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

Proceeding no.	91275359
Party	Defendant UNITYPAY LLC
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Submission	Answer and Counterclaim
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Signature	/Evan A. Raynes/
Date	05/09/2022
Attachments	2022-05-09 - UNITYPAY - Answer and Counterclaims.pdf(138584 bytes)

Registration subject to the submission

Registration no.	4978183	Registration date	06/14/2016
Register	Principal		
Registrant	Unity IPR ApS NIELS HEMMINGSENS GADE 24 COPENHAGEN K, 1153 DENMARK Email: unity@ipla.com		

Goods/services subject to the submission

<p>Class 009. First Use: Jun 6, 2005 First Use In Commerce: Jun 6, 2005 Requested goods and services in the class: 3D and 2D graphics software for use in creating multi-player game and non-game worlds; Computer platform software for creating computer games, online games, multi-player computer games, interactive 3D game worlds, and mixed 3D and 2D content; Computer editing software for editing images, sound and video; Computer gamesoftware; Computer software, namely, game engine software for video game development and operation; Downloadable electronic game programs for social networking, namely, for posting, showing, or displaying information in the field of electronic gaming via the Internet or other communications networks with third parties that may be accessed via the Internet, computers, mobile phones, smart phones, tablet computers, and gaming consoles; Virtual reality software for creating virtual and augmented reality experiences; Computer software used to process mobile payments; Computer software for the storage, transmission, verification, processing and authentication of credit and debit card and other payment and transaction information; Computer software for ensuring the security of mobile payments; Computer software for providing an online database in the field of transaction processing to upload transactional data, provide statistical analysis, and produce notifications and reports</p>
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Grounds for cancellation

Mark never used in commerce	Trademark Act Section 14(6)
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Registration subject to the submission

Registration no.	6121758	Registration date	08/11/2020
Register	Principal		
Registrant	Unity IPR ApS NIELS HEMMINGSENS GADE 24 COPENHAGEN K, 1153 DENMARK Email: unity@ipla.com		

Goods/services subject to the submission

<p>Class 009. First Use: Jun 6, 2005 First Use In Commerce: Jun 6, 2005 Requested goods and services in the class: Downloadable and recorded computer software for creating computer applications, computer games, online games, online computer applications, multi- player computer games, interactive 3D game and non- game worlds, mixed 3D and 2D content, films, television programs, videos, and digital media; Downloadable and recorded computer software for enabling remote access to computer software for creating computer applications, computer games, online games, online computer applications, multi- player computer games, interactive 3D game and non- game worlds, mixed 3D and 2D content, films, television programs, videos and digital media; Downloadable and recorded computer software for enabling, operating, and displaying computer applications, computer games, online games, online computer applications, multi-player computer games, interactive 3D game and non-game worlds, mixed 3D and 2D content, films, television programs, videos and digital media; Downloadable and recorded computer software for editing images, sound, video, and digital media; Downloadable and recorded computer games software; Downloadable and recorded computer software for video game development and operation; Downloadable and recorded computer software for creating virtual, augmented, mixed reality, and extended reality experiences; Downloadable and recorded computer software, namely, software for digital virtual agents, intelligence agents, predictive systems, cognitive process automation, visual computing applications, knowledge virtualization, robotics, natural language processing, genetic and deep learning algorithms, reinforcement learning, semantic ontologies, pattern recognition, knowledge modeling technologies, cognitive enhancement in respect of experience and productivity, accelerating processes, automation, and autonomy in the field of artificial intelligence; Downloadable computer- aided design (CAD) software for general use; Downloadable and recorded computer software for driving simulation and guidance; Downloadable software development kits (SDK); Downloadable and recorded computer software for enabling service providers to optimize user monetization, marketing, and satisfaction; Downloadable and recorded computer software for enabling processing of mobile payments; Downloadable and recorded computer software for providing an online database in the field of transaction processing to upload transactional data, provide statistical analysis, and produce notifications and reports; Downloadable and recorded computer software for delivery of online advertising; Downloadable and recorded computer software, namely, software for the delivery of educational materials, tutorials, certification tests, and exams in the fields of software development and digital content creation; Electronic downloadable educational publications, instructional materials, educational materials, teaching materials, tutorial materials, study materials, self-study preparation materials, namely, magazines, newsletters, guides, and manuals, and electronic downloadable practice exams in the fields of software development and digital content creation</p>

Grounds for cancellation

Other	Partial cancellation or limitation, Trademark Act Section 18.
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economically or legally harmed by the registration of the mark. Applicant admits its address is "9801 Washingtonian Boulevard, Suite 200, Gaithersburg, MD 20878."

OPPOSER'S BUSINESS AND TRADEMARK RIGHTS

2. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations and inferences contained in this paragraph and therefore denies those allegations and inferences.

3. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations and inferences contained in this paragraph and therefore denies those allegations and inferences.

4. Applicant admits that, according to the records of the USPTO, Opposer owns the trademarks listed in this paragraph ("Opposer's Marks") and the registrations listed in this paragraph ("Opposer's Registrations"). Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations and inferences contained in this paragraph and therefore denies those allegations and inferences. In particular, Applicant denies the inference that Opposer is the exclusive owner of Opposer's Marks for all goods and services, including Applicant's services.

5. Applicant admits that, according to the records of the USPTO, Opposer owns Opposer's Marks. Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations and inferences contained in this paragraph and therefore denies those allegations and inferences. In particular, Applicant denies the inference that Opposer is the exclusive owner of Opposer's Marks for all goods and services, including Applicant's services.

APPLICANT AND ITS PENDING APPLICATION

6. Admitted.

7. Admitted.

8. Admitted.

COUNT I
Likelihood of Confusion
(15 U.S.C. § 1052(d) and 15 U.S.C. § 1125(a))

9. This paragraph incorporates the above paragraphs of the Notice of Opposition by reference and does not require a separate response. Applicant incorporates the preceding responses to the above paragraphs of the Notice of Opposition by reference.

10. Applicant admits that, according to the records of the USPTO, applications for Opposer's Marks were filed prior to the filing date of Applicant's application, and that registrations for the first seven of Opposer's Registrations issued prior to the filing date of Applicant's application. Applicant denies that the last three of Opposer's Registrations issued prior to the filing date of Applicant's application, namely, the registrations for the UNITY MARS, UNITY FORMA, and UNITY PLAY trademarks. Applicant denies the remaining allegations and inferences contained in this paragraph.

11. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations and inferences contained in this paragraph and therefore denies those allegations and inferences.

12. Applicant admits that its UNITYPAY trademark and the trademarks asserted by Opposer contain the term "UNITY." Applicant denies the remaining allegations and inferences contained in this paragraph.

13. Denied.

14. Applicant admits that, under U.S. law, Applicant is deemed to have constitutive knowledge of Opposer's Registrations. However, Applicant denies that such constructive knowledge is relevant in this case given that there is no likelihood of confusion between the

parties' marks. Applicant denies the remaining allegations and inferences contained in this paragraph.

15. Denied.

COUNT II
Likelihood of Dilution
(15 U.S.C. § 1125(c))

16. This paragraph incorporates the above paragraphs of the Notice of Opposition by reference and does not require a separate response. Applicant incorporates the preceding responses to the above paragraphs of the Notice of Opposition by reference.

17. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations and inferences contained in this paragraph and therefore denies those allegations and inferences.

18. Denied.

Opposer's concluding paragraph is a prayer for relief to which no response is required.

AFFIRMATIVE DEFENSES

1. Count I fails to state a claim on which relief can be granted because it states that the parties' marks are "confusingly similar," whereas the relevant standard is "likelihood of confusion."

2. Count I fails to state a claim on which relief can be granted because Applicant fails to state, with any specificity, why it allegedly believes that the parties' marks are "confusingly similar," except that Opposer's Marks and Applicant's Mark contain the word "UNITY." Count I also fails to state a claim upon which relief can be granted because Opposer fails to state why it allegedly believes that the word "PAY" in Applicant's mark, which is part of the unitary mark UNITYPAY, is descriptive.

3. Count II fails to state a claim upon which relief can be granted because Opposer's identifications and goods and services show that such goods and services are highly specialized, and as a result, any fame that can be ascribed to Opposer's Marks is niche fame, which is not sufficient to support a claim of dilution in these proceedings.

4. Opposer's claims are precluded because Opposer is engaging in trademark misuse in that Opposer is attempting to improperly extend the scope of its rights in the word "UNITY" against Applicant.

5. Opposer's claims are precluded because Opposer is engaging in trademark misuse in that Opposer has attempted and is attempting to improperly extend the scope of its rights in the word "UNITY" against Applicant and others.

6. Opposer's claims are precluded by the doctrine of unclean hands in that Opposer is seeking to assert exclusive rights in the word "UNITY" against Applicant, which it knows or has reason to know is an improper assertion of its rights in this word.

7. Opposer's claims are precluded by the doctrine of unclean hands in that Opposer is seeking to assert exclusive rights in the word "UNITY" against Applicant and others, which it knows or has reason to know is an improper assertion of its rights in this word.

8. Opposer does not have exclusive rights in the word "UNITY" for all goods and services.

WHEREFORE, Applicant requests that the Board dismiss the opposition on grounds of an absence of any likelihood of confusion or dilution.

**COUNTERCLAIM FOR
PARTIAL CANCELLATION OR LIMITATION OF REGISTRATIONS**

Applicant UnityPay LLC ("Applicant") submits the following counterclaims against Opposer Unity IPR ApS ("Opposer") in these proceedings. Applicant's statements are made

upon actual knowledge with respect to itself and its own acts, and upon information and belief as to all other matters.

1. Applicant is A Delaware limited liability company with an address of 9801 Washingtonian Boulevard, Suite 200, Gaithersburg, Maryland 20878.

2. Opposer is a Danish private limited company having its principal place of business at Niels Hemmingsens Gade 24 Copenhagen K, Denmark.

3. Upon information and belief, Opposer is not using the UNITY trademark in commerce for payment or transaction processing software, and as a result, such goods should be deleted from Opposer's registrations covering such goods.

4. Partially cancelling Opposer's Registrations as to payment and transaction processing software will conclusively avoid any finding of a likelihood of confusion in these proceedings.

5. Upon information and belief, to the extent that Opposer is using the UNITY trademark in commerce for payment or transaction processing software, the mark is only used for payment or transaction processing software used to purchase computer game and graphics software, not for merchant services and associated payment transaction processing software, and as a result, Opposer's registrations covering such goods should be partially cancelled, limited, restricted, or rectified to indicate that this is the case.

6. Partially cancelling, limiting, restricting, or rectifying Opposer's Registrations covering payment or transaction processing software to indicate that Opposer is only using the UNITY mark for payment or transaction processing software used to purchase computer game and graphics software, not for merchant services and associated payment transaction processing software, will conclusively avoid any finding of a likelihood of confusion in these proceedings.

7. The registrations and the goods and services that Applicant seeks to partially cancel and/or limit, restrict, or rectify are as follows.

	Mark	Reg. No.	Reg. Date	Goods and Services
1.	UNITY	4978183	June 14, 2016	Class 9: Computer software used to process mobile payments; Computer software for the storage, transmission, verification, processing and authentication of credit and debit card and other payment and transaction information; Computer software for ensuring the security of mobile payments; Computer software for providing an online database in the field of transaction processing to upload transactional data, provide statistical analysis, and produce notifications and reports
2.	UNITY	6121758	August 11, 2020	Class 9: Downloadable and recorded computer software for enabling processing of mobile payments; Downloadable and recorded computer software for providing an online database in the field of transaction processing to upload transactional data, provide statistical analysis, and produce notifications and reports

8. The registrations summarized in the preceding paragraph are attached to Opposer's Notice of Opposition.

9. Applicant has standing to challenge the above registrations by virtue of the fact that Opposer has asserted the registrations against Applicant in these proceedings.

COUNT I
Partial Cancellation of Registration No. 4978183
(15 U.S.C. § 1064(6))

10. Applicant realleges and incorporates the preceding allegations of this counterclaim by reference.

11. Section 14(6) of the Trademark Act, 15 U.S.C. § 1064(6), provides that a registration may be cancelled in whole or in part "At any time after the three-year period following the date of registration, if the registered mark has never been used in commerce on or in connection with some or all of the goods or services recited in the registration."

12. Opposer is not using the UNITY mark shown in U.S. Trademark Registration No. 4978183 for "Computer software used to process mobile payments; Computer software for the storage, transmission, verification, processing and authentication of credit and debit card and other payment and transaction information; Computer software for ensuring the security of mobile payments; Computer software for providing an online database in the field of transaction processing to upload transactional data, provide statistical analysis, and produce notifications and reports," in Class 9, and/or is only using the mark for payment or transaction processing software used to purchase computer game and graphics software, not for merchant services or associated payment transaction processing software.

13. Thus, Applicant requests partial cancellation of U.S. Trademark Registration No. 6121758 for "Computer software used to process mobile payments; Computer software for the storage, transmission, verification, processing and authentication of credit and debit card and other payment and transaction information; Computer software for ensuring the security of mobile payments; Computer software for providing an online database in the field of transaction processing to upload transactional data, provide statistical analysis, and produce notifications and reports," in Class 9.

COUNT II
Partial Cancellation or Limitation of Registration No. 6121758
(15 U.S.C. § 1068)

14. Applicant realleges and incorporates the preceding allegations of this counterclaim by reference.

15. Section 18 of the Trademark Act, 15 U.S.C. § 1068, provides that the Board "may cancel the registration, in whole or in part, may modify the application or registration by limiting the goods or services specified therein, may otherwise restrict or rectify with respect to the register the registration of a registered mark"

16. Opposer is not using the UNITY mark shown in U.S. Trademark Registration No. 6121758 for "Downloadable and recorded computer software for enabling processing of mobile payments; Downloadable and recorded computer software for providing an online database in the field of transaction processing to upload transactional data, provide statistical analysis, and produce notifications and reports," and/or is only using the mark for payment or transaction processing software used to purchase computer game and graphics software, not for merchant services or associated payment transaction processing software.

17. Thus, Applicant requests partial cancellation of U.S. Trademark Registration No. 6121758 for "Downloadable and recorded computer software for enabling processing of mobile payments; Downloadable and recorded computer software for providing an online database in the field of transaction processing to upload transactional data, provide statistical analysis, and produce notifications and reports," in Class 9, and/or limiting, restricting, or rectifying the registration to indicate that Opposer's mark is only used for payment or transaction processing software used to purchase computer game and graphics software, not for merchant services or associated payment transaction processing software.

WHEREFORE, Applicant requests that the Board partially cancel and/or limit Opposer's registrations as set forth above.

Respectfully submitted,

Dated: May 9, 2022

/Evan A. Raynes/

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CERTIFICATE OF SERVICE

I certify that a copy of the attached ANSWER was served on the following person by email on May 9, 2022.

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/Evan A. Raynes /

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