

ESTTA Tracking number: **ESTTA1166707**

Filing date: **10/18/2021**

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

Proceeding	92075281
Party	Plaintiff Nerdio, Inc.
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Date	10/18/2021
Attachments	2021.10.18 Petitioner Reply ISO MSJ (Redacted).pdf(191673 bytes ) Ex. VV - 2021.01.15 - Initial Disclosures - NERDIO - 92075281.pdf(46775 bytes ) Ex. WW (Redacted in Entirety).pdf(27397 bytes ) Ex. XX (Redacted in Entirety).pdf(27430 bytes )

**PUBLIC/REDACTED VERSION**

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

In the Matter of Trademark Registration No. 6153453  
For the Mark: NERDIO  
Date Registered: September 15, 2020

Nerdio, Inc.,	)	
a Delaware corporation,	)	
Petitioner,	)	Cancellation No. 92075281
	)	
v.	)	
	)	
NerdIO Limited	)	
a Hong Kong corporation,	)	
Respondent.	)	
	)	

**PETITIONER’S REPLY IN SUPPORT OF ITS  
MOTION FOR SUMMARY JUDGMENT**

Petitioner Nerdio, Inc. (“Petitioner”), by and through its undersigned counsel and pursuant to Section 502 of the Trademark Trial and Appeal Board Manual of Procedure, respectfully submits this reply (“Petitioner’s Reply”) in support of its Motion for Summary Judgment. *See* 13 TTABVUE.

Petitioner acknowledges that the Board generally disfavors reply briefs and strives not to merely restate arguments that the Parties have already pled. *See* T.B.M.P. § 502.02(b). Accordingly, Petitioner uses this reply to:

1. Address the only four undisputed facts from Petitioner’s motion for summary judgment that Respondent NerdIO Limited (“Respondent”) appears to dispute but that are not actually in dispute; and
2. Address new arguments and evidence that Respondent has inappropriately introduced at this stage of the proceeding.

There is no genuine dispute as to the facts in the record, just the outcome of this case. Respondent’s constructive use does not trump Petitioner’s actual use prior to Respondent’s ITU Application filing date. Accordingly, Petitioner respectfully requests that the Board grant Petitioner’s summary

judgment motion and cancel Registration No. 6,153,453 (“the ’453 Registration”). In addition, Petitioner respectfully requests that the Board deny Respondent’s summary judgment motion.

**I. RESOLUTION OF THE ALLEGEDLY DISPUTED FACTS**

The standard for summary judgment is clear: if a movant meets its burden in showing that there are no genuine issues as to material facts and no reasonable factfinder could find otherwise, the movant is entitled to judgment as a matter of law. FED. R. CIV. P. 56; T.B.M.P. § 528.01; *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). The non-movant must provide counter-evidence showing the existence of a genuine dispute for trial. *Octocom Sys. Inc. v. Houston Comput. Servs. Inc.*, 918 F.2d 937, 16 U.S.P.Q.2d 1783, 1786 (Fed. Cir. 1990). Diverging opinions on legal conclusions to be drawn from facts are questions of law, not issues of material fact. *Fouad Kallamni v. Asad A. Khan*, 101 U.S.P.Q.2d 1864, 1865 (T.T.A.B. 2012). Petitioner has provided ample evidence to support its assertion that there is no genuine issue as to Petitioner’s priority—Petitioner’s predecessor-in-interest, Adar, Inc. (“Adar”), used the NERDIO mark in U.S. commerce prior to Respondent’s ITU Application filing date. Respondent has raised questions of law, not issues of material fact, in response to Petitioner’s established material facts.

Out of all the material facts that Petitioner has included in its motion for summary judgment, Respondent disputes only four while twenty-nine remain undisputed. *Compare* 17 TTABVUE 4–5 *with* 13 TTABVUE 7–15. It is also undisputed that Vadim Vladimirskiy’s Declaration provides a definitive meaning of Petitioner’s business records, operations, and correspondence. *See* Vladimirskiy Declaration (Ex. A to 13 TTABVUE) and Exs. 1–5 thereto. Respondent failed to take any depositions during discovery, and now still fails to address the actual context and content of the evidence. To clarify, Petitioner has responded to the allegedly disputed facts in the table below, indicating where the dispute is resolved in the record or briefings.

<b>ALLEGEDLY DISPUTED FACT</b>	<b>PETITIONER’S RESPONSE</b>	<b>CONCLUSION</b>
<p>“On June 2, 2016, Adar was setting up free trials with potential new clients using the NERDIO mark.” <i>See</i> Respondent’s Response at 17 TTABVUE 3–4.</p>	<p>This fact is not in dispute. Respondent’s only argument is that the evidence provided is not related to “new clients.” Respondent has not disputed that Petitioner received trial requests from its <a href="http://www.getnerdio.com">www.getnerdio.com</a> website on June 2 and 6, 2016. <i>See</i> 17 TTABVUE 16; 13 TTABVUE, Ex. B at TTAB_NERDIOINC_0002427–28; 14 TTABVUE, Ex. UU at TTAB_NERDIOINC_0000072.</p> <p>Additionally, Respondent ignores that Adar offered and rendered its services under the NERDIO mark starting on June 1, 2016. Petitioner has provided a fulsome response to Respondent’s allegations on this alleged dispute in its Response to Respondent’s Motion for Summary Judgment. <i>See</i> 19 TTABVUE 4–10.</p>	<p>Adar offered and rendered its services to customers in the U.S. prior to Respondent’s ITU Application filing date of June 9, 2016.</p>
<p>“On June 7, 2016, Adar sent an email to existing clients announcing its launch of its NERDIO brand.” <i>See</i> Respondent’s Response at 17 TTABVUE 4.</p>	<p>This fact is not in dispute. The subject line of the email in question resolves any alleged dispute: “Subject: Adar Introduced Nerdio Platform.” 13 TTABVUE, Ex. 3 to Vladimirskiy Declaration at TTAB_NERDIOINC_0000167–68; 13 TTABVUE, Ex. C at TTAB_NERDIOINC_0000189–90; 13 TTABVUE, Ex. D at TTAB_NERDIOINC_0000916.</p>	<p>On June 7, 2016, Adar sent an email to existing clients announcing its launch of its NERDIO brand.</p>
<p>“Petitioner’s clients continued to pay for the NERDIO-branded services following the June 7, 2016</p>	<p>This fact is not in dispute. Dated June 6, 2016, the email string cited by Respondent relates to a customer’s confusion as where</p>	<p>Adar provided customers the services at issue that Adar then branded as NERDIO services upon the June 7,</p>

ALLEGEDLY DISPUTED FACT	PETITIONER'S RESPONSE	CONCLUSION
<p>email.” See Respondent’s Response at 17 TTABVUE 4.</p>	<p>to go to access the services it was already subscribed to. See e.g., 17 TTABVUE at Ex. D to Lesser Decl. at TTAB_NERDIOINC_0000227–228. This email string relates to the launch of Petitioner’s services under the NERDIO mark and does not relate to how Adar would describe the services in future billing. See 17 TTABVUE 6; 20 TTABVUE 6.</p> <p>Additionally, Petitioner has provided a fulsome response to Respondent’s allegations on this alleged dispute in its Response to Respondent’s Motion for Summary Judgment. See 19 TTABVUE 4–10; see also 13 TTABVUE, Ex. 4 to Vladimirskiy Declaration (file history for Trademark Application Serial No. 87078739) at 28; 13 TTABVUE, Ex. E at TTAB_NERDIOINC_0000177 (dated June 7, 2016); 13 TTABVUE, Ex. F at TTAB_NERDIOINC_0000178 (dated June 6, 2016); 12 TTABVUE, Ex. T at TTAB_NERDIOINC_0000239 (dated June 2, 2016); 13 TTABVUE, Ex. B at TTAB_NERDIOINC_0002427–28 (dated June 2, 2016); 14 TTABVUE, Ex. UU at TTAB_NERDIOINC_0000072 (dated June 6, 2016); 13 TTABVUE, Ex. 3 to Vladimirskiy Declaration at TTAB_NERDIOINC_0000167–</p>	<p>2016 brand launch. Adar continued to provide those services to Adar customers following the launch of the NERDIO brand.</p>

ALLEGEDLY DISPUTED FACT	PETITIONER'S RESPONSE	CONCLUSION
	68; 13 TTABVUE, Ex. C at TTAB_NERDIOINC_0000189–90.	
“Respondent’s business is based in Hong Kong.” <i>See</i> Respondent’s Response at 17 TTABVUE 4.	This fact is not in dispute. The ITU Application Respondent filed with the USPTO states that its address is in Hong Kong. <i>See, e.g.,</i> United States Trademark Registration No. 6,153,453 (“NerdIO Limited (HONG KONG CORPORATION”). Respondent does not dispute this.	Respondent’s business is based in Hong Kong.

There are no genuinely disputed facts in the record, just a disagreement over the outcome. Adar has prior rights to the NERDIO mark because it offered and rendered NERDIO services under the NERDIO mark to consumers in U.S. commerce prior to Respondent’s ITU Application filing date of June 9, 2016.

**II. THERE ARE NO GENUINE ISSUES OF MATERIAL FACT AS TO THE PLEADED CLAIMS AND DEFENSES IN THIS CASE**

Adar offered and rendered services under the NERDIO mark to consumers in U.S. commerce prior to Respondent’s ITU Application filing date, thus entitling Petitioner to priority to the NERDIO mark. With the facts and precedential case law not supporting its contrary position, Respondent now appeals to equitable remedies that to date are unpleaded, evidence that was withheld in discovery, as well as non-precedential case law. *See* 17 TTABVUE 10.

**A. The Board Does Not Hear Unpleaded Affirmative Defenses Argued in Response to Summary Judgment Motions**

The Board does not hear a party’s arguments attempting to establish laches (or other affirmative defenses) through dispositive motions when the relevant party failed to plead the

defense in its answer. *See U.S. Olympic Comm. v. Bata Shoe Co.*, 225 U.S.P.Q. 340, 341 (T.T.A.B. 1984); T.B.M.P. § 314; *see also, Spanishtown Enterprises, Inc. v. Transcend Resources, Inc.*, 2020 U.S.P.Q.2d 11388, at \*4 (T.T.A.B. 2020); *Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 U.S.P.Q.2d 1289, 1291 n.2 (T.T.A.B. 2016). In *U.S. Olympic Comm.*, the respondent attempted to establish that laches applied because of the petitioner’s delay even though respondent had not specifically pleaded the affirmative defense under Fed. R. Civ. Pro. 12(b). 225 U.S.P.Q. at 341. The Board refused to hear the argument in the respondent’s summary judgment motion because the respondent had failed to plead the defense in its answer. *Id.*

Here, Respondent is similarly attempting to establish an unpleaded laches defense in its Response to Petitioner’s Motion for Summary Judgment. Respondent voluntarily struck laches as an affirmative defense from its own pleading on December 1, 2020. *See* 6 TTABVUE. Discovery revealed no new information for laches, nor did Respondent move to amend its answer during the discovery period based on any allegedly newly discovery information. Respondent now argues that it withdrew its affirmative defenses “for the sake of judicial economy” (*see* 18 TTABVUE 1), but its clear that the withdrawal had nothing to do with judicial resources but instead had everything to do with a lack of evidence as Petitioner explained in its motion to strike. *See* 5 TTABVUE 3–4. Judicial resources would have been preserved had Respondent taken the time and effort to bring its claims once it believed it had a basis so that the parties could have properly investigated such allegations during discovery. Instead, Respondent now asks the Board to grant leave to revive its defense of laches and add a defense of bad faith based on information it has had in its possession for many months. *See* 18 TTABVUE 2. As discussed more fully in Petitioner’s Response to Respondent’s Motion to Amend its First Amended Answer, Respondent waited months to ask for the Board’s leave to amend, as its proposed amendments rely on evidence that

it likely had in its possession at least as early as January 2021. *See* Ex. VV, Respondent’s Initial Disclosures (citing to its likely reliance on “[c]ommunications with Petitioner and/or its representatives”). Laches is an unpleaded defense in this matter. Accordingly, the Board should refuse to hear the argument.

**B. Introduction of New Evidence That Respondent Withheld during Discovery is Inappropriate**

A party cannot introduce evidence that it withheld during discovery in a response to a motion for summary judgment. *Presto Prods., Inc. v. Nice Pak Prods., Inc.*, 9 USPQ2d 1895 n.5 (T.T.A.B. 1988). In *Presto Products*, a party attempted to support its motion for summary judgment by submitting evidence that it had refused to produce during discovery under attorney-client privilege. *Id.* The Board stated that a party who has refused to produce information sought in a discovery request may not thereafter rely on the information as evidence in its behalf and struck the newly introduced evidence. *Id.*

Here, Respondent attempts to do the same thing by improperly introducing new evidence that it withheld during the course of discovery. Respondent’s Director, Edmond Chow, claims that he has successfully prosecuted patents related to NERDIO services in the U.S. *See* Chow Declaration (17 TTABVUE) at ¶ 2. Yet, Respondent disclosed no such patent filings in its initial disclosures, and appears to have withheld the existence of the patent portfolio and related prosecution files in discovery. *See* Ex. VV, Respondent’s Initial Disclosures; *see also* Response to Petitioner’s First Set of Requests for Production, Request Nos. 7, 15, 23, 24, 27, 35, and 36. Mr. Chow also appears to have withheld the existence of the patent portfolio relating to services allegedly under his NERDIO brand and mark from Adar’s counsel in 2016 when she asked for additional details on Respondent’s services to assess whether there was a likelihood of confusion:



[REDACTED]

Ex. WW at NERDIOLTD\_0000133. Rather than direct Adar’s counsel to what would have been publicly available information regarding the services he was contemplating offering in the U.S., Mr. Chow directed counsel away from any such information: “[REDACTED]

[REDACTED]

[REDACTED]” Ex. XX, NERDIOLTD\_0000122.

Nonetheless, Mr. Chow’s alleged patent portfolio is irrelevant in this proceeding. Whatever the strategy is behind attempting to introduce evidence of a patent portfolio in a trademark proceeding after the close of discovery, the tactics are irrelevant to the record and summary judgment motions before the Board. As such, the Board should disregard the late-disclosed information and grant summary judgment for Petitioner.

**III. CONCLUSION**

Until Respondent filed its Statement of Use and its mark registered, Petitioner had no way of knowing that Respondent actually had plans to do business in the United States or that Respondent would actually pursue its registration despite Petitioner’s warning not to. Any allegedly disputed facts are now resolved and Petitioner respectfully request that the Board enter summary judgment for Petitioner.

For the reasons set forth above, the Board should grant Petitioner’s motion for summary judgment and cancel the ’453 Registration. The Board should also deny Respondent’s motion for summary judgment.

Dated: October 18, 2021

Respectfully submitted,

By: /s/ Alexis Crawford Douglas

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**CERTIFICATE OF SERVICE**

The undersigned, an attorney, hereby certifies that a copy of the foregoing PETITIONER'S REPLY IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT was served, via electronic mail, upon counsel for Respondent via email on October 18, 2021 at the following address:

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/s/ Alexis Crawford Douglas  
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# EXHIBIT VV

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

NERDIO, INC.  <p style="text-align:right">Petitioner,</p> <p style="text-align:center">v.</p> NERDIO LIMITED  <p style="text-align:right">Registrant.</p>	Reg. No.: 6153453 Reg. Date: September 15, 2020 Mark: NERDIO  Cancellation No.: 92/075,281
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**REGISTRANT’S INITIAL DISCLOSURES**

NerdIO Limited (“Registrant”), pursuant to Fed. R. Civ. P. 26(a)(1)(A), hereby makes the following initial disclosures. These disclosures are based on information reasonably available to Registrant at this time. Registrant’s investigation is ongoing, and it reserves the right to amend and/or supplement these disclosures at a later date. By providing this information, Registrant does not waive any attorney-client privilege, work product doctrine, or other privilege. Registrant reserves the right to object to discovery involving the subject matter of these disclosures.

**INITIAL DISCLOSURES**

**I. INDIVIDUALS WITH DISCOVERABLE INFORMATION**

The following individuals are likely to have discoverable information that Registrant may use to support its claims and defenses in this case.

1. **Edmond Kwok-Keung Chow**, Founder, and CEO of NerdIO Limited has knowledge regarding Registrant’s bona fide use and use of the NERDIO mark in

interstate commerce. Any contact with the foregoing individual should be made through Registrant's counsel.

## II. DOCUMENTS

Registrant may use the following categories of documents, data compilations and tangible things to support its claims and defenses in this proceeding.

1. Communications with Petitioner and/or its representatives.
2. Registrant and its related companies use of its marks in the United States.
3. Registrant's use of its NerdIO mark.

Date: January 15, 2021

BAKER & HOSTETLER LLP

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**CERTIFICATE OF SERVICE**

I, Jacqueline M. Lesser, hereby certify that on January 15, 2021 a true and correct copy of the foregoing REGISTRANT'S INITIAL DISCLOSURES has been served by e-mail upon Counsel for Petitioner, Alexis Crawford Douglas at [alexis.douglas@klgates.com](mailto:alexis.douglas@klgates.com); [patrick.richards@klgates.com](mailto:patrick.richards@klgates.com); [trevor.martin@klgates.com](mailto:trevor.martin@klgates.com).

*/Jacqueline M. Lesser/* \_\_\_\_\_

Jacqueline M. Lesser

# **EXHIBIT WW**

**REDACTED IN ITS ENTIRETY**



# **EXHIBIT XX**

**REDACTED IN ITS ENTIRETY**