

ESTTA Tracking number: **ESTTA929847**

Filing date: **10/21/2018**

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

Proceeding	92065911
Party	Plaintiff Joseph Valenti, NERO International Holding Co., Inc., and NERO Live Adventure Games, LLC
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Date	10/21/2018
Attachments	Response NERO.pdf(84215 bytes)

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

3 In the matter of trademark Registration No. 46280398

4 For the mark NERO

5 Registered on December 16, 2014

6
7 Joseph Valenti, NERO International

8 Holding Co., Inc., and NERO Live

9 Adventure Games, LLC,

10 Petitioner's,

11 v.

12 NERO World, LLC,

13 Defendant.

Cancellation No. 92065911

14
15 **PLAINTIFF'S RESPONSE TO DEFENDANT'S RESPONSE TO**
16 **PLAINTIFF'S MOTION TO STRIKE AFFIRMATIVE DEFENSES**

17 COMES NOW, Joseph Valenti, NERO International Holding Co., Inc., and NERO Live
18 Adventure Games, LLC ("Valenti," "NIHC," and "NLAG," respectively and individually, collectively
19 "Petitioner's") and hereby submits its reply in further support of its Motion to Strike Affirmative
20 Defenses ("Motion") filed on September 24, 2018, and in response to NERO World LLC's ("Defendant")
21 opposition to the Motion, filed on October 10, 2018.

22 **I. Standing**

23 Petitioner's still rely on the Boards ruling that has concluded that "[u]pn review of the Petitioner's
24 amended petitions to cancel included with its motion to amend, standing is adequately pleaded." 32
25 TTABVUE 6. Petitioner's have shown that they have a "real interest," i.e., a "personal stake" in this
26 proceeding, beyond that of a mere intermeddler. Ritchie v. Simpson, 170 F.3d 1092, 50 USPQ2d 1023,
27 1025-26 (Fed. Cir. 1999).

1 Defendant's first, second, and third affirmative defense all allege lack of standing. Specifically,
2 Defendant's third defense claims lack of standing due to lack of privity between NIHC and NLAG. 33
3 TTABVUE 7. Again, the Board has found that "[a]fter careful review of the [Petitioner's] submissions
4 and upon the record before the Board, Petitioner [Valenti] has adequately alleged that Mr. Valenti, and
5 NERO International Holding Co., Inc. and NERO Live Adventure Games LLC are in privity." 32
6 TTABVUE 7.

7 **II. Bad Faith and Unclean Hands**

8 Petitioner's do no dispute that the affirmative defense of unclean hands is available to
9 Defendant's, however, Petitioner's do dispute the pleading of the affirmative defense. Particularly,
10 whether bad faith and unclean hands are the same defense, or if they are two different defenses in one
11 paragraph. Additionally, Defendant fails to put Petitioner's on notice of what is meant by "other acts."
12 33 TTABVUE 12.

13 **III. Defendant's Amplified Denials**

14 Defendant claims the fifth, sixth, and seventh affirmative defenses are amplified denials. First,
15 Petitioner's would assert these are not amplified denials but instead, blanket assertions. Secondly,
16 Petitioner's would assert that these denials are more akin to counterclaims to cancel registrations and
17 therefore, are improper. *See* Trademark Rule 2.106(b)(3); *see also Continental Gummi-Werke AG v.*
18 *Continental Seal Corp.*, 222 USPQ 822, 825 (TTAB 1984).

19 Additionally, Petitioner's argue that these types of improper attacks should be given no weight
20 since these counterclaims are for oppositions. Since this is a cancellation proceeding and since
21 Petitioner's do not have an application that is in the opposition phase, these defenses are improper and
22 should be stricken.

23 **IV. Defendant's Reservations**

24 Petitioner's again assert that a reservation to put forth additional defenses is improper under the
25 Federal Rules of Civil Procedure. *See FDIC v. Mahajan*, 923 F. Supp. 2d 1133, 1141 (N.D. Ill. 2013)
26 (reservation of right to add affirmative defenses at a later date is improper under the Federal Rules).
27 Petitioner's argue it is unfair and impertinent to reserve unidentified defenses or counterclaims since it

1 fails to put Petitioner’s on notice about what the defenses or counterclaims are or could be. This is not to
2 say Defendant cannot file a motion for leave to amend under Fed. R. Civ. P. 15(a), however, this type of
3 blanket reservation should not be allowed and stricken.

4 **V. Conclusion**

5 Based on Petitioner’s Motion and the arguments contained herein, Petitioner’s respectfully
6 requests that Petitioner’s Motion be granted, and that Defendant’s affirmative defenses be stricken and
7 given no further consideration.

8

9 Date: October 21, 2018

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Attorney for Petitioners

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CERTIFICATE OF SERVICE

I, Phillip Thomas Horton, Esq., certify that 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 via email to Jovanna Bearden at the following email address:

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Dated: October 21, 2018

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