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Filing date: **04/13/2017**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Joseph Valenti		
Entity	Individual	Citizenship	UNITED STATES
Address	2763 NC Hwy 731 West Mount Gilead, NC 27306 UNITED STATES		

Attorney information	Phillip Thomas Horton 47 School Street Pembroke, MA 02359 UNITED STATES NEROLitigation@gmail.com Phone:617-721-6205		
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Registration Subject to Cancellation

Registration No	4657988	Registration date	12/16/2014
Registrant	NERO WORLD, LLC 21 BATTERY PARK AVE APT 302 ASHEVILLE, NC 28801 UNITED STATES		

Goods/Services Subject to Cancellation

Class 041. First Use: 2006/06/14 First Use In Commerce: 2006/06/14 All goods and services in the class are cancelled, namely: Entertainment, namely, production of live-action roleplaying games and interactive theatre productions

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
Registrant not rightful owner of mark for identified goods or services	Trademark Act Sections 14(1) and 1
Fraud on the USPTO	Trademark Act Section 14(3); In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)

Mark Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	2270409	Application Date	01/20/1998
Registration Date	08/17/1999	Foreign Priority Date	NONE
Word Mark	NERO		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 1989/03/00 First Use In Commerce: 1990/00/00 entertainment activities, namely, the conducting of role-playing events featuring costumes, lifestyles, customs and language from times past, other than the era of the Roman Empire

Attachments	NERO.pdf(656156 bytes)
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Signature	/Phillip Thomas Horton/
Name	Phillip Thomas Horton
Date	04/13/2017

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

In the matter of trademark Registration No. 4657988, Serial No. 86280398
For the mark NERO
Registered on December 16, 2014

Joseph Valenti,)	
)	
Petitioner,)	
)	Cancellation No. _____
v.)	
)	
Ford Ivey d/b/a/ NERO World, LLC,)	
)	
Assignee.)	
)	
)	

PETITION FOR CANCELLATION

Petitioner, Joseph Valenti, with a principal residence of 2763 NC Hwy 731 West, Mount Gilead, NC 27306, is the owner and operator of NERO Live Adventure Games, LLC, a Pennsylvania limited liability company, having an address at 4719 Hatfield Street – FRNT, Pittsburgh, PA 15201, believes that it is and will continue to be damaged by Registration No. 4657988, Serial No. 86280398, and hereby petitions to cancel said registration under the provisions of Section 14 of the Trademark Act of 1946, 15 U.S.C. § 1064 on the grounds that the registration was obtained through fraud on the United States Patent and Trademark Office, is likely to be confused with a mark previously used and not abandoned by Petitioner, and that the Assignee cannot lawfully use the mark.

To the best of Petitioner’s knowledge, the name and address of the current Assignee are as follows:

Ford Ivey d/b/a NERO World, LLC, 21 Battery Park Ave., Apt. 302, Ashville, NC 28801.

As grounds for cancellation, Petitioner alleges the following:

1. Petitioner has owned and operated a live action roleplaying gaming community known as

“NERO” for over 19 years.

2. Petitioner purchased the rights to the “NERO” gaming community and the “NERO” trademark (Registration No. 2270409)(the “Mark”) through a Bill of Sale, Transfer of Copyright, and Assignment of Trademark (“Assignment”) dated August 3, 1998 from Ford Ivey, President of NERO International, Inc. Said Assignment was recorded with the Trademark Office in Reel: 003066, Frame: 0927.

3. For over 19 years, Petitioner has actively maintained the “NERO” gaming community website located at NEROLARP.com as a promotional vehicle and as a means of keeping his community and fans updated about NERO news, upcoming NERO events, local and nationwide Chapter information, and a forum for members to talk and engage with one another.

4. Petitioner has performed, and continues to perform, under the Mark for over 19 years and during that time, Petitioner has developed a substantial client and fan base. As a result, the Mark has become well-known in the US and abroad, which includes over 5,000 members, 31 NERO Chapters in various US states, 2 NERO Chapters in Canada, and 1 NERO Chapter in South Africa.

5. Petitioner also operates and controls NERO LARP (Live Action Role Playing) on Facebook, which has been active since on or about January 1, 2008 and has on or about 1,964 active members.

6. Petitioner naively failed to renew the Mark and as such, the Mark was cancelled on or around March 20, 2010.

7. Although the Mark was not renewed, and in light of Petitioner’s continuous use in commerce of the Mark for over 19 years, and the fact that Petitioner is universally known by that name, Petitioner is the rightful owner of the Mark.

8. On or about April 3, 2006, William Joseph Bearden d/b/a NERO Central (“Registrant”) signed a “NERO License Offering and Agreement” (the “Agreement”) with Petitioner to become part of the NERO gaming community.

9. On Page 2 of the Agreement, Petitioner is listed as doing business as NERO, New

England Roleplaying Organization, and NERO Game Systems.

10. Petitioner has used, and continues to use, these business names for over 19 years and has the names listed in all of his Agreements.

11. Registrant paid royalties and fees to NERO under the Agreement to Petitioner until on or around September 1, 2009 before unilaterally cancelling his Agreement with Petitioner.

12. On or about May 13, 2014, Registrant, a previous Chapter Licensee of Petitioner's NERO gaming community, filed an application to register the Mark.

13. Registrant, without the knowledge or consent of Petitioner, filed an application for the registration of the Mark in connection with "(e)ntertainment, namely, production of live-action roleplaying games and interactive theatre productions."

14. On information and belief, Registrant is an individual with the mailing address of 505 E. Main Street, Adrian, MO 64720.

15. On or around September 14, 2015, Registrant assigned the Mark to Ford Ivey d/b/a NERO World, LLC ("Assignee") in a Trademark Assignment Agreement ("TAA"), which was recorded on Reel 005622, Frame 0904.

16. Ironically, Assignee is the same owner and operator of NERO International, Inc. that sold and assigned the rights of NERO in 1998.

Registrant's Fraudulent Procurement of the Mark

17. In his trademark application, Registrant declared, under penalty of perjury, that "no other person, firm corporation or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive."

18. Registrant knew the Mark was owned and continuously being used by the Petitioner when he sent out an email telling others he has been a NERO Chapter Owner since 2006 and he was still

in a valid contract with Petitioner when he fraudulently acquired the Mark.

19. In response to an Office Action dated October 10, 2014, Registrant was asked what “NERO” was an acronym for and in reply, Registrant responded by stating “New England Roleplaying Organization.”

20. Petitioner has continuously used and owned the Mark for over 19 years and distributes a *Nero Rule Book*, which is located on Petitioner’s website and distributed by Chapter Licensee’s, states that “NERO” stands for “New England Roleplaying Organization.”

21. Therefore, at the time of his filing, Registrant clearly knew that the Mark was in use and continuously being used by Petitioner.

22. Assignee knew the Mark was owned and continuously being used by Petitioner as he is the one who sold the rights to NERO and the Mark to Petitioner.

23. Assignee also knew Petitioner owned and continuously used the Mark as Assignee made multiple attempts to negotiate the buying back of NERO.

24. On information and belief, at the time of his filing of the trademark application, Registrant knew that members of the general public encountering the Mark in connection with “(e)ntertainment activities, namely the conducting of role-playing events featuring costumes, lifestyles, customs and languages, other than that of the Roman Empire” understood the Mark to identify the Petitioner.

25. On information and belief, at the time of his filing the TAA, Registrant and Assignee knew that members of the general public encountering the Mark in connection with “(e)ntertainment activities, namely the conducting of role-playing events featuring costumes, lifestyles, customs and languages, other than that of the Roman Empire” understood the Mark to identify the Petitioner.

26. On information and belief, at the time of his filing of the trademark application, Registrant knew, or had reason to know, that members of the general public would also encounter the Mark in connection with “(e)ntertainment, namely, production of the live-action roleplaying games and interactive theatre productions” and relate it to Petitioner.

27. On information and belief, at the time of the filing of the TAA, Registrant and Assignee knew, or had reason to know, that members of the general public would also encounter the Mark in connection with “(e)ntertainment, namely, production of the live-action roleplaying games and interactive theatre productions” and relate it to Petitioner.

28. While the goods and services description may differ slightly, both descriptions refer to the same Mark, for the same purpose, and both involve the same role-playing gaming community.

29. On information and belief, Registrant misrepresented the nature of his use in commerce of the Mark and misrepresented his rights to the Mark at the time he submitted his Application and continued to prosecute the trademark application leading to the registration that is the subject of this Petition.

30. On information and belief, the aforementioned false and/or fraudulent statements were made with the intent to induce authorized agents of the USPTO to grant said registration, and, reasonably relying on the truth of said false and/or fraudulent statements, the USPTO did, in fact, grant said registration of the Mark.

31. Petitioner believes that he has, is, and will continue to be damaged by Assignee’s registration of the Mark and the continued use of the Mark by the Assignee.

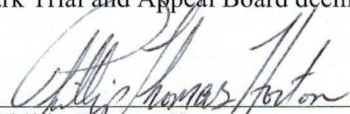
32. Petitioner has spent countless hours, money, and effort promoting the goods and/or services offered under the Mark.

33. Petitioner will be irreparably damaged by Assignee’s continued use of the Mark because the public will associate the Mark with the wrong owner.

34. In view of the above-listed statements, Assignee is not entitled to Registration No. 4657988, Serial No. 86280398 because Registrant, upon information and belief, committed fraud in the procurement of the subject registration, and because Petitioner has previously used and not abandoned the same mark.

WHEREFORE, Petitioner respectfully requests that Registration No. 4657988, Serial No. 86280398 be cancelled and any and all relief the Trademark Trial and Appeal Board deems fit.

Dated: 04/13/17

By: 
Phillip Thomas Horton
47 School Street
Pembroke, MA 02359
Telephone: (617) 721-6205
Email: NEROLitigation@gmail.com
Attorney for Petitioner


CERTIFICATE OF SERVICE

I, Phillip Thomas Horton, Esq., certify that on this 13 day of April, 2017, a true and correct copy of the foregoing document was filed with the Trademark Trial and Appeal Board via the Electronic System for Trademark Trials and Appeals and was sent by U.S. Mail to:

Ford Ivey
d/b/a NERO World
21 Battery Park Ave., Apt. 302
Asheville, NC 28801

Andrew Palmer
Andrew P. Palmer & Associates
200 Cordwainer Dr., Ste. 301
Norwell, MA 02061

Dated: 04/13/17

By: 
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Attorney for Petitioner