

ESTTA Tracking number: **ESTTA829475**

Filing date: **06/27/2017**

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

Proceeding	92065911
Party	Defendant NERO World, LLC
Correspondence Address	JOVANNA R BEARDEN BEARDEN LAW 104 S MAIN STREET BUTLER, MO 64730 UNITED STATES Email: jovannabearden@gmail.com
Submission	Opposition/Response to Motion
Filer's Name	Jovanna R. Bearden
Filer's email	email@bearden.law
Signature	/Jovanna R. Bearden/
Date	06/27/2017
Attachments	Response to Petitioner MTD for Insufficient Service.pdf(119912 bytes ) NERO.pdf(665033 bytes )

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, )  
 )  
Plaintiff, )  
 ) Cancellation No. 92065911  
v. )  
 )  
NERO World, LLC, )  
 )  
Defendant, )  
 )

**DEFENDANT’S OPPOSITION TO PETITIONER’S MOTION TO DISMISS FOR  
INSUFFICIENT SERVICE**

COMES NOW Defendant, by and through Counsel, and opposes Petitioner’s Motion to  
Dismiss for Insufficient Service as follows:

STATEMENT OF FACTS

Defendant does not contest any of the facts as stated by Plaintiff, except for Plaintiff’s  
statement “Plaintiff’s counsel never received a service copy of the Motion at the indicated email  
address.” Defendant’s counsel received a confirmation of the sending of this email to Plaintiff’s  
counsel, which is attached hereto as Exhibit “A.” Defendant’s counsel was in the process of  
sending an email to Plaintiff with a copy of the Motion to Dismiss when she received the receipt  
of filing from the ESTTA and was under the impression that a copy of the Motion was served on  
Plaintiff by the ESTTA system. As a result, Defendant’s counsel did not finish sending the email

to Plaintiff, in an attempt to avoid redundancies. This was an error of excusable neglect, and was not done to prejudice the Plaintiff, or to obstruct the progression of this case. The Affidavit of Defendant's Counsel is attached hereto as Exhibit A and attests to the facts as set forth in this motion.

#### ARGUMENT

Plaintiff's first argument is that Defendant's service of its Motion to Dismiss did not comply with the Trademark Trial and Appeal Board Rule of Practice sec. 113.04. When Counsel filed the Entry of Appearance and Motion to Dismiss with the ESTTA, she believed she had effectuated service via email on Plaintiff's email address for service, Nerolitigation@gmail.com. Defendant did not intentionally neglect to send Plaintiff a service copy, but made a good faith error which at the most amounted to excusable neglect. Further, Plaintiff has not been prejudiced by Defendant's actions, evidenced by the Plaintiff's instant motion and a response to the Motion to dismiss.

Plaintiff's second argument is that Defendant failed to comply with Trademark Trial and Appeal Board Rule of Practice sec. 2.111(b). First, this section pertains to the Filing of a Petition for Cancellation, and does not speak to the service requirements of Motions. Second, the language which Plaintiff has quoted from this section is not actually there or anywhere in the Trademark Rules of Practice. Therefore, because this section is not applicable to service of Defendant's motion, and because the language relied on by the Plaintiff is not part of this section, this argument is without merit.

Finally, the various authorities relied on by Plaintiff do not support his position in this case. Defendant will address each in turn. Plaintiff sites *Springfield Inc. v. XD*, 86 USPQ2d 1063

(Trademark Tr. & App. Bd. 2008), for the proposition that putting a certificate of service on a document is ineffective if service does not occur. First, there is a major distinction between the facts in *Springfield* and this case. *Springfield* dealt with the service of process requirements when instituting an opposition to a mark. In *Springfield*, the opposer informed the Trademark Trial and Appeal Board that a copy of its opposition was served on the applicant when it had not been. Because the opposer failed to comply with the requirements to institute an opposition, the opposition was dismissed as it was never effectively started. As discussed above, the service requirements to institute an opposition are separate and different from the service requirements for a motion. Therefore, the *Springfield* case is not binding or informative in this case.

The next authority cited by Plaintiff is Trademark Rule of Practice 2.126, “Form of submissions to the Trademark Trial and Appeal Board.” Again, this section does not apply to service requirements of a motion. However, to the extent it is instructive in this matter, Defendant followed the requirements for submission of its documents to the TTAB.

The next authority cited by Plaintiff is Trademark Rule of Practice 2.127, “motions”. Plaintiff does not state what part of this section it relies on as authority. However, it appears that Defendant did comply with all of the requirements for a motion filed with the TTAB as set forth in this section.

Finally, Plaintiff relies on F.R.C.P. (b)(5) to support its Motion “insufficient service of process.” Again, as explained above, because Defendant has filed a Motion, and not instituted an action, any requirements or defenses related to the service of documentations at the onset of litigation are inapplicable here. Therefore, this rule has no weight in this matter.

## CONCLUSION

Through ignorance, Defendant's counsel failed to send Plaintiff a separate email with a copy of Defendant's Motion to Dismiss. However, Plaintiff has not been prejudiced by this action. Therefore, Defendant prays for an Order Denying Plaintiff's Motion and allowing its Answer to be allowed out of time.

Dated: June 27, 2017

By: / Jovanna R. Bearden /  
Jovanna R. Bearden MO#60294  
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Attorney for Defendant

## CERTIFICATE OF SERVICE

I, Jovanna R. Bearden, certify that on this 27th day of June, 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 sent by email to Counsel for Plaintiff, Phillip Thomas Horton at NEROLitigation@gmail.com.

Dated: June 27, 2017

By: / Jovanna R. Bearden /  
Jovanna R. Bearden

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,	)	
	)	
Plaintiff,	)	
	)	Cancellation No. 92065911
v.	)	
	)	
NERO World, LLC,	)	
	)	
Defendant,	)	
	)	

**Affidavit of Jovanna R. Bearden**

I, Jovanna R. Bearden, being duly sworn, do state that the following statements are true and correct:

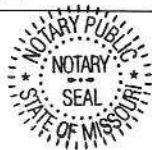
1. My name is Jovanna R. Bearden. I am the attorney for Defendant, NERO World, LLC in the above captioned case.
2. This is the first case that I have handled before the TTAB. Prior to filing any documents I did read the Procedure Manual and spent many hours trying to familiarize myself with the procedure for cases in this forum.
3. I conduct most of my legal work in Missouri State Court. Missouri's eFiling system attaches service copies of documents to email receipts and sends the same to all parties on the case by email.
4. On May 29, 2017, I filed with the ESTTA an Entry of Appearance and Motion to Dismiss in this case.

5. When I filed the documents, I began drafting an email with a service copy of the documents to Nerolitigation@gmail.com. However, in the process of drafting this email I received a receipt of filing from the ESTTA system. A true and accurate copy of this email is attached hereto.
6. The Receipt of filing indicated that the documents I had filed were "Attached". The Receipt also indicated that NeroLitigation@gmail.com also received a receipt. Based on this, and my experiences with Missouri's eFiling system, I was under the belief that there was a copy of the documents I had filed were attached and mailed to NeroLitigation@gmail.com.
7. Had I known that a service copy of these documents was not sent through the ESTTA email I would have sent over service copies immediately. However, I was not made aware of this, and I received no correspondence regarding the matter from Plaintiff's Counsel.
8. I did not act in a malicious or obstructive manner. I was simply attempting to avoid duplication of effort, numerous emails to Plaintiff's Counsel, and attempting to follow procedure with my first filings with the ESTTA to the best of my ability.
9. I was not attempting to obstruct litigation in this matter, or prejudice the Plaintiff in any way.

Date: 6/26/17  
Signed: Joanna R Bearden  
Print: Joanna R Bearden

Subscribed and sworn to before me, this 26<sup>th</sup> day of June, 2017.

Stacey Fox



STACEY FOX  
My Commission Expires  
June 4, 2018  
Bates County  
Commission #14396066

NOTARY PUBLIC

My commission expires: 6-4-18

June 26<sup>th</sup>, 2017.



Jovanna Bearden &lt;jovannabearden@gmail.com&gt;

**ESTTA. Motion to Dismiss - Rule 12(b) confirmation receipt ID: ESTTA823563**

1 message

estta-server@uspto.gov <estta-server@uspto.gov>  
To: NEROLitigation@gmail.com, jovannabearden@gmail.com

Mon, May 29, 2017 at 2:17 PM

Cancellation No.: 92065911

Tracking No: ESTTA823563

**ELECTRONIC SYSTEM FOR TRADEMARK TRIALS AND APPEALS Filing Receipt**

The Trademark Trial and Appeal Board (Board) has received a filing titled ELECTRONIC SYSTEM FOR TRADEMARK TRIALS AND APPEALS submitted through the Electronic System for Trademark Trials and Appeals (ESTTA). This Notice verifies receipt of the filing and includes an ESTTA Tracking Number.

Unless the filing fails to meet all applicable minimum legal requirements for filing, the Board will not retract the filing or refund any fees paid.

The filing, and any Board proceeding, may be viewed on TTABVUE at <http://ttabvue.uspto.gov>. Please allow up to two hours for the system to process this filing.

If the filer has a question, or if the filing is not viewable in TTABVUE, the TTAB Assistance Center is available at 571-272-8500, Monday to Friday from 8:30 a.m. to 5:00 p.m. Eastern Time (ET), or email at [estta@uspto.gov](mailto:estta@uspto.gov). Please provide your ESTTA Tracking No.

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ESTTA server at <http://estta.uspto.gov>

ESTTA Tracking number: ESTTA823563  
Filing date: 05/29/2017

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

Proceeding: 92065911  
Party: Defendant  
NERO World, LLC

Correspondence Address:  
NERO WORLD LLC  
21 BATTERY PARK AVENUE APT 302  
ASHEVILLE, NC 28801  
UNITED STATES

Submission: Motion to Dismiss - Rule 12(b)

Filer's Name: Jovanna R. Bearden  
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Signature: /Jovanna R. Bearden/



6/20/2017

Gmail - ESTTA. Motion to Dismiss - Rule 12(b) confirmation receipt ID: ESTTA823563

Date: 05/29/2017

Attachments: Ford - MTD.pdf