

ESTTA Tracking number: **ESTTA1304670**

Filing date: **08/18/2023**

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

Proceeding no.	91281414
Party	Plaintiff Niccolò Mascaro
Correspondence address	ROBYN S. LEDERMAN BROOKS KUSHMAN P.C. 1000 TOWN CENTER, 22ND FLOOR SOUTHFIELD, MI 48075 UNITED STATES Primary email: trademarks@brookskushman.com Secondary email(s): rcantor@brookskushman.com, rlederman@brookskushman.com 248-358-4400
Submission	Motion to Amend Pleading/Amended Pleading
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Signature	/rebecca j cantor/
Date	08/18/2023
Attachments	TREEDEFI Second Amended NOO.PDF(431535 bytes) Exhibit 1 to Amended NOO.PDF(1008253 bytes)

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

In re Trademark Application Serial No. 90881203
Filed: August 13, 2021
Published: June 28, 2022
Trademark: TREEDEFI

NICCOLÒ MASCARO)	
)	
Opposer,)	
)	
v.)	Opposition No. 91281414
)	
TREEDEFI LTD)	
)	
Applicant.)	

SECOND AMENDED NOTICE OF OPPOSITION

VIA ELECTRONIC FILING
Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

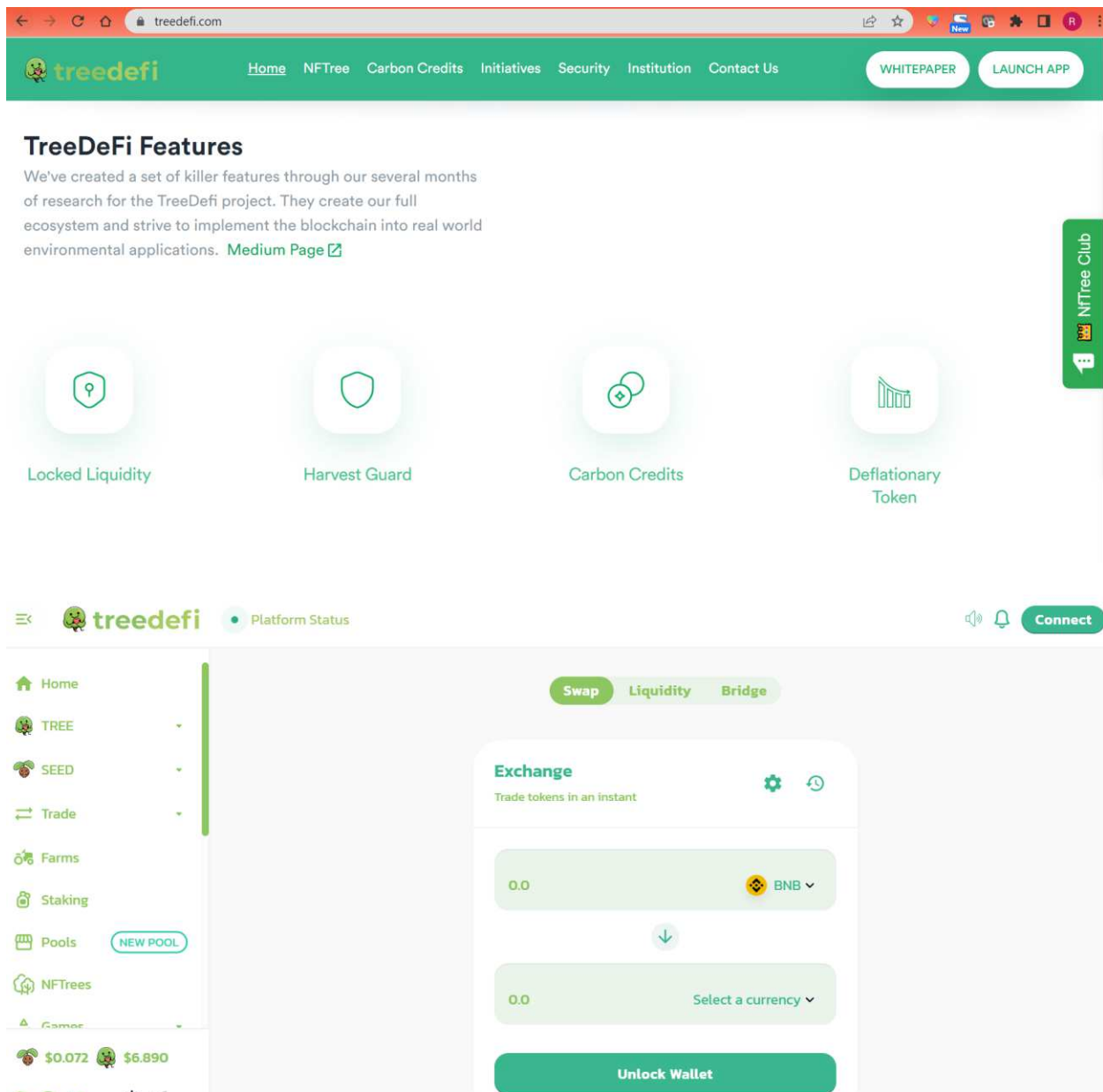
Sir/Madam:

Niccolò Mascaro (“Opposer”), an Italian citizen residing at Via Somalia No. 289, Rome, 00199, Italy believes that he is will be damaged if Applicant is allowed to register TREEDEFI in Classes 9 and 42 as set forth in U.S. Trademark Application No. 90881203 in the name of TreeDeFi Ltd. (“Applicant”), a UK private limited company located at 57A Maberley Road, London, United Kingdom SE192JE, and hereby opposes registration of the same.

As grounds for opposition, Opposer alleges as follows:

1. Opposer is one of the creators of a decentralized finance platform that aims to help the environment by planting trees. Opposer operates that platform under the name TREEDEFI.

TREEDEFI uses and exploits new fintech tools (*e.g.*, blockchain, cryptocurrency, and tokens) to raise funds aimed at financing eco-friendly projects, such as the planting of trees around the world. To date, nearly 37,000 trees have been planted through Opposer’s TREEDEFI platform which absorb over 800,000 kg of carbon dioxide each year. These goods and services will be referred to as the “Opposer’s Goods and Services.” Screenshots of Opposer’s website are shown below:



2. Since at least March 2021, Opposer has operated a website at treedefi.com, which

allows users to finance the planting of trees. The source code for this website and the TreeDeFi infrastructure is stored in a Github repository created and owned by Opposer. Opposer also owns the Amazon Web Service platform account that runs the code for the website and the Google email service account that is used to manage all emails for the treedefi.com domain. This website is fully accessible throughout the US. Opposer operates this website using a cryptocurrency website owned by Opposer and a Monday account, which is also owned by Opposer. In addition to treedefi.com, Opposer also owns treedefi.info (registered 3/13/2021), treedefi.net (registered 6/14/2021), treedefi.app (registered 6/14/2021), treedefi.io (registered 6/3/2021), treedefi.app (registered 6/14/2021), treedefi.org (registered 6/14/2021), treedefi.eu (registered 6/14/2021), treedefi.store (registered 10/11/2022), treedefi.ventures (registered 10/21/2022), and treedefi.exchange (registered 11/24/2022).

3. Opposer also owns several social media accounts for TreeDeFi, including on YouTube, Facebook, Instagram, Twitter, Telegram, and Medium.

4. As a result of its use of TREEDEFI, Opposer has obtained common law rights in its TREEDEFI mark for Opposer's Goods and Services throughout the United States.

5. Opposer has expended considerable time, effort, and expense in advertising and promoting the TREEDEFI mark, and the goods and services associated with it, throughout the United States, with the result that the purchasing public has come to know and recognize goods and services of Opposer by the TREEDEFI mark. Opposer has exceedingly valuable goodwill established in the TREEDEFI mark.

6. When Opposer first started TREEDEFI, he worked in collaboration with other individuals including Gheorhe Daniel Morosan and Lorenzo Castagnone to create the treedefi.com website. Opposer alone registered and paid for the treedefi.com domain.

7. Unbeknownst to Opposer, sometime prior to August 13, 2021, Messrs. Morosan and Castagnone formed Applicant TreeDeFi Ltd in secret. Opposer was never aware of the creation of Applicant, and Applicant did not have any rights to file a trademark application for TREEDEFI.

8. Upon information and belief, around the time Messrs. Morosan and Castagnone founded TreeDeFi Ltd., they also edited a small portion of the code which powers a fraction of the Exchange Service on the dex.treedefi.com website (a subdomain of treedefi.com) in an attempt to indicate TreeDeFi Ltd. was the license holder for the all website, by adding the wording “SPDX-LICENCE: TREEDEFI LTD 13410488.”¹ This wording is not visible to the general community. Rather, only a few experts who are able to read the source code can reach the exact location of this code and read the wording. Despite making this representation, at no time did Messrs. Morosan and Castagnone or TreeDeFi Ltd. have any rights in the treedefi.com website, including at the time Messrs. Morosan and Castagnone made this change to the code.

9. While Messrs. Morosan and Castagnone listed that TREEDEFI LTD 13410488 license in this source code for dex.treedefi.com website, there is no such license. The TreeDeFi SPDX does not exist in the SPDX License official and public database.

10. In or around April 2022, Messrs. Morosan and Castagnone ceased working with Opposer on TREEDEFI. Opposer, Messrs. Morosan and Castagnone, and Opposer’s other partner came to an agreement whereby Opposer would continue to use the TREEDEFI mark for its decentralized finance platform and Messrs. Morosan and Castagnone would leave the project. The parties had conversations in which they agreed that Messrs. Morosan and Castagnone would exit TreeDeFi and Mr. Mascaro would be the sole owner of TreeDeFi. Translations of portions of these

¹ Software Package Data Exchange or “SPDX” is an open standard for communicating, *inter alia*, licenses information relating to software and websites. The listing of an SPDX license is irrelevant to trademark ownership.

conversations are attached hereto as Exhibit 1. The parties subsequently memorialized portions of their agreement regarding finances in writing. Copies of this agreement and a translation thereof can be found at 6 TTABVUE Exhibits A and B. As can be seen, this agreement did not give Applicant any rights in the TREEDEFI mark, nor did it give Applicant or Messrs. Morosan and Castagnone any right to use the TREEDEFI mark.

11. In or around June 2022, Mr. Mascaro discovered that Messrs. Morosan and Castagnone had edited the code on treedefi.com to include TreeDeFi Ltd. as the license holder for the website. Shortly thereafter, on or around June 13, 2022, Mr. Mascaro asked Mr. Castagnone whether the inclusion of TreeDeFi Ltd. as the license holder of the treedefi.com website indicated that TreeDeFi Ltd. had any intellectual property rights in the TREEDEFI mark. Mr. Castagnone responded that it did not.

12. On August 13, 2021, Applicant filed a trademark application for TREEDEFI for the following goods:

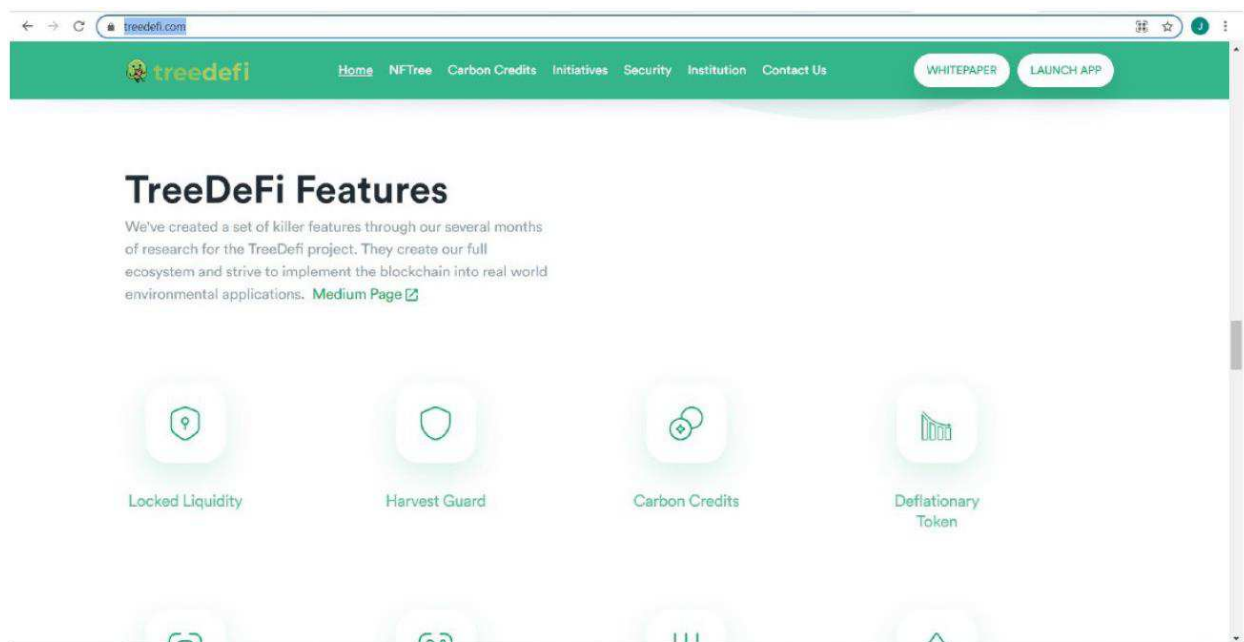
Computer software platforms, downloadable, for processing and managing blockchain operations; Downloadable computer application software for mobile phones, namely, software for processing and managing blockchain operations via a wallet app; Downloadable computer software for processing and managing blockchain operations; Downloadable computer software for blockchain-based inventory management; Downloadable computer software for managing cryptocurrency transactions using blockchain technology; Downloadable computer software development tools in Class 9; and

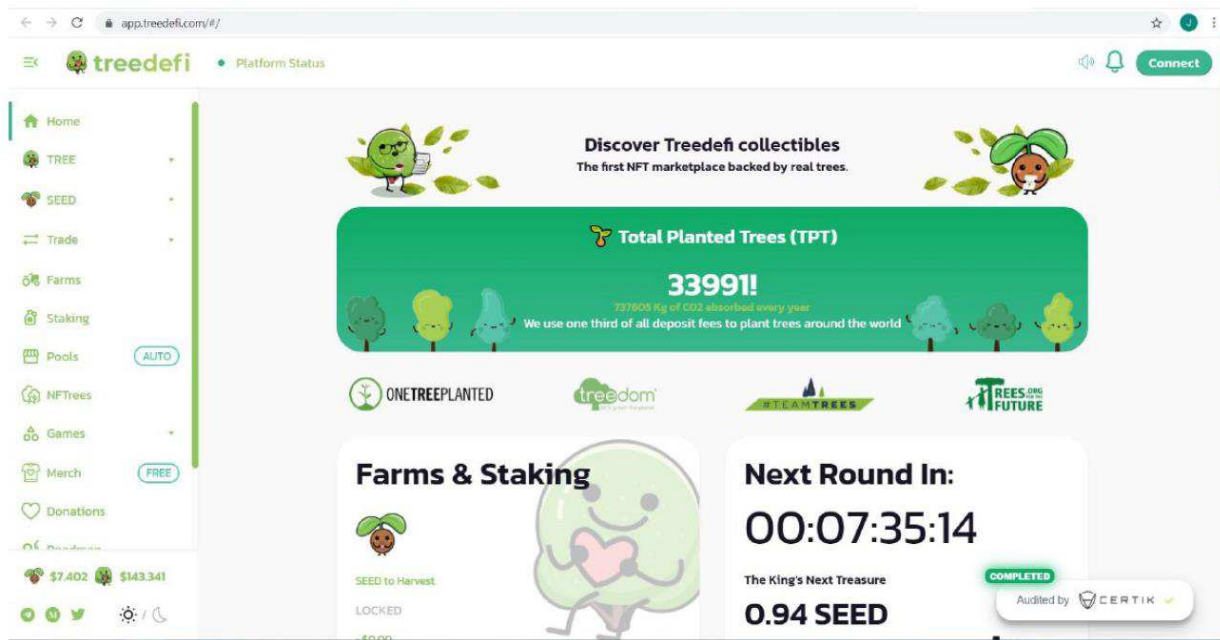
Authentication of data in the field of financial transaction using blockchain technology; Computer programming; Computer software development; Information technology consulting services; Providing temporary use of on-line non-downloadable software for accessing, reading, and tracking information in the field of financial transaction on a blockchain; Software design and development; Platform as a service (PAAS) featuring computer software platforms for managing financial transactions using blockchain; Software as a service (SAAS) services featuring software for managing financial transactions using blockchain in Class 42

This is evidenced by publication of the mark in the *Official Gazette* on June 28, 2022. Applicant filed

this application under Section 1(a) for the goods in Class 42 and under Section 1(b) for the goods in Class 9. This application was assigned serial number 90881203 (the “’203 Application”). The goods and services identified in this Application shall be referred to as “Applicant’s Goods and Services.”

13. With respect to Class 42, Applicant filed the specimen reproduced below. As can be seen, these are screenshots of Opposer’s website and therefore show Opposer’s use of the TREEDEFI mark—not Applicant’s.





14. Upon information and belief, when Applicant filed the '203 Application it was not using the TREEDEFI mark in commerce, including on the goods identified in Class 42.

15. Applicant did not obtain Opposer's consent before it filed the '203 Application. Indeed, Applicant did not inform Opposer of the filing.

16. Upon information and belief, when Applicant filed the '203 Application, it was aware that Opposer had rights in the TREEDEFI mark.

17. Upon information and belief, when Applicant filed the '203 Application, it was aware that it did not own the TREEDEFI mark for the goods identified in Class 42.

18. Upon information and belief, when Applicant filed the '203 Application, it lacked a *bona fide* intent to use the goods identified in Class 9.

19. In As described above, Applicant was not the owner of TREEDEFI for the goods identified in Class 42 when it filed the '203 Application. As such, the '203 Application is void *ab initio* for lack of ownership with respect to the goods in Class 42.

20. The '203 Application is also void *ab initio* with respect to the goods in Class 42

because Applicant was not using the TREEDEFI mark in commerce at the time it filed the Application as described above.

21. The '203 Application is also invalid with respect to the goods in Class 9 for lack of *bona fide* intent to use the mark in commerce and should be refused registration with respect to the goods in Class 9 under 15 U.S.C. § 1126(e).

22. Opposer will be harmed if Applicant is allowed to register TREEDEFI. If Applicant were granted the registration herein opposed, it would obtain at least a *prima facie* exclusive right to use of the TREEDEFI mark in connection with the designated goods and services. Such registration would be a source of injury and damage to Opposer's prior and established rights in the TREEDEFI Marks.

23. Accordingly, Applicant's TREEDEFI mark shown in Application Serial No. 90881203 should be refused registration for the following reasons: (1) Applicant's lack of ownership of the mark for the goods in Class 42; (2) Applicant's lack of use of the mark in commerce for the goods in Class 42; and (3) Applicant's lack of *bona fide* intent to use the mark in commerce for the goods in Class 9.

WHEREFORE, Applicant prays that this opposition be sustained, and Applicant's U.S. Trademark Application Serial No. 90881203 be denied registration.

Opposer does not believe a fee is required for this Amended Notice of Opposition. If a fee is required, however, please charge any required fee to Deposit Account 502337.

Respectfully submitted,

By: /s/ Rebecca J. Cantor
Robyn S. Lederman
Rebecca Cantor
Attorneys for Opposer

Date: August 18, 2023

BROOKS KUSHMAN P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075
Phone: 248-358-4400
Fax: 248-358-3351

CERTIFICATE OF SERVICE

I certify that I served:

AMENDED NOTICE OF OPPOSITION

On August 18, 2023 by email to:

Baruch S. Gottesman
Law Office Of Baruch S. Gottesman
185-12 Union Turnpike
Fresh Meadows, NY 11366
bg@gottesmanlegal.com

Attorney for Applicant

By: /Rebecca J. Cantor/
Rebecca J. Cantor

EXHIBIT 1

Extract 1

Niccolò Mascaro: [00:13:40] - Exactly. I didn't spend it all because marketing, I mean strong marketing, still has to start. The development work has been done, and we reasoned that it would be better to finish the development first, so we could then concentrate on marketing... and so that's what would be missing... I'd like to support this project. I mean if we took the 100k and divided it by three, that would leave zero cash in hand, and so I couldn't make "Tellus" work, do you understand me?

Lorenzo Castagnone: Why zero? In your way, we'd have to give you 33k!

Niccolò Mascaro: Why would you have to give me 33k?

Lorenzo Castagnone: 100k divided by three...

Niccolò Mascaro: I don't understand that...

Lorenzo Castagnone: 100k divided by three equals 33k, minus the 10 we already gave you, that leaves 20...

Gheorghe Daniel Morosan: And you will be more motivated

Niccolò Mascaro: And how much would be left as cash in hand with "Treedefi"? With me personally, or with me as "Treedefi"?

Lorenzo Castagnone: [00:13:37] With you as "Treedefi"! By now you are "Treedefi", apart from...

Niccolò Mascaro: [00:14:48] Ok, so how much would "Treedefi" have as cash in hand?

Lorenzo Castagnone: [00:14:52] 33k minus 12k minus 10k. But, at that point, since that would be too small a sum, because it would be (only) 10, I would say we could take it on ourselves... (because) as you said, when someone exits, we not only have to calculate the cash in hand, but also the debts. At that point, I would also calculate "Ravi's" debt, so...

Niccolò Mascaro: [00:15:13] – Exactly.

Extract 2

Lorenzo Castagnone: [00:12:37] After paying all the expenses. So then, after paying all the expenses with "Treedefi's" current cash in hand, we can go ahead with the "exit", divide everything by three, and get rid of it!

If we want to do something to meet Nick halfway, in my opinion it would also be right to include the current debts as well, and not just the money... in order to do...

Extract 3

Niccolò Mascaro: [00:22:23] - And then there's "Ashvin" and the other guy...

Lorenzo Castagnone: [00:22:24] "Ashvin" is paid by the hour. "Ashvin" gives me a note of the hours worked. He says to me: "I worked 10 hours for "GambleFi" ", and I pay him 10 hours, and I think he does the same with "Treedefi". So the expenses have been divided. As for "Treedefi's" earnings - everything since January - Daniel and I have nothing to do with that. I see you put the...

Niccolò Mascaro: [00:22:35] ... the "trees"...yes...and the "mystery boxes".

The undersigned Federica GUERRA BONVIN, born on December 11, 1972, from Crans-Montana, in Lugano, a Swiss national, owner of TI Traduce, Piazza Dante Alighieri 8, CH 6900 Lugano, hereby certifies that the above translation into English (3 pages) conforms with the text in Italian.

Lugano, 20.12.2022

In witness whereof,

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