

ESTTA Tracking number: **ESTTA1166714**

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

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

Proceeding	92075281
Party	Defendant NerdIO Limited
Correspondence Address	JACQUELINE M LESSER BAKER & HOSTETLER LLP 2929 ARCH STREET CIRA CENTRE, 12TH FLOOR PHILADELPHIA, PA 19104-2891 UNITED STATES Primary Email: jlesser@bakerlaw.com Secondary Email(s): llabella@bakerlaw.com , bhipdocket@bakerlaw.com , jjlyons@bakerlaw.com 215-568-3100
Submission	Reply in Support of Motion
Filer's Name	Jacqueline M. Lesser
Filer's email	jlesser@bakerlaw.com , jjlyons@bakerlaw.com , llabella@bakerlaw.com , bhipdocket@bakerlaw.com
Signature	/Jacqueline M. Lesser/
Date	10/18/2021
Attachments	2021-10-18-NERDIO LIMITED-PUBLIC-Reply Brief In Support of Its Motion for Summary Judgment.pdf(249964 bytes)

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

NERDIO, INC.,

Petitioner,

v.

NERDIO LIMITED,

Registrant.

Cancellation No.: 92075281

Reg. No. 6153453

Mark: NERDIO

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

Pursuant to Fed. R. Civ. P. 56 and 37 C.F.R. § 2.127, Registrant NerdIO Limited (“NerdIO”) submits this reply brief in further support of its motion for summary judgment. Petitioner Nerdio, Inc. (“Petitioner”) has presented no triable issues of material fact preventing entry of summary judgment in NerdIO’s favor and dismissal of the the Petition for Cancellation is warranted.

I. ARGUMENT

A. Petitioner Fails to Rebut the Facts Establishing That Petitioner Lacks Priority of Use to Cancel NerdIO’s Registration

Petitioner does not proffer any evidence that it used the mark “Nerdio” in interstate commerce before NerdIO filed its intent to use trademark application. Per Petitioner’s own verified interrogatory response and produced documents, its first in commerce of “Nerdio” for priority purposes was after NerdIO’s ITU application. Petitioner has submitted no evidence to the contrary. Instead, it offers explanations that do not support earlier actual trademark use in commerce necessary. 20 TTABVUE 2-10. A presumption of validity attaches to NerdIO’s registration. *Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989). Without a registration, Petitioner bears the burden of proof of priority of rights

as of a date earlier than NerdIO's rights. *See Embarcadero Techs., Inc. v. RStudio, Inc.*, 105 USPQ2d 1825, 1834 (TTAB 2013). None of the documents referenced by Petitioner establish early use in commerce. To the contrary, they are the same documents relied on by NerdIO to show that there was no priority use in commerce.

Although Petitioner attempts to paint its use of "Nerdio" as simply a rebranding of the then current Adar service, that clearly is not the case, as shown by Petitioner's own discovery, and which is not refuted by the documents submitted by Petitioner in support of its opposition. "Nerdio" was a different service than the AdarIT services. "Nerdio" had a complicated launch and internal pre-test. 11 TTABVUE 5-6. Petitioner points to the long negotiation for the new service, which included [REDACTED] with Adar, even for existing customers. *Id.* at 10. These documents, produced by Petitioner, support NerdIO's position that Petitioner's use of "Nerdio" was a different service than previously established by Petitioner's predecessor under the Adar name.

The other "uses" that it claims to support registration are all internal to the company. None of those types of activities withstand a use in commerce requirement for priority. The preliminary internal actions that the Petitioner conducted before a launch in August 2016 do not rise to the level of use in commerce. Petitioner has already established that its first use in commerce was to [REDACTED] and that sale was after NerdIO's intent to use application. While Petitioner now characterizes this new contractual arrangement as a mere "upgrade," it has presented no earlier customer than [REDACTED] which is identified in its verified responses to interrogatories as its first "Nerdio" customer. That the first customer for "Nerdio" was already an "Adar" customer does not create a priority of use in the mark "Nerdio" based on that customer's

earlier purchase of an Adar branded product or service, as Petitioner attempts to argue. 20 TTABVUE 12-13.

Nor would internal discussions on future marketing events satisfy a use in commerce requirement, as Petitioner also attempts to argue. 20 TTABVUE 14. Website use is not use in commerce. Internal testing by employees is not use in commerce. *See* 11 TTABVUE 11 (citing *City Nat'l Bank v. OPGI Mgmt. GP, Inc.*, 106 USPQ2d 1668, 1676-77 (TTAB 2013)). The preliminary internal actions that the Petitioner conducted before a launch in August 2016 do not rise to the level of use in commerce. *Id.* (citing *Era Corp v. Elec. Realty Assocs., Inc.*, 211 USPQ 734, 735 (TTAB 1981); *Aycock Eng'g, Inc. v. Airflite, Inc.*, 560 F.3d 1350, 1353, 90 USPQ2d 1301 (Fed. Cir. 2009); *In re Sones*, 590 F.3d 1282, 1289, 93 USPQ2d 1118 (Fed. Cir. 2009)).

Although Petitioner “claims” that it used its “Nerdio” mark to existing customers before the filing of its application, that is completely contradicted by Petitioner’s own admission that [REDACTED]

[REDACTED] *See* 15 TTABVUE, Ex. D at TTAB_NERDIOINC_0000916 (emphasis added). This position is also contradicted by the new documents submitted by Petitioner in opposition to NerdIO’s summary judgment motion. These emails from Adar customers about a future “Nerdio” service (which there is no indication these customers wish to purchase) do not create a triable issue. The [REDACTED] for marketing campaigns from customers using the NERDIO services[.]” do not exist. 20 TTABVUE 4-6; 9; 12, Exs. 2-4. These referenced exhibits are not of a “video testimonial” for a nonexistent “Nerdio” service, but are no more than a series of unauthenticated emails that at most establish that certain customers of AdarIT were [REDACTED]

[REDACTED]. Importantly, none of these emails supports the “use in commerce” requirement necessary for a showing of priority. The correspondence that

is Exhibit 2 to Petitioner’s opposition papers appears to be an exchange between [REDACTED]

[REDACTED] Exhibit 3 to Petitioner’s summary judgment opposition papers, which is also an unauthenticated document, is another email to AdarIT, [REDACTED]

[REDACTED]. Nothing in this email exchange supports any use of “Nerdio” as a trademark for services that are available. There is no person authenticating this document, and it is unclear of the context in which [REDACTED]

[REDACTED] Similarly, Exhibit 4, does not show use in commerce. It refers to [REDACTED]

[REDACTED] do not create a triable issue of use in commerce of the mark “Nerdio” used by Petitioner.

In fact, Petitioner’s opposition to NerdIO’s undisputed facts provides further support for NerdIO’s position that Petitioner’s cancellation should be dismissed on summary judgment for failure to proffer any priority evidence. Further corroborating NerdIO’s position that there were no sales of any NERDIO branded product or service until at least [REDACTED], Petitioner attempts to justify its [REDACTED] the company identified by Petitioner in its verified responses to Interrogatories as the “first customer to purchase licenses to the Nerdio platform and contract for IT services to support that platform[,]” 15 TTABVue at Ex. L (Petitioner’s Responses and Objections to Respondent’s First Set of Interrogatories at No. 6), by explaining that the [REDACTED] was also previously a customer for the AdarIT service and became a customer for the new ‘Nerdio’ service, after [REDACTED]

██████████ 20 TTABVUE 5-6 ¶ 6.¹ This upgrade required Adar to send a ██████████ ██████████, *id.* at 8 (citing 11 TTABVUE (Lesser Decl. at ¶ 25, Ex. X (TTAB_NERDIOINC_0002430))), and ██████████ ██████████ *id.* (11 TTABVUE (Lesser Decl. at ¶ 23, Ex. V (TTAB_NERDIOINC_0002236-38))), ██████████ ██████████ *Id.* (11 TTABVUE (Lesser Decl. at ¶ 24, Ex. W (TTAB_NERDIOINC_0002233))).

Petitioner presents no earlier customer. Petitioner also completely ignores the sales spreadsheet, which was produced by Petitioner in discovery in this case, and which revealed its earliest invoices, none of which were earlier than NerdIO’s ITU filing date and were in fact substantially later in time. The first actual invoice for a “Nerdio” branded service was ██████████

██████████ See 12 TTABVUE 10 (citing Lesser Decl. at ¶ 24, Ex. W). ██████████

██████████ All of these dates occurred after NerdIO filed its trademark application.

Although Petitioner attempts to blend its services under its Adar mark with those under the to-be-launched new “Nerdio” service, the documentation produced by Petitioner clearly establishes that any legally recognized use in commerce under a “Nerdio” mark was for a new

¹ Petitioner misleadingly notes that its negotiations with ██████████ ██████████ 20 TTABVUE 10 ¶ 16. However, those negotiations, according the sole document cited by Petitioner, began around ██████████ weeks after NerdIO’s ITU application was filed. *See id.* (citing Ex. 5 at TTAB_NERDIOINC_0002431).

service, and that use occurred after Registrant, NerdIO filed its application in the U.S. Use in commerce requires that a product or service be sold. *See Christian Faith Fellowship Church v. adidas AG*, 841 F.3d 986, 989 (Fed. Cir. 2016); *Couture v. Playdom, Inc.*, 113 USPQ2d 2042, 2044 (Fed. Cir. 2015) (“On its face, the statute is clear that a mark for services is used in commerce only when *both* [1] ‘it is used or displayed in the sale or advertising of services *and* [2] **the services are rendered....**’” (emphasis added) (quoting 15 U.S.C. § 1127)). Contrary to Petitioner’s novel definition, the rendering of services is not composed of internal or even external communications about a to-be-launched service. 20 TTABVUE 12.

B. Petitioner Conflates Use in Commerce with An Unpleaded Claim of Analogous Use

Petitioner attempts to argue “analogous use” of “Nerdio” in opposition to summary judgment. 20 TTABVUE 11. However, it has not pleaded analogous use of its trademark and cannot now make this claim in opposition to summary judgment. *See Cent. Garden & Pet Co. v. Doskocil Mfg. Co.*, 108 USPQ 1134, 1142 (TTAB 2013); *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1537-38 (TTAB 2007).

Petitioner’s sole grounds are “use in commerce,” which according to the discovery produced by Petitioner in this case, has revealed that Petitioner’s date of use is a significantly later date than alleged in its application or Petition for Cancellation. Petitioner has cited no evidence that it actually provided a “Nerdio”-branded service prior to NerdIO’s ITU application and failed to rebut the evidence to which NerdIO points. Therefore, summary judgment in favor of NerdIO is appropriate and Petitioner’s Petitioner for Cancellation should be dismissed.

C. Adar’s Purported June 6 “Trials” Do Not Create a Triable Issue of Fact of Priority of Use

The sum total of Petitioner’s cited evidence in support of its argument is that: (1) Adar launched its getnerdio.com website and had “details about its services and plans”; and (2) Adar

received free trial requests on June 2 and 6, 2016. 20 TTABVUE 15. None of the cited evidence demonstrates that Adar had offered a "Nerdio" -branded trial service. It is clear under the relevant caselaw, that simply presentation of a mark on a website, without the ability to make use is insufficient as a basis of priority. *Couture v. Playdom, Inc.*, 113 USPQ2d at 2044.

As to point (1), the evidence submitted in support of summary judgment by NerdIO establishes that irrespective of a website, Petitioner's own records show that there was no working "Nerdio" platform in early June 2016. *See* 11 TTABVUE 5 (citing documents that even the free trial request for the anticipated [REDACTED]

[REDACTED] Thus, the fact that Adar had details/descriptions about services it intended to offer on its website did not mean that those services were currently being offered. It is established that merely listing a service, without the possibility of performing is not use in commerce. *Aycock Eng'g, Inc. v. Airflite, Inc.*, 90 USPQ2d 1301, 1308 (Fed. Cir. 2009). Tellingly, Petitioner does not point to any evidence of actual services offered under the mark in early June 2016. Moreover, it is clear from the documents produced that Petitioner had no ability to contract and perform the services in early June 2016 because [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] 11 TTABVUE 5-6.

As to point (2), Petitioner maintains its misrepresentation of use through its "offering" of "free trials"—internally to its own business consultants at [REDACTED] to test the platform. *See* 11 TTABVUE (Lesser Decl. at ¶ 16, Ex. O (TTAB_NERDIOINC_0001093)); *see also id.* at ¶ 17, Ex. P (TTAB_NERDIOINC_0000983-84); *id.* ¶ 26, Ex. Y (TTAB_NERDIOINC_0001812-13); 13 TTABVUE, Ex. B at TTAB_NERDIOINC_0002427-28; 21 TTABVUE 12. Internal uses do

not qualify for use in commerce. *City Nat'l Bank v. OPGI Mgmt. GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1677 (TTAB 2013). Nor would an individual request from [REDACTED] [REDACTED] 20 TTABVUE 15 (citing 14 TTABVUE, Ex. UU at TTAB_NERDIOINC_0000072), to which Adar never provided the requestor with any service at all, not even a free trial. See 11 TTABVUE (Lesser Decl. at ¶ 19, Ex. R (TTAB_NERDIOINC_0002436)); *Aycock Eng'g*, 90 USPQ2d 1301 at 1308.

II. CONCLUSION

Petitioner has failed to demonstrate based on the evidence of record that there is a triable issue of fact of priority of use of “Nerdio.” The record evidence is that the Petitioner made use of a “Nerdio” mark well after the filing of NerdIO’s application. Therefore, NerdIO has priority of use of the NERDIO mark based on the date of its application, and its registration must withstand challenge. Accordingly, Registrant respectfully requests that the Board grant summary judgment in NerdIO’s favor, and dismiss the cancellation.

Dated: October 18, 2021

Respectfully submitted,

BAKER & HOSTETLER LLP

By: /s/Jacqueline M. Lesser

Jacqueline M. Lesser

Jeffrey J. Lyons

2929 Arch Street, Cira Centre, 12th Floor

Philadelphia, PA 19104

Tel: (215) 568-3100

jlless@bakerlaw.com

jjlyons@bakerlaw.com

Attorneys for Registrant NerdIO Ltd.

CERTIFICATE OF SERVICE

I, Jacqueline M. Lesser, hereby certify that on October 18, 2021, a true and correct copy of the foregoing REGISTRANT'S REPLY BRIEF IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT was served by e-mail upon Counsel for Petitioner at:

alexis.douglas@klgates.com

patrick.richards@klgates.com

trevor.martin@klgates.com

katy.allor@klgates.com

/Jacqueline M. Lesser/ _____

Jacqueline M. Lesser