

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: March 21, 2018

Cancellation No. 92065883

Joseph Valenti

v.

William J. Bearden dba NERO Central

Cancellation No. 92065911

Joseph Valenti

v.

NERO World, LLC

By the Trademark Trial and Appeal Board:

This case comes before the Board on:

1. Petitioner's motions to amend its name, Cancellation No. 92065883, 16 TTABVUE; Cancellation No. 92065911, 16 TTABVUE;
2. Respondent's motions to dismiss Petitioner's first amended petitions to cancel, Cancellation No. 92065883, 15 TTABVUE, 19 TTABVUE; Cancellation No. 92065911, 15 TTABVUE, 18 TTABVUE; and
3. Respondent's motions to strike Petitioner's second amended petitions to cancel filed in response to Respondent's motions to dismiss, Cancellation No. 92065883, 23 TTABVUE; Cancellation No. 92065911, 21 TTABVUE.

In both cancellation proceedings, Petitioner's motions to amend its name and Respondent's motions to strike are fully briefed.¹

Although these proceedings are not consolidated, inasmuch as the motions and arguments therein are similar and nearly identical, for convenience, the Board issues a single order with a copy in both proceedings. Because answers have not yet been filed in either cancellation proceeding, whether proceedings will be consolidated may be determined by the Board after joinder of issue. *See* TBMP § 511 (June 2017) ("Generally, the Board will not consider a motion to consolidate until an answer has been filed.").

Petitioner's Second Amended Pleading and Respondent's Motions to Strike

Pursuant to Fed. R. Civ. P. 15(a)(1)(B), a party may amend its pleading once as a matter of course within twenty-one days after service of a responsive pleading or twenty-one days after service of a motion under Rule 12(b), (e) or (f). The rule "force[s] the pleader to consider carefully and promptly the wisdom of amending to meet the arguments in the motion." Fed. R. Civ. P. 15, Advisory Committee's Note (2009 Amendments). By specifying the timeframe in which an amended complaint may be filed, Rule 15(a) provides courts and litigants with a degree of notice of whether a pleader intends to respond to a motion to dismiss via an amended complaint. *See Hayes v. District of Columbia*, 275

¹ The Board has considered the parties' submissions and presumes the parties' familiarity with the arguments made therein. The parties' arguments will not be summarized herein except as necessary to explain the Board's decision.

Petitioner's change of correspondence filed in both proceedings is noted and made of record. *See* Cancellation No. 92065883, 25 TTABVUE; Cancellation No. 92065911, 23 TTABVUE.

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F.R.D. 343, 345-46 (D.D.C. 2011); Wright, Miller, Kane, and Spencer, 6 *Fed. Prac. & Proc. Civ.* § 1480 3d ed. (April 2017 Update). An amendment filed as a matter of course need not be accompanied by a motion for leave to amend. *See* Fed. R. Civ. P. 15(a). Thereafter, a party may amend its pleading only by written consent of every adverse party or by leave of the Board. *See id.*

In this case, Petitioner’s ability to amend its pleadings “once as a matter of course” expired twenty-one days after the motions to dismiss were filed in response to its *initial* petitions to cancel. *See* Fed. R. Civ. P. 15, Advisory Committee Notes (2009 Amendments) (“The 21-day periods to amend once as a matter of course after service of a responsive pleading or after service of a designated motion are not cumulative. If a responsive pleading is served after one of the designated motions is served, for example, there is no new 21-day period.”); *see also, e.g., Montz v. Pilgrim Films & Television, Inc.*, 606 F.3d 1153, 1159 n. 1 (9th Cir. 2010) *vacated on other grounds by* 649 F.3d 975 (9th Cir. 2011) (en banc); *Rodgers v. Lincoln Towing Serv., Inc.*, 771 F.2d 194, 203-04 (7th Cir. 1985); *Glaros v. Perse*, 628 F.2d 679, 686 (1st Cir. 1980); *Yagman v. Galipo*, 2013 WL 1287409, 2 n. 3 (C.D. Calif. 2013). The time for Petitioner to amend its pleadings as a matter of course was within twenty-one days of Respondent’s first motions to dismiss. *See* Cancellation No. 92065883, 5 TTABVUE; Cancellation No. 92065911, 5 TTABVUE. Petitioner did not file amended pleadings in response thereto electing instead to respond to the merits of the motions to dismiss. *See* Cancellation No. 92065883, 9 TTABVUE;

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Cancellation No. 92065911, 6 TTABVUE. More than twenty-one days have passed since Respondent's first motions to dismiss and thus, Petitioner's time to file amended pleadings as a matter of course has expired. *See Fed.R.Civ.P.* 15(a).

Insofar as Petitioner's time to file amended pleadings as a matter of course has expired, Petitioner's second amended pleadings must be accompanied by a motion. *See Trademark Rule 2.127(a); S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1297 (TTAB 1997). As noted, Petitioner failed to file proper motions to amend with its second amended pleadings.

In view thereof, Respondent's motions to strike are **granted**. Petitioner's second amended petitions to cancel are not properly before the Board and are therefore, stricken from the record.² *See Cancellation No. 92065883*, 21 TTABVUE; *Cancellation No. 92065911*, 19 TTABVUE.

Petitioner's First Amended Pleadings/Petitioner's Motions to Amend its Name

In its September 14, 2017 order, the Board noted that Petitioner's identity was not clearly alleged and therefore, standing was not properly pleaded. *See Cancellation No. 92065883*, 13 TTABVUE 9; *Cancellation No. 92065911*, 13 TTABVUE 9. Petitioner was given thirty days to file amended petitions to cancel to address the issue of standing, amongst other matters. Cancellation

² The parties are reminded that 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. Should either party seek to amend its pleading at a later stage in this proceeding, they must do so pursuant to the rules. *See Fed. R. Civ. P. 15(a); TBMP § 527 et seq.*

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No. 92065883, 13 TTABVUE 15; Cancellation No. 92065911, 13 TTABVUE 15.

In its first amended pleadings, Petitioner alleges:

II. Standing.

3. Registrant is listed in the United States Patent and Trademark Office (“USPTO”) records as the owner of record of Registration No. 4697406 (the “Registrant’s Registration”) for use of the mark NERO New England Roleplaying Organization (“NERO NERO”) with “Entertainment, namely, production of liveaction roleplaying games and interactive theatre productions” in International Class 041 (“Registrant’s Services”).

4. Petitioner is:

a) The owner and operator of the website www.NEROLARP.com (“Petitioner’s Website”) (Exhibit A), which is offers entertainment activities and venues for conducting roleplaying events featuring costumes, lifestyles, customs and languages from times past, other than the era of the Roman Empire, as well as digital and printed material relating to the rules and regulations for NERO (“Petitioner’s Services”); and

b) The owner of all copyrights for works created and distributed from 1998 that relate and involve NERO (“Petitioner’s Copyrights”) (Exhibit B), which allows Petitioner to offer Petitioner’s Services; and

c) The sole owner and sole proprietor of various business ventures, such as Nero Live Adventure Games, NERO, New England Roleplaying Organization, and NERO Game Systems, as well as being the sole President and Owner of NERO International Holding Co. Inc. (“Petitioner’s Companies”).

5. On information and belief, any application by Petitioner to register the names related to Petitioner’s Website, Petitioner’s Copyrights, and/or Petitioner’s Companies will be rejected based on Registrant’s Registration.

6. Petitioner believes he has and will continue to be damaged by the Registrant’s Registration, and hereby petitions for cancellation of the same pursuant to 15 U.S.C. §1064.

Cancellation No. 92065883, 15 TTABVUE 3-4; and

II. Standing.

3. Assignee is listed in the United States Patent and Trademark Office (“USPTO”) records as the owner of record of Registration No. 4657988 (the “Assignee’s Registration”) for use of the mark NERO (“NERO”) with “Entertainment, namely, production of

live-action roleplaying games and interactive theatre productions” in International Class 041 (“Assignee’s Services”).

4. Petitioner is:

a) The owner and operator of the website www.NEROLARP.com (“Petitioner’s Website”) (Exhibit A), which is offers entertainment activities and venues for conducting roleplaying events featuring costumes, lifestyles, customs and languages from times past, other than the era of the Roman Empire, as well as digital and printed material relating to the rules and regulations for NERO (“Petitioner’s Services”); and

b) The owner of all copyrights for works created and distributed from 1998 that relate and involve NERO (“Petitioner’s Copyrights”) (Exhibit B), which allows Petitioner to offer Petitioner’s Services; and

c) The sole owner and sole proprietor of various business ventures, such as Nero Live Adventure Games, NERO, New England Roleplaying Organization, and NERO Game Systems, as well as being the sole President and Owner of NERO International Holding Co. Inc. (“Petitioner’s Companies”).

5. On information and belief, any application by Petitioner to register the names related to Petitioner’s Website, Petitioner’s Copyrights, and/or Petitioner’s Companies will be rejected based on Assignee’s Registration.

6. Petitioner believes he has and will continue to be damaged by the Assignee’s Registration, and hereby petitions for cancellation of the same pursuant to 15 U.S.C. §1064.

Cancellation No. 92065911, 15 TTABVUE 3.

Thereafter, Petitioner filed motions to amend its name to “Joseph Valenti d/b/a NERO Live Game Systems and Joseph Valenti d/b/a NERO International Holding Co., Inc.” or alternatively to add “NERO Live Game Systems, LLC and NERO International Holding Co., Inc.” as party plaintiff. Cancellation No. 92065883, 16 TTABVUE 3; Cancellation No. 92065911, 16 TTABVUE 3. In support of its motions, Petitioner includes a copy of a copyright assignment and a New York State corporate registration of NERO International Holding

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Co., Inc. Cancellation No. 92065883, 16 TTABVUE 6-7, 13-14; Cancellation No. 92065911, 16 TTABVUE 6-7, 13-14.

Petitioner's motions assert that Petitioner is doing business as NERO Live Game Systems and NERO International Holding Co., Inc. Cancellation No. 92065883, 16 TTABVUE 3; Cancellation No. 92065911, 16 TTABVUE 3. However, the evidence submitted by Petitioner does not support this assertion.

Petitioner has submitted a corporate registration from the State of New York, noting that NERO International Holding Co., Inc. is a "domestic business corporation." Cancellation No. 92065883, 16 TTABVUE 13; Cancellation No. 92065911, 16 TTABVUE 13. Although the certificate includes language that "[a] **Fictitious** name must be used when the **Actual** name of a foreign entity is unavailable for use in New York State," (emphasis in original) NERO International Holding Co., Inc, is designated as a "corporation" not as a fictitious name registration. Moreover, assuming arguendo the certificate submitted is a fictitious name registration, it does not indicate with what entity/person the fictitious name registration is associated. In short, there is no indication that Petitioner, Joseph Valenti, owns the purported fictitious name registration. In view thereof, it is unclear if NERO International Holding Co., Inc., is the fictitious name registration of Petitioner.

Further, the assignment submitted is for "original works of authorship" what are purportedly subject to copyright protection. Cancellation No. 92065883, 16 TTABVUE 6-7; Cancellation No. 92065911, 16 TTABVUE 6-7.

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The assignment reads that “Joseph Alan Valenti ... doing business as NERO International, Inc., NERO International Holding Co., Inc., and NERO Live Adventure Games, LLC is desirous of acquiring the entire right, title and interest in and to said WORKS and in and to any copyrights thereon.” Cancellation No. 92065883, 16 TTABVUE 7; Cancellation No. 92065911, 16 TTABVUE 7. Although the assignment recites that Petitioner is doing business under other names, the assignment does not contain any supporting documents (e.g., a registration with the pertinent Secretary of State) which establish that Petitioner is doing business as NERO International Co., Inc. or NERO Adventure Games, LLC. Indeed, the assignment does not mention NERO Adventure Games, LLC at all – rather, it mentions NERO Live Adventure Games, LLC.

In short, Petitioner’s motions to amend its name raises questions about the identity of Petitioner. Therefore, whether Petitioner’s standing in its first amended petitions to cancel is properly pleaded is unclear.

In view thereof, Petitioner has **twenty days** from the date of this order 1) to supplement its motions to amend its name to clarify its identity and 2) to clarify its pleadings of standing in its first amended petitions to cancel. As appropriate and pursuant to Board rules, Petitioner may alternately file new motions to amend its pleadings to further clarify its purported standing to bring these proceedings. Petitioner should include evidence and documents to support its allegations of standing and its identity, as appropriate. If Petitioner

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supplements its motions, clarifies its standing in the first amended petitions to cancel or files new motions to amend its pleadings, Respondent shall have **thirty days**, after service of the supplemented motions, clarifications of standing or new motions to amend, to supplement its motions to dismiss, file new motions to dismiss or otherwise respond thereto, as appropriate. If Petitioner fails to supplement and clarify its motions to amend its name, its allegations of standing in its first amended petitions to cancel or file new motions to amend its pleadings, this proceeding may be dismissed.

For the reasons explained herein, Respondent's motions to dismiss for failure to plead standing are hereby **deferred**. Petitioner's motions to amend its name are also **deferred**.

Proceedings otherwise remain suspended.