Registration alleging prior use of the ROCKET SPORTS Mark in commerce.
4. Registrant has also threatened to bring an action of trademark infringement of the Registration if Counterclaimant continues to sell goods of any variety bearing the ROCKET MESH Mark.

On the basis of the allegations set forth above, Counterclaimant believes that Registrant's hostile assertion of the Registration against him will damage Counterclaimant, and Counterclaimant therefore has standing to petition for cancellation of the Registration.

5. Registrant filed for registration of the ROCKET SPORTS Mark on June 19, 2016, for the services of "Marketing services for the sports equipment of others; marketing services in the field of sports equipment; marketing services, namely, promoting or advertising the goods and services of others; marketing, promotional and advertising services provided by mobile telephone connections; marketing, advertising, and promoting the retail goods and services of others through wireless electronic devices; promoting and marketing the goods and services of others by distributing advertising material, coupons and discount offers via text messages; promoting and marketing the goods and services of others by websites and social media; promoting the goods and services of others by means of word-of-mouth and nontraditional marketing programs; promoting the sale of goods and services of others by websites and social media; advertising and marketing services, namely, promoting the goods and services

- of others; advertising, marketing, and promoting the goods and services of others via websites and social media; on-line advertising and marketing services; providing marketing services for the sports equipment industry; reseller services, namely, distributorship services in the field of sports equipment.” The ROCKET SPORTS Mark was registered on September 26, 2017 in International Class 35, and alleges a first use in commerce of January 10, 2017.
6. On information and belief, and based upon Registrant's admissions in the Opposition, the Registration should have been barred by at least prior Trademark Reg. No. 4,069,932 for “ROCKET MEDIA” (the ROCKET MEDIA Mark).
- a. The ROCKET MEDIA Mark was registered in International Class 35 on December 13, 2011, prior to both the alleged first use date and the filing date of the ROCKET SPORTS Mark Registration. Its registration is still live as of this filing.
- b. The ROCKET MEDIA Mark is directed to the services of “Advertising agencies; Advertising, marketing and promotion services; Marketing and consulting services in the field of promoting and tracking the goods, services, and brands of others through all public communication means, particularly specializing in the use of mobile, social, on-line and print media to drive consumer interest, engagement and action; social media strategy and marketing consultancy focusing on helping clients create and extend their product and brand strategies by building virtually engaging marketing solutions.” These services encompass every service listed in the Registration for the ROCKET SPORTS Mark, and are expected to share the same trade

channels. Indeed, a consumer could easily draw the conclusion that “Rocket Sports” is a branch of “Rocket Media” specializing in the marketing of sports businesses.

c. Registrant alleged in its Notice of Opposition that Counterclaimant's ROCKET MESH Mark is confusingly similar to the ROCKET SPORTS Mark, although the two are registered in different International Classes selling different goods and services. This is an inherent admission by Registrant that the ROCKET SPORTS Mark is confusingly similar to the ROCKET MEDIA Mark, which is registered in the same International Class for very similar services, and which is at least equally similar to ROCKET SPORTS in appearance, sound, connotation, and commercial impression as ROCKET MESH is.

d. Therefore, consistent with Registrant's admissions, the ROCKET SPORTS Mark is confusingly similar to the prior ROCKET MEDIA Mark and thereby barred from registration.

7. On information and belief, and based upon Registrant's admissions in the Opposition, the Registration should have also been barred by at least prior Trademark Reg. No. 2,734,981 for “ROCKET” (the ROCKET Mark).

a. The ROCKET Mark was registered in International Class 28 on July 8, 2003, prior to both the alleged first use date and the filing date of the ROCKET SPORTS Mark. Its registration is still live as of this filing.

b. The ROCKET Mark is directed to the goods of “Golf club shafts distributed exclusively to golf club manufacturers and golf club refitters.”

- c. Registrant alleged in its Notice of Opposition that the ROCKET MESH Mark is confusingly similar to the ROCKET SPORTS Mark, although ROCKET MESH is registered for goods in International Class 28 directed to sports equipment rather than marketing services. This is an inherent admission by Registrant that the ROCKET SPORTS Mark is confusingly similar to the ROCKET Mark, which is also registered for goods in International Class 28 directed to sports equipment, and which is more similar to ROCKET SPORTS in appearance, sound, connotation, and commercial impression than ROCKET MESH is. Indeed, ROCKET SPORTS wholly incorporates the ROCKET Mark.
- d. Therefore, consistent with Registrant's admissions, the ROCKET SPORTS Mark is confusingly similar to the prior ROCKET Mark and thereby barred from registration.

On the basis of the allegations set forth above, Counterclaimant believes that the ROCKET SPORTS Mark should have been barred from registration, and therefore requests that Trademark Reg. No. 5,297,623 for the ROCKET SPORTS Mark be cancelled.

As it is unclear whether this counterclaim will be entered by the Board, the Cancellation fee is not included at this time. However, in the event the accompanying Motion is granted and the counterclaim entered, such that a fee for the filing of the counterclaim and/or any further fees are required, the Director of Patents and Trademarks is hereby authorized to charge such to Deposit Account 50-5298.

MR4861-2

Opposition No. 91237356

Applicant's Amended Answer to Opposer's Amended Notice of Opposition – Marked

WHEREFORE, Applicant/Counterclaimant prays that this Board find in favor of Applicant/Counterclaimant, cancel Opposer/Registrant's mark, and deny and dismiss with prejudice the Notice.

Respectfully submitted,
FOR: ROSENBERG, KLEIN & LEE

DATE: December 29, 2018

/Christopher Reaves/
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/Morton J. Rosenberg/
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CERTIFICATE OF SERVICE

I hereby certify that on December 29, 2018, I served a copy of the Document entitled on **APPLICANT'S AMENDED ANSWER TO OPPOSER'S AMENDED NOTICE OF OPPOSITION** on Opposer by sending a true and correct copy of the Document by email to Paul Koda at paul@kodafirm.com.

/Christopher Reaves/
Christopher Reaves