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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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

NERDIO, INC.,

Petitioner,

v.

NERDIO LIMITED,

Respondent.

Cancellation No.: 92075281

Reg. No. 6153453

Mark: NERDIO

**RESPONDENT'S TRIAL BRIEF**

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## I. INTRODUCTION

Respondent, NerdIO Limited, is rightly the owner of the mark NERDIO. Since 2013, Respondent has used NerdIO as its company name and subsequently NERDIO as its mark for its computer software development and consulting services. Based on longstanding intent to use the NERDIO mark in U.S. commerce, on June 9, 2016, Respondent filed its intent-to-use application for its mark.

Petitioner's sole claim in its Petition for Cancellation is that it has priority to "Nerdio" based on purported use in commerce starting June 1, 2016—eight days before Respondent's constructive use date of June 9, 2016. However, Petitioner has not supported its priority claim with any credible proof, nor has it demonstrated a likelihood of confusion between the marks. Accordingly, the Petition has no legitimate grounds to cancel Respondent's mark.

By virtue of its constructive use date, Respondent, not the Petitioner, is the senior user of the mark NERDIO. Respondent is the first applicant in the U.S. and there is no earlier use in commerce by Petitioner. Respondent therefore respectfully requests that the Board deny this Petition for Cancellation.

## II. DESCRIPTION OF THE RECORD

Petitioner commenced this action on September 22, 2020. (1 TTABVUE). Respondent filed its Answer on November 2, 2020 (4 TTABVUE) and filed an Amended Answer on December 1, 2020 (6 TTABVUE), after Petitioner moved to dismiss Respondent's affirmative defenses (5 TTABVUE). Upon consideration, the parties' cross-motions for summary judgment on the issue of priority were denied. (11 TTABVUE; 15 TTABVUE; 31 TTABVUE). In denying summary judgment, the Board in relevant part, stated that "Petitioner may not rely upon an unpleaded use analogous to trademark use to prove priority." (31 TTABVUE 3 (citing *Cent. Garden & Pet Co. v. Dorskocil Mfg. Co.*, 108 USPQ 1134, 1142 (TTAB 2013))

**1. *Petitioner's Evidence***

Petitioner's trial evidence consists of the following:

- The deposition upon written questions of the principal of the Respondent, Edmond Kwok-Keung Chow (hereinafter "Chow"), taken in Hong Kong on August 23, 2022. (45 TTABVUE (confidential); 46 TTABVUE);
- The testimonial declaration of its CEO, Vadim Vladimirskiy, with accompanying trial exhibits (48 TTABVUE, "Vladimirskiy Decl."; 49 TTABVUE, "Vladimirskiy Decl.", (confidential)); and
- The testimonial declaration of Elizabeth Hoscheid, the director of marketing for Petitioner, with accompanying trial exhibits (50 TTABVUE (confidential); 51 TTABVUE).

Petitioner also submitted Notices of Reliance consisting of Official Records (55 TTABVUE (confidential); 56 TTABVUE); Printed Publications (53 TTABVUE; 54 TTABVUE (confidential)); and Respondent's Discovery Responses (52 TTABVUE).

The Parties filed a Joint Stipulation agreeing as to the authenticity of certain documents produced by Petitioner as business records kept in the ordinary course of business. (57 TTABVUE). Objections to the trial exhibits of Petitioner are set forth in detail in a separate statement of Evidentiary Objections filed concurrently herewith.

**2. *Respondent's Evidence***

Respondent took a cross-examination deposition of Vladimirskiy on December 15, 2022, which included trial **Exhibits A-P**. (63 TTABVUE, "Vladimirskiy Tr."; 64 TTABVUE, Vladimirskiy Tr. (confidential)).

Respondent submitted a testimonial declaration of its principal, Chow, which included trial **Exhibits Q-W** (66 TTABVUE, Chow Decl.; 68 TTABVUE, Chow Decl. (confidential)), and a



Notice of Reliance, which included trial **Exhibits X-VV** (67 TTABVUE; 70 TTABVUE (confidential)).

Chow's testimonial declaration provides unopposed evidence that the parties currently offer unrelated services and, indeed, have always offered unrelated services from each other. (66 TTABVUE 3-4, 6-9, Chow Decl. ¶¶ 9, 18, 21-24). Chow's testimonial declaration also provides unopposed evidence that Petitioner's adoption of the "Nerdio" mark was with knowledge of his rights and in bad faith. (66 TTABVUE 3, 8, 9-10, Chow Decl. ¶¶ 7-8, 20, 25).

The Notice of Reliance provides unopposed evidence to show Respondent's priority in the mark NERDIO (67 TTABVUE ¶¶ 1, 9-10); changes in Petitioner's services, channels of trade, and target consumers (67 TTABVUE ¶¶ 3-8, 9-10); history of Petitioner's business and ownership or lack of ownership of trademarks (67 TTABVUE ¶¶ 9-11); pointed discrepancies from Petitioner's testimony (67 TTABVUE ¶¶ 9-10); chain of title and ownership claims made by both Petitioner and its predecessor regarding Petitioner's application (67 TTABVUE ¶¶ 10).

Petitioner has not raised any objections to Respondent's evidence and has not cross-examined Respondent's witness.

### **3. *Rebuttal Evidence***

Petitioner did not submit any rebuttal testimony or evidence.

## **III. STATEMENT OF THE ISSUES**

The sole basis for the case is priority of actual use in interstate commerce. Analogous use is not at issue. As previously identified by the Board in its denial of cross motions for summary judgment, "Petitioner may not rely upon an unpleaded use analogous to trademark use to prove priority." (31 TTABVUE 3).

Accordingly, the only issues properly before the Board in this proceeding are:

1. Whether Petitioner has met its burden of proving that the services contained in Petitioner's pending application were actually used in interstate commerce before Respondent's June 9, 2016 constructive use date.
2. Whether Petitioner should be entitled to cancel a trademark registration which has been properly registered under Section 1(b) of the Lanham Act when its evidence of priority is not credible based on a long history of misrepresentations and demonstrated inconsistencies within the record.

#### IV. **STATEMENT OF THE FACTS**

Respondent was first established in 2013 by Edmond Kwok-Keung Chow. (66 TTABVUE 2-3, Chow Decl. ¶ 5). Respondent adopted the name NerdIO in good faith in 2013 by changing the name of his then-existing Hong Kong company, China Software Venture Limited, to NerdIO Limited. (66 TTABVUE 2-3, Chow Decl. ¶ 5; 66 TTABVUE 13-14, Exhibit Q). Respondent has been a Hong Kong company since July 16, 2013. (66 TTABVUE 2-3, Chow Decl. ¶ 5). Chow is the principal of Respondent and a registered professional engineer. (66 TTABVUE 2-3, Chow Decl. ¶ 1, 4).

In 1999, Chow acquired the domain name [www.nerdio.com](http://www.nerdio.com) with the intent of operating a business using the mark NERDIO. (66 TTABVUE 2-3, Chow Decl. ¶ 5). Chow owns several patents which he intended to commercialize under the NerdIO brand in the United States. (66 TTABVUE 3, Chow Decl. ¶ 6). In keeping with its plans, on June 9, 2016, Respondent filed its intent-to-use application under U.S. Serial No. 87/066,441 (the "Subject Application") to register the mark NERDIO for the following services, which correspond to Chow's patents:

Computer software design; computer software development; computer programming; computer software application development in the field of Internet-enabled services; product design and development in the field of Internet-enabled services; advisory services in the fields of product development and quality improvement of software; consulting services in the field of software development; consulting services in the field of product development; consulting

services in the field of development and protection of intellectual property related to information technology; consulting services in the fields of design, selection, implementation and use of digital hardware, software components, application programming interface, and cloud computing services for product development and deployment; none of the aforesaid services being for hosting of electronic communication services, software applications, and data storage for others in the field of enterprise information technology outsourcing, installation and configuration of enterprise software and hardware at customer premises, or support and maintenance thereof.

(66 TTABVUE 2-3, Chow Decl. ¶ 2). Respondent has made use of the mark on all of the claimed services. (66 TTABVUE 2-3, Chow Decl. ¶ 2; 46 TTABVUE 10:1-5).

Respondent filed its statement of use and supporting specimens of use on July 10, 2020. (July 10, 2020 Statement of Use, at TSDR).<sup>1</sup> The mark was registered on September 15, 2020, under U.S. Reg. No. 6,153,453. (September 15, 2020 Registration Certificate, at TSDR.)

None of these facts are in dispute.

**A. PETITIONER WAS LONG AWARE THAT RESPONDENT CLAIMED RIGHTS IN NERDIO.**

Even prior to the filing of Respondent's intent-to-use application on June 9, 2016, Petitioner was aware of both Respondent and its principal, Chow. (66 TTABVUE 3, Chow Decl. ¶¶ 7-8). However, neither Respondent nor Chow were aware of the Petitioner. (66 TTABVUE 3-4, Chow Decl. ¶¶ 9). In early May 2016, Chow was approached by an anonymous intermediary interested in purchasing Mr. Chow's www.nerdio.com domain for a client. (66 TTABVUE 3, Chow Decl. ¶ 7). Chow rejected that offer unequivocally. (66 TTABVUE 3, Chow Decl. ¶ 7). Over the course of the month, the anonymous buyer *sua sponte* [REDACTED], but Chow did not respond. (68 TTABVUE Exhibit R (confidential)). Then, on June 8, 2016, Petitioner's predecessor company, Adar, Inc., revealed itself to be the potential anonymous

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<sup>1</sup> The Trademark Status & Document Retrieval ("TSDR") citations refer to the electronic file database for the involved Registration, No. 6,153,453. All citations to the TSDR database are to the downloadable .pdf version of the documents.

purchaser. (68 TTABVUE Exhibit S (confidential)) Chow again rejected the offer. (68 TTABVUE 3 Chow Decl. ¶ 8 (confidential)).

On July 14, 2016, one month after filing the Subject Application, Chow received a letter from counsel for Adar, Inc. alleging that [REDACTED] (68 TTABVUE Exhibit T (confidential)). However, no opposition or other action was taken against the Subject Application during its publication period. (66 TTABVUE 7, Chow Decl. ¶ 15).

**B. PETITIONER HAS MADE REPEATED CONTRADICTIONARY AND INACCURATE STATEMENTS REGARDING OWNERSHIP AND USE OF THE NERDIO MARK TO THE PUBLIC, USPTO AND THE BOARD.**

Petitioner's evidentiary record is rife with contradictory statements that do not support its claims. Such inaccuracies can be found throughout the record, from Petitioner's customer testimonials to its claimed date of first use, scope of actual services offered, and even ownership of the asserted mark.

**1. *Petitioner Admits That It Manipulated Customer Testimonials on Its Website.***

To promote its new "Nerdio" services, Vladimirskiy testified that Petitioner promoted testimonials from customers on the new getnerdio.com website. (48 TTABVUE 4, Vladimirskiy Decl. ¶ 13). Some examples of these testimonials are attached to Vladimirskiy's Declaration in Exhibit 4. (48 TTABVUE 19-23). Because no customers had ever actually received Nerdio-branded services, the testimonials were from customers "who previously received computer and IT services under the ADAR IT mark." (48 TTABVUE 4, Vladimirskiy Decl. ¶ 13). It is clear from the context of the testimonials that the customers are describing prior services that had been rendered under the Adar name and brand. However, to make it appear that those testimonials were about Nerdio-branded services, Petitioner changed the name from "Adar" to "Nerdio." For example, one such testimonial congratulates Nerdio on "10 years" even though the brand had only just launched (48 TTABVUE 19-23, Exhibit 4 to Vladimirskiy Decl.):



Vladimirskiy was asked about another such testimonial in cross examination (63 TTABVUE 87, Vladimirskiy Tr. 86:12-22):

Q. Okay. So the quote here says (as read):

"Since going live with Nerdio in 2014, we haven't had any downtime, and the user experience with Nerdio has been fantastic! Nerdio has been one of the best decisions I've made -- I've had a lot more time to focus on core business."

Did I read that correctly?

**A. Yes.**

Q. Was there a Nerdio offered by Adar in 2014?

**A. No.**

Petitioner took old testimonials for Adar and changed them to promote Nerdio, even though none of these customers had ever actually received Nerdio-branded services. This shows that Petitioner is comfortable making misrepresentations in its marketing materials to the public and its potential customers.

2. *Petitioner Misrepresented the Scope of its Actual Use in Vladimirskiy's Testimonial Declaration, the '739 Application, and this Petition.*

Petitioner has conceded that it does not use “Nerdio” on the majority of services included in its ‘739 Application, which were the services asserted in its Petition for Cancellation.<sup>2</sup> The Vladimirskiy trial testimonial declaration states that Petitioner currently offers all of the services under the Nerdio mark that are claimed by the ‘739 Application (48 TTABVUE 3, Vladimirskiy Decl. ¶¶ 8-9). That is not true. Vladimirskiy admitted that Petitioner does not actually offer most of the claimed services in the ‘739 Application:

3           Q.    So that's -- this is a -- so today do you  
4   offer all of these services under the Nerdio mark?  
5           A.    No.  
6           Q.    Okay.  What don't you offer?  
7           A.    (Witness reviews document.)  Many of these  
8   services.

(63 TTABVUE 55, Vladimirskiy Tr. 54:3 – 8). When pressed on cross examination, Vladimirskiy admitted that, despite his prior sworn statement under oath, the actual services offered by Petitioner under a “Nerdio” mark are considerably more limited. (63 TTABVUE 55-57, Vladimirskiy Tr. 54: 6-56: 18). Through cross-examination it was confirmed that Petitioner does not offer the following specific services claimed in the ‘739 Application:

- “Computer services, namely providing information technology infrastructure services via an internet-based private network in the nature of remote and on-site infrastructure management services for monitoring, administration, and management of private cloud computing IT and application systems” (63 TTABVUE 55-56, Vladimirskiy Tr. 54:21-55);

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<sup>2</sup> See Cover Page of Petition for Cancellation (1 TTABVUE Cover Pages 1-2) and allegation in Petition for Cancellation (1 TTABVUE ¶ 2).

21 "Computer services, namely providing  
22 information technology infrastructure services via  
23 an internet-based private network in the nature of  
24 remote and on-site infrastructure management  
25 services for monitoring, administration, and  
  
1 management of private cloud computing IT and  
2 application systems"?  
3 **A. No.**

- “Monitoring the computer systems of others for technological purposes and providing backup computer programs and facilities” (63 TTABVUE 56, Vladimirskiy Tr. 55:4-8);

4 Q. Do you offer (as read):  
5 "Monitoring the computer systems of others  
6 for technological purposes and providing backup  
7 computer programs and facilities"?  
8 **A. No.**

- “Outsource service provider in the field of information technology consulting” (63 TTABVUE 56, Vladimirskiy Tr. 55:9-12);

9 Q. Do you offer (as read):  
10 "Outsource service provider in the field  
11 of information technology consulting"?  
12 **A. No.**

- “Electronic data storage” (63 TTABVUE 56, Vladimirskiy Tr. 55:17-19);

17 Q. Do you offer (as read):  
18 "Electronic data storage"?  
19 **A. No.**

- “Computer services, namely remote management of the information technology (IT) systems of others.” (63 TTABVUE 56, Vladimirskiy Tr. 55: 20-24);

20 Q. Do you offer (as read):  
21 "Computer services, namely remote  
22 management of the information technology (IT)  
23 systems of others"?  
24 A. No.

- “Technical support for computer systems, namely monitoring technical functions of computer network systems” (63 TTABVUE 57, Vladimirskiy Tr. 56: 9-13).

9 Q. Do you offer (as read):  
10 "Technical support for computer systems,  
11 namely monitoring technological functions of  
12 computer network systems"?  
13 A. No.

Based on Petitioner’s cross examination testimony as described above, the current identification of services for the ‘739 Application would more accurately appear as follows:

Computer services, namely, acting as an application service provider in the field of information management to host computer application software for the purpose of business and enterprise operations; ~~Computer services, namely, providing information technology infrastructure services via an internet-based private network in the nature of remote and on-site infrastructure management services for monitoring, administration and management of private cloud computing IT and application systems; Monitoring the computer systems of others for technological purposes and providing backup computer programs and facilities; Outsourced service provider in the field of information technology consulting;~~ Planning, design and implementation of computer technologies for others; ~~Electronic data storage; Computer services, namely, remote management of the information technology (IT) systems of others;~~ Installation, maintenance and repair of software for computer systems; Technical support services for computer systems, namely, troubleshooting of computer software problems; ~~Technical support for computer systems, namely, monitoring technological functions of computer network systems;~~ computer technology support services, namely, helpdesk services.

This shows that Petitioner is comfortable making misrepresentations about its service offerings in sworn statements to the USPTO.



**3. Petitioner Submitted Contradictory Statements and Evidence Regarding its Date of First Use.**

On June 21, 2016, twelve days after Respondent’s filing of the Subject Application, Vladimirskiy, as the CEO of Adar, Inc., filed a *use-based* application to register the mark NERDIO, wherein he stated under oath and under penalty of perjury that Adar Inc. had used “Nerdio” on the services identified in the 87/078,739 application (the “‘739 Application”) since June 1, 2016. (67 TTABVUE Exhibit VV, also available at June 21, 2016 TEAS RF New Application, at TSDR in App. No. 87078739). Vladimirskiy, now as the CEO of Nerdio, Inc., makes the very same representation under oath in his trial testimonial declaration, sworn to on October 26, 2022. (48 TTABVUE 8, Vladimirskiy Decl. ¶ 37). Nevertheless, during his cross examination, Vladimirskiy acknowledged that he defined “use” as far less than the requisite use in commerce to support a valid priority of use:

8	<b>A. The first public use was on June 1st of</b>	
9	<b>2016. Internally it was used prior to that.</b>	
10	Q. Okay. You said "first public use."	
11	What do you mean by "first public use"?	
12	<b>A. Social media channels, website,</b>	
13	<b>announcement to customers, etcetera.</b>	
14	Q. Okay. What do you mean by "etcetera"?	
15	<b>A. That -- that's it. Those --</b>	
16	Q. Okay.	
17	<b>A. -- those channels.</b>	

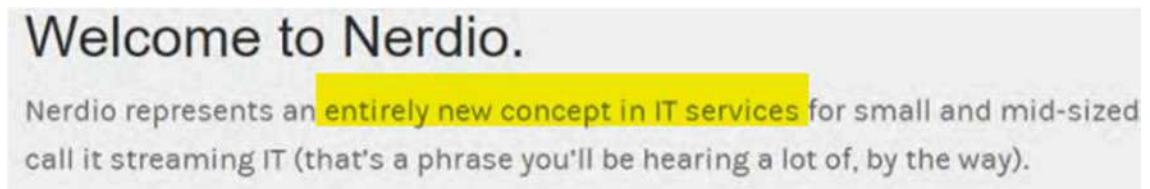
(63 TTABVUE 30, Vladimirskiy Tr. 29:10-17). The alleged “use in commerce” was no more than social media uses and online announcements. This is not the type of customer-facing use in commerce supporting the actual rendering of services in connection with a mark.

Petitioner’s brief suggests that the transition from the ADAR mark to the NERDIO mark was a flip-the-switch overnight transition of the company brand. (73 TTABVUE 11 (“prior to launching

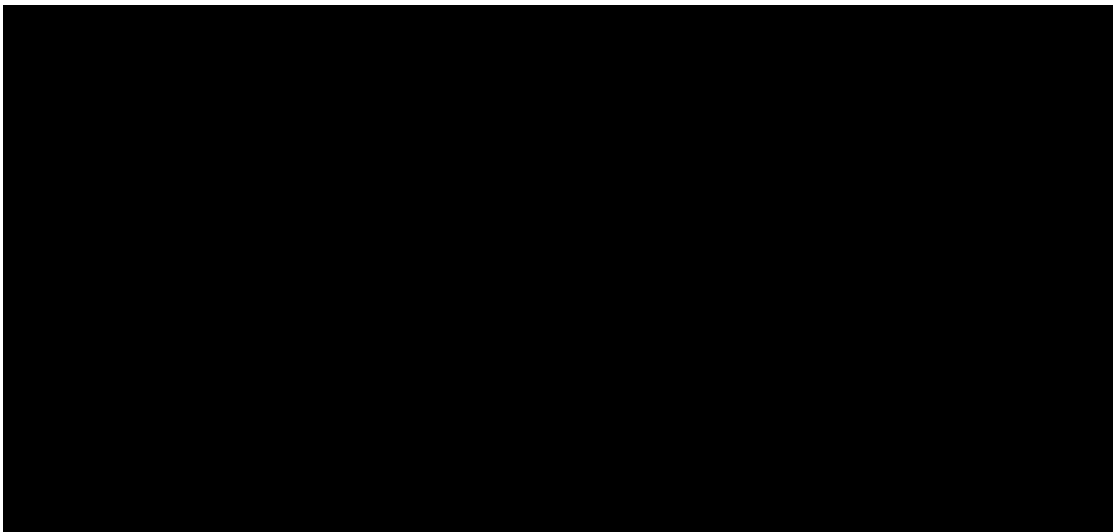
the NERDIO mark, Adar was previously engaged in offering and providing its customers with the same services as those it provided under the NERDIO mark”). Vladimirskiy’s declaration also refers to a transition of existing services as an overnight event. (48 TTABVUE 3, Vladimirskiy Decl. ¶9; 63 TTABVUE 58-59, Vladimirskiy Tr. 57:25-58:11, 87:12-15 and 22-25 (Q: “But did Adar change its brand to Nedio as of that date? Adar continued to offer services under the Adar name; didn’t it?” A: “All existing services being offered on and after June 1<sup>st</sup> were offered under the Nerdio brand.”); 63 TTABVUE 58-9, 88).

A close examination of Petitioner’s documentary evidence purporting to show priority of use, however, also reveals inconsistencies with June 1, 2016 as the date of first use, as detailed below.

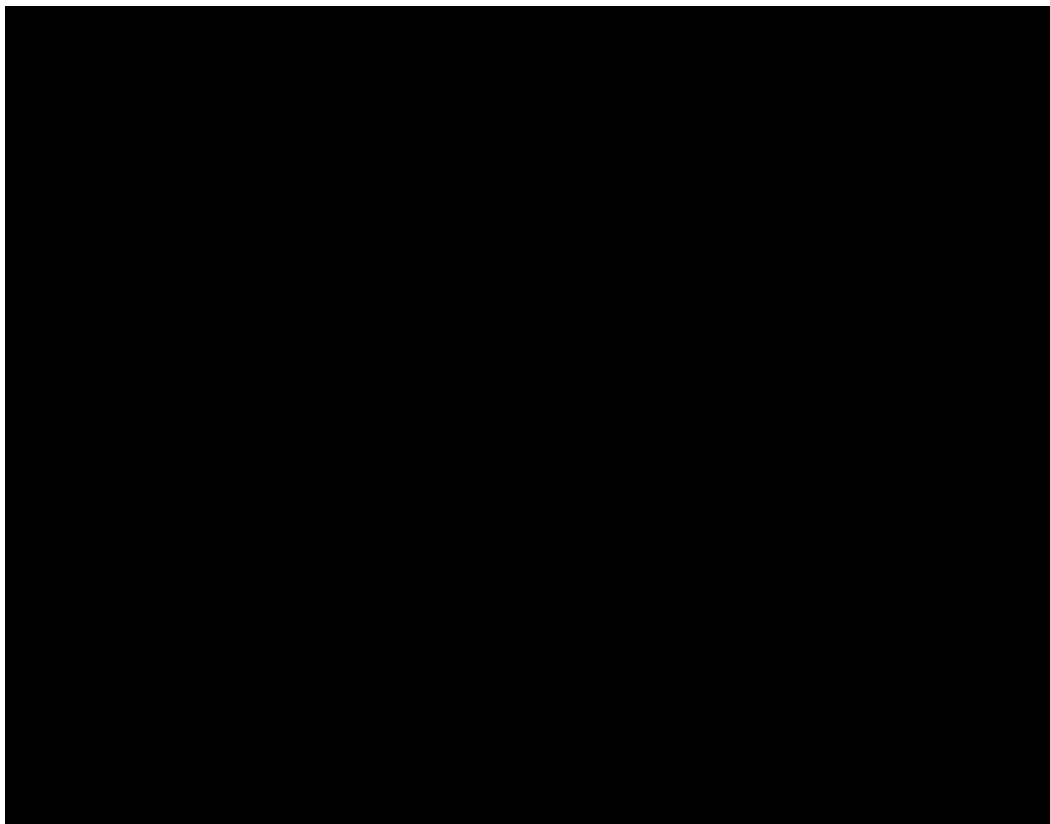
Proffered evidence contradicts Petitioner’s position that “Nerdio” simply replaced ongoing “Adar” branded services. Exhibit 3 to the Vladimirskiy trial testimonial declaration is a document uploaded from the *Wayback Machine*, covering a date range between June 2016 and August 2016. In it, Petitioner promotes a blog post not for a new name, but for an “*entirely new concept*” under a NERDIO designation (48 TTABVUE 17-18, Vladimirskiy Decl. Exhibit 3):



More evidence that Nerdio was a new service, not a replacement name for an old service is that one of Petitioner’s sales representatives sent an email on June 7, 2016 [REDACTED] [REDACTED] (70 TTABVUE Exhibit JJ (confidential)).



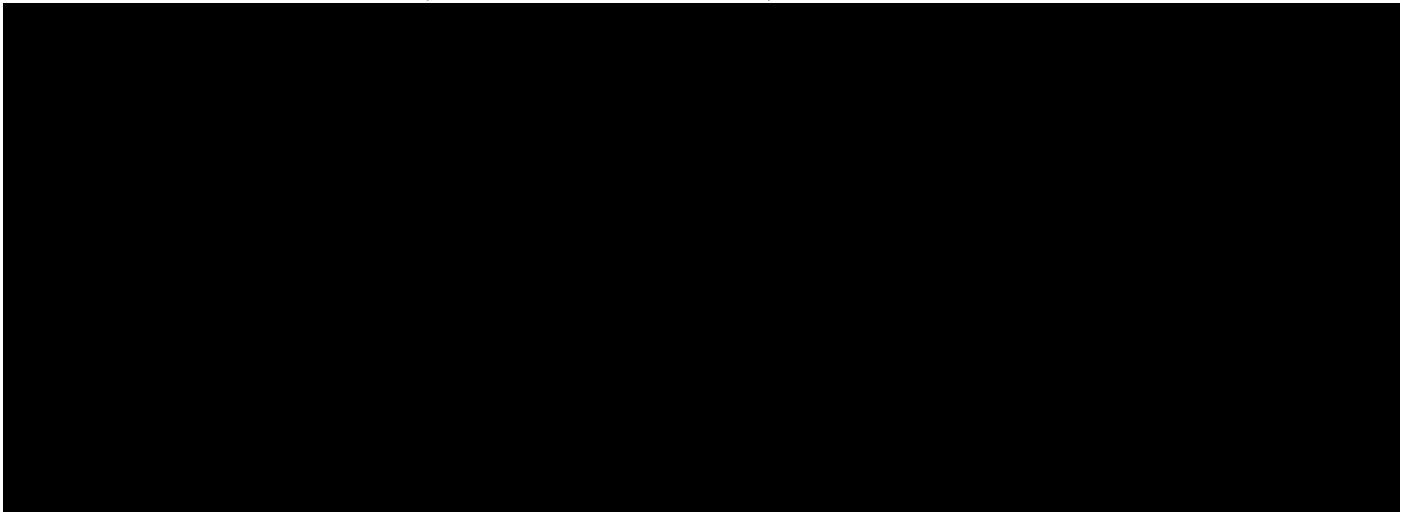
In another email, a report that the website's Terms of Service had been [REDACTED] [REDACTED]” resulted in a response that the terms needed to be returned [REDACTED] [REDACTED] (70 TTABVUE Exhibit GG (confidential)). This suggests that Adar was still offering services through its Adar-branded website and could not yet lose the Terms of Service while it was operational.



There is also record evidence that the “Nerdio” branded services needed to be rolled out and trialed. (63 TTABVUE 79, Vladimirskiy Tr. 78:17-19).

17           **A. Nerdio trial is a -- is a way for a**  
18           **customer or a potential customer to test and use**  
19           **the Nerdio services.**

The need to test the services strongly suggests that the services were new and different. Moreover, Petitioner’s evidence suggests that this testing prior to launch occurred after Respondent’s constructive first use date. (67 TTABVUE). While Vladimirskiy’s trial testimonial declaration states that on June 2, 2016, Adar set up free trials for customers to test the new service, the supporting documents reveal that alleged date is not true. (48 TTABVUE 5, Vladimirskiy Decl. ¶ 15) (49 TTABVUE Exhibit 7 to Vladimirskiy Decl. (confidential)). Vladimirskiy Exhibit 7 shows that the trials did not begin on June 2, 2016. According to the record evidence, the earliest scheduled test did not start until June 16, 2016. (70 TTABVUE at Exhibit Y):



These are not the only examples of contradiction between Petitioner’s priority claim and its documents:

- When asked by his staff how to respond to concerned customers, Vladimirskiy responded,



[REDACTED]

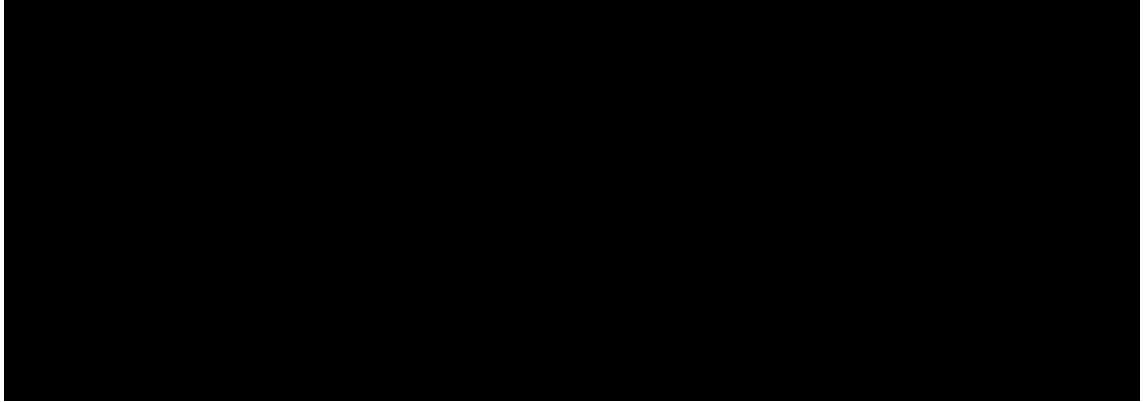
(48 TTABVUE 29 Exhibit 8 (confidential) (emphasis added)).

- [REDACTED]
- One email preparing for launch shows that the intended [REDACTED] [REDACTED].” (70 TTABVUE at Exhibit OO (confidential)). Notably [REDACTED] stated in May 2016 (at a time when Petitioner still thought it would purchase Respondent’s domain and was not trying to establish priority post-hoc), directly contradicts Petitioner’s asserted June 1 date.
- [REDACTED]

- On June 2, 2016 Vladimirskiy was telling his contractor that [REDACTED] [REDACTED] (70 TTABVUE at Exhibit NN)<sup>3</sup>. There was no mention of rolling over existing customers.

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<sup>3</sup> This email chain also referenced the [REDACTED] scheduled to be launched today, implying more than a name change.

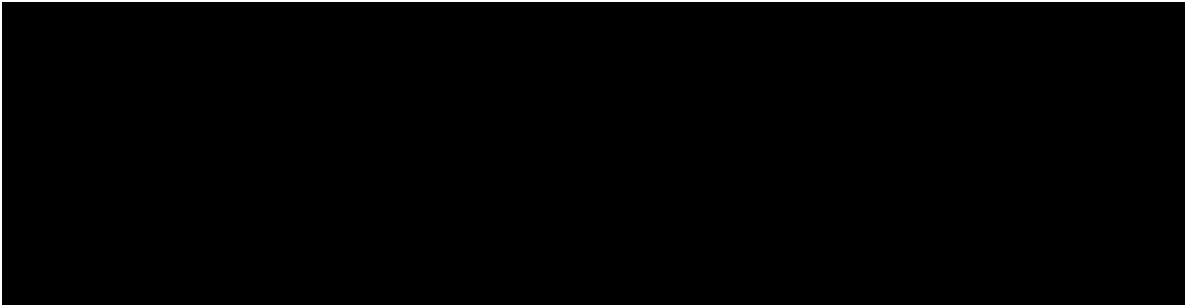


- Also on June 2, a day after the alleged first use date, Adar’s VP of sales sent an email

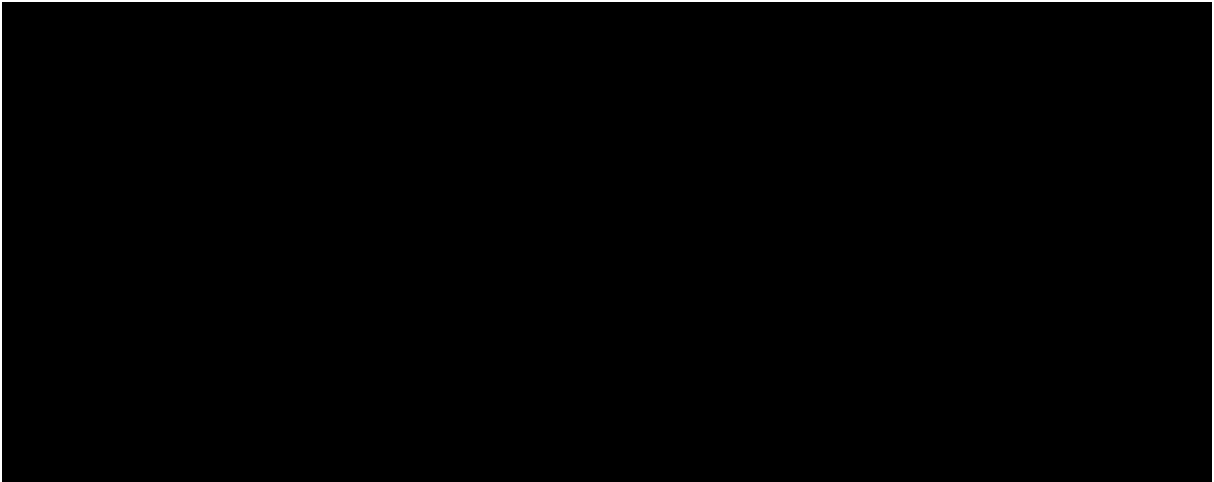


\_\_\_\_\_.” (70 TTABVUE at Exhibit KK (emphasis

added)). This suggests the team was tying up loose ends as it prepared for launch.

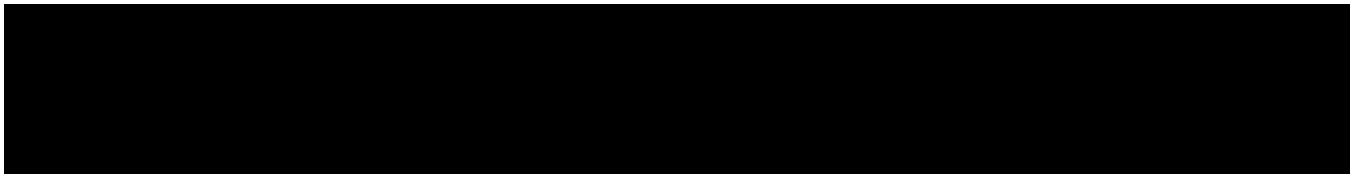


- On Monday, June 6, 2016, five days after the alleged “use” date, the internal sales team at Adar was still planning how it would promote the new service. (70 TTABVUE Exhibit MM (confidential)):

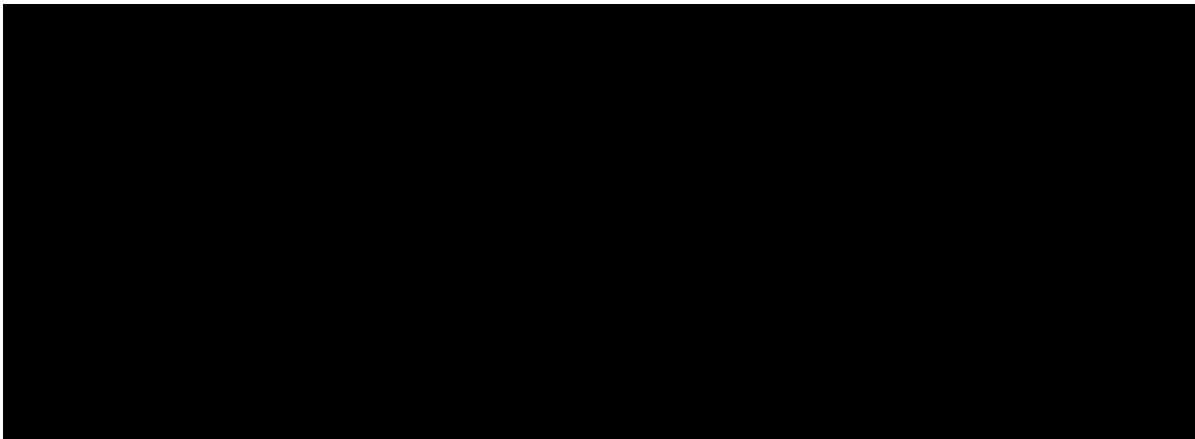


- Moreover, Petitioner’s counsel was [REDACTED],” a sign that Petitioner was preparing for use but had not yet actually started since this was a product that required individual customer contracts (70 TTABVUE Exhibit MM (confidential)), (67 TTABVUE Exhibit FF).

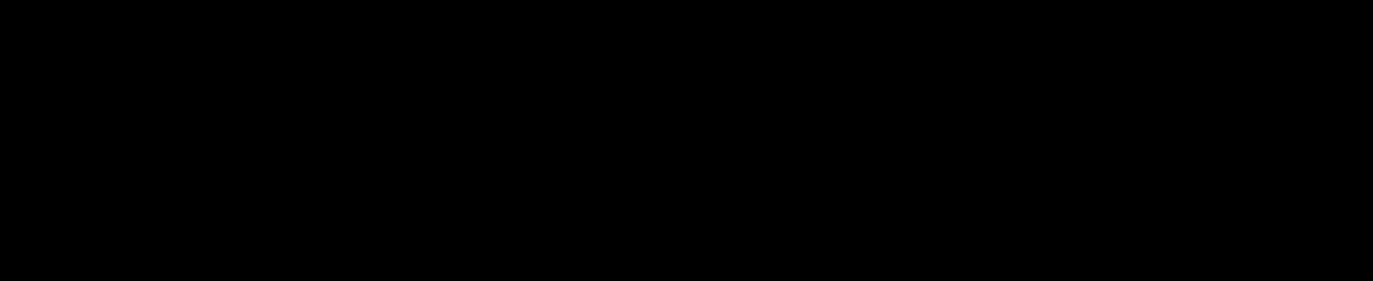
As another example of Petitioner’s many contradictions, Vladimirskiy referred to a spreadsheet in Exhibit 7 as showing “customer” trials, when the relevant trials with early use dates were not for customers at all. (49 TTABVUE 6, Vladimirskiy Decl. ¶12 (confidential)).



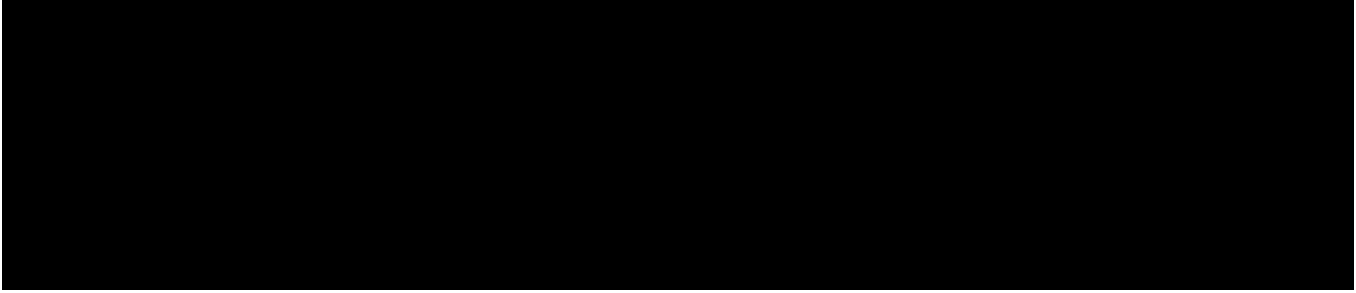
The insinuation is that [REDACTED] t, shown in the first row of the chart, was a “customer” of the Nerdio-branded services. In cross examination, however, Vladimirskiy revealed that [REDACTED] was actually a vendor to Adar, not a customer, and that it was assisting with the free trials. (64 TTABVUE 77-78, Vladimirskiy Tr. 76:19-21,77:1-7:10-25 (confidential); 67 TTABVUE 14, Exhibit Y (explaining [REDACTED]); 70 TTABVUE Exhibit HH (showing that on June 8, 2016 [REDACTED] was a vendor providing support to Adar)).




The second trial customer was Vladimirskiy, himself, on behalf of Adar. (49 TTABVUE Exhibit 7 (confidential)). Neither of these trials could reasonably be considered “use in commerce,” even if they had been completed before Respondent’s constructive use date of June 9, 2016.



As the chart from Exhibit 7 further shows, most of these early trials were “cancelled.” (49 TTABVUE, Exhibit 7 (confidential)).



The first trial that could be considered an external test and is listed as “finished” was for .” That trial was created on July 22, 2016 and did not start until August, well after Respondent’s constructive use date. (*Id.*)

In addition to the above documentary contradictions, Petitioner’s testimony also contradicts its assertion of a June 1, 2016 priority date. When questioned on cross examination, Vladimirskiy admitted that the services to be offered under the NERDIO mark were not the same services as offered under the ADAR mark, which would make Petitioner’s flip-of-the-switch theory of use impossible. (63 TTABVUE 51-52, Vladimirskiy Tr. 50:25-51:1).



13 Q. Was the trademark Nerdio intended to  
14 replace the trademark ADAR PrivateCloud?  
15 MR. WYLIE: Object to scope.  
16 A. As of what date?  
17 Q. As of the date of the application.  
18 A. Which application?  
19 Q. For Nerdio.  
20 A. Okay.  
21 Q. The application for Nerdio.  
22 MR. WYLIE: Objection. Scope.  
23 A. No, it was meant to augment it.  
24 Q. And what do you mean by "augment it"?  
25 A. It was meant to be used for provision of

51

1 services alongside the Adar trademark.

Instead, Vladimirskiy reveals that the Nerdio services were “meant to augment” the Adar services, which implies adding something new. (*Id.*). This admission again directly contradicts his prior sworn statement wherein he characterizes the services contained in the ‘739 Application as identical services conducted under both the Adar and Nerdio businesses and defines them as “Nerdio Services.” (48 TTABVUE 3, Vladimirskiy Decl. at ¶8).

Not only were the Nerdio and Adar services different at the time of launch, the nature of the Nerdio services has changed over time. To explain how Petitioner’s services have evolved, Respondent provides the following clarification, which is not disputed by Petitioner: Petitioner’s current services now support a single third party – Microsoft. (73 TTABVUE 23-24, Chow Decl. ¶ 22). These are essentially “helpdesk” services for Microsoft Azure, nothing more. (48 TTABVUE 3, Vladimirskiy Decl. ¶8). This is far more limited than initially claimed.

The above-described testimony and evidence contradict Petitioner's position of priority and show that Petitioner is comfortable making inaccurate statements regarding its use of the "Nerdio" mark in commerce.

**4. *Petitioner Misrepresented Ownership of '739 Application in Loan Documents Filed with the USPTO.***

Not only are Petitioner's marketing materials, scope of rendered services, and date of first use called into question as described in the previous subsections, but Petitioner's actual ownership of both the '739 application and the underlying goodwill is not clear based on recorded documents in the USPTO. Petitioner alleges that it "own[s]" all rights in the '739 Application because it received an assignment of the '739 application through a chain of title. (1 TTABVUE ¶ 2; 67 TTABVUE 72, Exhibit FF, Interrogatory No. 2). Petitioner contends those rights give it standing to bring this action. (1 TTABVUE ¶ 2). However, the trial record presents evidence that as late as 2019, if not later, Adar, Inc. maintained ownership of the '739 application and the associated common-law rights, which is the only basis for Petitioner's claim against Respondent. (63 TTABVUE 46-48, Vladimirskiy Tr. 45:8-47:23; 63 TTABVUE 162-170, Exhibit E; 63 TTABVUE 171-181, Exhibit F).

On December 31, 2017, Adar Inc. transferred all rights in the '739 application to Adar Holdings Inc. (63 TTABVUE 43-44, Vladimirskiy Tr. 42:17-43:10; 63 TTABVUE 150-155, Exhibit C). That same day, Adar Holdings Inc. transferred all rights to Petitioner. (63 TTABVUE 44, Vladimirskiy Tr. 43:21 -18; 63 TTABVUE 156-161, Exhibit D). However, on April 12, 2019, Adar, Inc., the first assignor, executed a security interest agreement with Pacific Western Bank that confirmed and pledged all of its "right, title and interest" in and to '739 application, as well as "without limitation all proceeds thereof (such as, by the way of example but not by way of limitation, license royalties and proceeds of infringement suits), the right to sue for past, present and future infringements, all rights corresponding thereto through the world and all re-issues, divisions, continuations, renewals, extensions and continuations-in-part thereof" as collateral for a security

interest to secure a loan. (63 TTABVUE 46-47, Vladimirskiy Tr. at 45:8-46:14; 63 TTABVUE 162-170, Exhibit E). All three documents – the two assignments and the loan agreement – were signed by Vladimirskiy as CEO of the three respective entities.<sup>4</sup> (63 TTABVUE 150-155, Exhibit C, 63 TTABVUE 156-161, Exhibit D, 63 TTABVUE 162-170, Exhibit E).

A few months later, on June 18, 2019, Adar, Inc. entered into another financing arrangement with CIBC Bank USA, in which “reaffirms” its prior grant of a security interest to ‘739 Application and affirms its “entire right, title, and interest in and to all of its now owned or existing and hereafter acquired or arising trademarks, trade names, corporate names, company names, business names, fictitious business names, trade styles, service marks, logos, ...an all applications in connection therewith,” as well as “all rights corresponding to any of the foregoing throughout the world and the goodwill” of [Adar, Inc.’s] business connected with the use of and symbolized by the Trademarks.” (63 TTABVUE 47-48, Vladimirskiy Tr. 46:23-47:23, 63 TTABVUE 171-181, Exhibit F). Adar, Inc., as the “Borrower,” also provided warranties and representations that “Borrower is the sole and exclusive owner of the entire and unencumbered right, title and interest in and to each Trademark, free and clear of any liens...charges and encumbrances.” (Exhibit F). Further, “Borrower shall not, without the prior written consent of Lender...sell or assign its interest in any Trademark or enter into any other agreement with respect to any Trademark which would affect the validity or enforcement of the rights transferred to Lender under this Security Agreement.” (Exhibit F) Adar Inc. also agreed in this document to “maintain the quality of any and all products in connection with which the Trademarks are used.” This document was executed by Vladimirskiy as the “President and Chief Executive Officer” of Adar, Inc. (Exhibit F) Thus, as least as late as June 18, 2019, more than three years after Respondent acquired constructive use rights in its application for the mark NERDIO,

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<sup>4</sup> Interestingly, Adar, Inc. and Adar Holdings Inc. are still existing companies along with Nerdio Inc. (67 TTABVUE 73, Exhibit FF, Interrogatory No. 3)

Adar, Inc., (and pointedly not Nerdio, Inc.) continued to claim exclusive trademark rights in the ‘739 Application and all rights appurtenant thereto.

When asked about these security interests on cross-examination, Vladimirskiy had no explanation why Adar, Inc. was entitled to claim rights in the ‘739 Application. (63 TTABVUE 47-48 , Vladimirskiy Tr. 46:14, 47:23).

9 Q. Okay. Then how did ADAR, Inc., come to  
10 use the Nerdio mark as collateral for a loan in  
11 2019?  
12 MR. WYLIE: Objection. Scope.  
13 Foundation. Legal conclusion.  
14 A. I do not recall.

These repeated inconsistencies on important business documents cast doubt on the accuracy of Petitioner’s entire record.

V. **ARGUMENT**

**A. RESPONDENT’S REGISTRATION AND CONSTRUCTIVE USE DATE IS PRESUMED VALID**

Respondent’s registered NERDIO mark carries the presumption of validity that it has the exclusive right to use the mark NERDIO in commerce on or in connection with the NERDIO Services as specified in the certificate. *See* 15 U.S.C. § 1057(b). As a legal matter, Respondent may rely on the priority filing date of June 9, 2016 for the Subject Application as its constructive use date. *See Compagnie Gervais Danone v. Precision Formulations, LLC*, 89 USPQ2d 1251, 1253 (TTAB 2009) (“A party that has filed an intent-to-use application may rely on the filing date of its application to establish priority.”)

To cancel Respondent’s registration, Petitioner must “show proprietary rights in [its] mark that produce a likelihood of confusion.” *JNF LLC v. Harwood Int’l Inc.*, 2022 USPQ2d 862, at \*3 (TTAB 2022). This Cancellation action must fail because Petitioner cannot make either of its

required showings—Petitioner fails to establish both (i) proprietary rights in its alleged mark prior to June 9, 2016 and (ii) a likelihood of confusion between its alleged mark and Respondent’s NERDIO mark. *See Herbko Int’l, Inc. v. Kappa Books, Inc.*, 64 USPQ2d 1375, 1378, 308 F.3d 1156, 1162 (Fed. Cir. 2002). For that reason, the Board must find for Respondent.

**B. PETITIONER HAS NO EVIDENCE OF PRIORITY OF RIGHTS THAT IS EARLIER THAN RESPONDENT’S CONSTRUCTIVE USE DATE.**

It is without question that to prevail in its Cancellation Petitioner must show priority of use in interstate commerce before the date of Respondent’s constructive use, which is June 9, 2016. *See, e.g., Orange Bang, Inc. v. Olé Mexican Foods, Inc.*, 116 USPQ2d 1102, 1115 (TTAB 2015). With respect to prior use, there must be “use in commerce,” which means “the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark.” 15 U.S.C. § 1127. Petitioner’s self-serving claim that June 1, 2016 was its date of first use must be considered with skepticism, as Petitioner was well-aware of Respondent and its constructive use date prior to filing the ‘739 Application. (63 TTABVUE 4, Vladimirskiy Tr. 39:12-40:21; 66 TTABVUE 3, Chow Decl. ¶ 7-8). And as described in Section IV.B., *supra*, Petitioner has a history of inaccuracies in its documents<sup>5</sup>. Although Petitioner argues that it started using its alleged mark on June 1, 2016, it has

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<sup>5</sup> Respondent respectfully notes that Petitioner’s proof of first use should be clear and convincing for the same reason that a party who seeks to show an earlier date of use than that claimed in an application must have clear and convincing evidence of the newly alleged date: enhanced substantiation is required in circumstances that give rise to doubt as to the legitimacy of the claimed date of first use. *Hydro-Dynamics, Inc. v. George Putnam & Co., Inc.*, 811 F.2d 1470, 1473, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987). Here, when Petitioner filed its ‘739 Application it was already well-aware of the exact date that Petitioner must establish to win priority over Respondent. Counsel for Petitioner filed the application and sent a demand letter to Respondent asserting the earlier-claimed rights.

Despite knowing that it would have to prove priority, Petitioner apparently made no effort to preserve evidence of use that would clearly establish the alleged priority date. Respondent submits that this failure is not because of poor record-keeping over the years, but because such evidence never existed – while Petitioner may have been preparing to begin technical trademark use of its mark during the period from June 1, 2016 to June 9, 2016, it had not yet actually done so.

minimal, if any, documentary evidence to corroborate these claims and so cannot establish priority in the face of so much contradictory evidence.

**1. *Petitioner Has Not Shown the Requisite Use in Commerce to Prove Priority.***

There was no technical trademark use of the mark “Nerdio” by the Petitioner prior to June 9, 2016. Technical trademark use in commerce requires that the mark be displayed in the sale or advertising of the services, and that the services are actually rendered in commerce. *Couture v. Playdom, Inc.*, 778 F.3d 1379, 1380, 113 USPQ2d 2042 (Fed. Cir. 2015). Petitioner relies on five actions to allege priority of use before Respondent’s constructive use date—(i) “launch” of the “NERDIO Website,” (ii) a blog post and social media posts about the name change, (iii) “free trials,” (iv) “rendering the NERDIO Services to its existing clients,” and (v) “emails to all existing customers.” (73 TTABVUE 29-31). Upon inspection, none of these actions qualify as technical trademark use.

Launch of a website is not trademark use. *See Couture*, 778 F.3d at 1382 (Board holding that applicant “had not rendered his services as of the filing date of his application” because he had “merely posted a website advertising his readiness, willingness and ability to render said services”). Similarly, social media posts, blog posts, and even LinkedIn posts are not trademark use. *In re Alessandra Suuberg*, 2021 USPQ2d 1209 (TTAB 2021) (“we have held that mere preparation and publication of future plans do not constitute use in commerce.”). This shows that the first two of five actions are not sufficient to establish priority.

With respect to the “free trials,” in order for beta testing to be a sufficient basis for priority, that testing must reach a sizable proportion of the relevant public, and the testing cohort must constitute more than a small, hand-picked group. *Nexsan Tech., Inc. v. EMC Corp.*, 260 F. Supp. 3d 68, 76 (D. Mass. 2017). The evidence of Petitioner’s trials does not meet this threshold. Petitioner points to trials conducted by Radialpoint, a vendor of Petitioner, and internally by its CEO,

Vladimirskiy. (49 TTABVUE (confidential), Vladimirskiy Decl. Exhibit 7). Neither of the early trials were public.

Even if the trials were public, there is no evidence that they were conducted prior to Respondent's constructive use date. The first trial, scheduled by [REDACTED] on June 2, 2016, was originally set to start testing on June 16, 2016. A second trial was scheduled on June 10, 2016 to start testing on June 24, 2016, as discussed in an email to [REDACTED]. Both trials were later "cancelled." The first trial ultimately was not created until July 22, 2016 and completed on August 1, 2016. The fact that Petitioner's trial runs were not finalized until over a month after Respondent's constructive use date furthers the inference that Petitioner could not have been rendering services under the NERDIO mark during the eight days before the constructive use date. *See Ayock Eng'g, Inc. v. Airflite, Inc.*, 560 F.3d 1350, 1360 (Fed.Cir. 2009) ("An applicant's preparations to use a mark in commerce are insufficient to constitute use in commerce. Rather, the mark must be actually used in conjunction with the services described in the application for the mark."); *see also Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1054 (TTAB 2017) (finding that activities that are vague, equivocal, and mostly undated was preliminary and exploratory were not yet ready to introduce the product in the ordinary course of trade). This shows that the third action is not trademark use.

The fourth action, "rendering services to existing clients," is not supported by credible evidence. Petitioner claims that one day its clients used Adar-branded services and the next they used Nerdio-branded services. But record evidence suggests that the change to Nerdio was more than just a change of name. For example, Petitioner's blog post said "Welcome to Nerdio" and then identified Nerdio as an **entirely new concept in IT services**. This suggests the new services would offer something different and exciting, not identical to those of the day before. And internal emails clearly stated that the new branding applied to "new customers only." (48 TTABVUE 29 Exhibit 8). Similarly, the

need to conduct testing of software is also indicative of something new and different. The evidence described here and in Section IV.B.3, *supra*, undermines Petitioner's claim that it was actually rendering services by June 9, 2016.


Petitioner's lack of sales evidence in dollars or actual invoices during the priority period further points toward a finding that its services were not yet in the ordinary course of trade. *Cf. Research in Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1932 (TTAB 2009) (lack of documentation contributes to finding lack of bona fide intent to use a mark). And, as already discussed in Section IV.B.3., *supra*, many of Petitioner's internal emails revealed language that indicated the Nerdio services were new and distinct from Adar's prior services. The implication of a new service offering is that there were no prior existing customers who allegedly went to sleep as an Adar customer on May 31, 2016 and woke up as a Nerdio customer on June 1, 2016, refusing the claim of action five. The Nerdio customer base, being new, had to be built from scratch, which would take time.

Indeed, that is what appears to have happened. When asked to identify its "first United States customer" for each of its claimed services, Petitioner provided just one name in response to the interrogatory: [REDACTED] (70 TTABVUE Exhibit FF, Interrogatory No. 6 (confidential)).

[REDACTED]

Petitioner's first evidence of sales to [REDACTED] was not after Respondant's constructive use date, as evidenced in Petitioner's earliest service order to [REDACTED], signed August 12, 2016. (70 TTABVUE Exhibit TT (confidential)):





This is echoed by the numerous internal emails which show Petitioner’s preparations to render services, such as by putting together a sales team, figuring out marketing materials, and tying up loose ends relating to the launch, as set forth in Section IV.B.3., *supra*.

Petitioner’s use likely starting after June 9, 2016 is also supported by a trade publication, the *Redmond Channel Partner*. On May 29, 2018, it published the following statement: “A year after launching . . . Nerdio is taking its vision. . . to another level.” (67 TTABVUE 35, Exhibit BB). One year prior to the publication date of that article would have been May 2017, nearly a full year after Petitioner’s alleged date of first use. This unbiased, third-party, contemporaneous evidence casts further doubt on Petitioner’s claimed 2016 date of use.

**2. *Petitioner’s Alleged Sales After Respondent’s Earlier Constructive Use Are of No Evidentiary Importance on Petitioner’s Asserted Claim of Priority.***

Petitioner’s only documentary evidence of sales of *any* service rendered in commerce are limited to 2020, well after Respondent’s constructive use date. (63 TTABVUE 95, Vladimirskiy Tr. 94:16-17, 63 TTABVUE 180-184, Exhibit B14 (confidential)). These seem to be for a more limited set of services than the ‘739 Application and are limited to the Petitioner’s more current role as a support service for third party Microsoft Azure. (73 TTABVUE 23-24; Chow Decl. ¶ 22). The submission of Petitioner’s 2020 sales information is intended to suggest only that, despite Respondent’s earlier constructive use date, Petitioner had on some date thereafter developed a business under the identical mark to which Respondent has superior rights.

Interestingly, such sales data starting in 2020 correlates with Petitioner’s public relations campaign starting after 2020. (See 67 TTABVUE 19-28, Exhibit Z; 67 TTABVUE 29-33, Exhibit AA; 67 TTABVUE 34-38, Exhibit BB; 67 TTABVUE 39-43, Exhibit CC; 67 TTABVUE 44-52, Exhibit DD; 67 TTABVUE 55-64, Exhibit EE (“Today we help organizations of every size and vertical be successful and save money running virtual desktops in Microsoft Azure.”)). This 2020 campaign shows that Petitioner started using “Nerdio” in 2020 strictly in connection with Microsoft Azure support services, which are different from the services Petitioner alleges to have been providing in 2016. However, any later use, especially of evolving types of services, simply does not provide Petitioner with better rights than Respondent. Petitioner’s theory actually flies in the face of the Lanham Act, which clearly provides priority constructive use to Respondent, whose application is earlier than any use proven by Petitioner.

**3. *Petitioner Cannot Argue an Unpleaded Claim of Analogous Trademark Use.***

Extraordinarily, Petitioner again attempts to argue analogous use by inference, even though during denial of summary judgment the Board instructed Petitioner not to allege analogous use because it was not pleaded. (31 TTABVUE 3 (citing *Cent. Garden & Pet Co. v. Dorskocil Mfg. Co.*, 108 USPQ 1134, 1142 (TTAB 2013)). The parties have expressly not tried analogous use, and Respondent has expressly not consented to this unpleaded claim.

The Petition for Cancellation only alleges that Petitioner made valid trademark use on the list of services contained in its pending ‘739 Application before the filing date of Respondent’s intent to use application. (15 TTABVUE 11) (“Registrant’s own USPTO records for the ‘453 Registration and correspondence show that it did not use NERDIO with respect to the registered services in commerce in the U.S. before Petitioner.”); (1 TTABVUE ¶ 2) (“Petitioner filed the NERDIO application on June 21, 2016, and first used the NERDIO mark in commerce on June 1, 2016.”); *see also* (*id.* ¶ 4) (“As a result of Petitioner’s continuous and exclusive use of the NERDIO mark in United States commerce for over four years...”); (*id.* ¶ 11) (“Petitioner has priority. Petitioner first used the

NERDIO mark in commerce as early as June 1, 2016, giving Petitioner priority and trademark rights at least of this date.”).

For argument’s sake, a claim of analogous use was likely not pleaded because there is no support for it. For example, there is no evidence that Petitioner created widely circulated advertising for the then-yet-to-be-rendered services under a “Nerdio” mark. Even if it had been properly pleaded, nothing in the record could support a showing that there was an earlier association in the minds of the purchasing public between the mark and the petitioner’s goods to support such non-technical use. *See T.A.B. Sys. v. Pactel Teletrac*, 77 F.3d 1372, 1377, 37 USPQ 2d 1879, 1883 (Fed. Cir. 1996).

**C. PETITIONER’S INCONSISTENT EVIDENCE IS INADEQUATE TO SUPPORT ITS PRIORITY CLAIM.**

Petitioner’s evidentiary record is rife with contradictory statements and a number of unsupported and conflicting documents, as detailed in Section IV.B, *supra*. Such internal conflict within Petitioner’s record makes its testimony unreliable, particularly considering that this testimony is self-serving and offered without corroborating, authenticated documentation. *See Cent. Garden & Pet Co. v. Doskocil Mfg. Co.*, 108 USPQ2d 1134, 1145 (TTAB 2013) (“While a party may establish priority by oral testimony alone, testimony which is uncertain or inconsistent is insufficient”); *H. Betti Indus., Inc. v. Brunswick Corp.*, 211 USPQ 1188, 1197 (TTAB 1981) (vague, indefinite and inconsistent testimony accompanied by inadequate documentary evidence insufficient to support priority claim); *Mars Generation, Inc. v. Carson*, 2021 USPQ2d 1057, at \*20 (TTAB 2021) (probative value of testimony also is significantly undermined by witness’ utter lack of detail).

This entire case essentially rests on the testimony of Vladimirskiy, the CEO of both Petitioner and its predecessor, Adar, Inc. Vladimirskiy makes conflicting and unsubstantiated statements of use and recants much of his trial testimony and prior sworn statements on cross-examination. In other matters where evidence is unreliable, the Board has discounted the probative value of such evidence. *See Rapid Inc. v. Hungry Marketplace, Inc.*, 2022 USPQ2d 678 (TTAB

2022) (likelihood of confusion claim dismissed because priority of use not established due in part to inconsistencies in record and fabrication of evidence). The following subsections further detail Petitioner's inconsistencies and raise serious doubts regarding its claimed priority date.

**1. *The Record Shows Vladimirskiy is an Unreliable Witness***

Vladimirskiy has repeatedly demonstrated not only that he is an unreliable witness, but that he is willing to make any statement necessary to support a position. There are multiple instances where he offers testimony in conflict with his prior sworn declaration or other evidence produced by Petitioner. *See* Section IV.B., *supra*. For example, the Petitioner claims to “own” the underlying ‘739 Application that forms the basis of its Cancellation petition, having allegedly received an assignment of the application through a chain of title, initially filed by Adar, Inc. on December 31, 2017 to Adar Holdings, Inc. and then on the same date, from Adar Holdings, Inc. to the Petitioner. *See* Section IV.B.4., *supra*. Yet, two years later, in security interest documents with two different financial institutions in 2019, Adar, Inc. claimed all of the “right, title and interest” in and to the very same underlying trademark application, with all appurtenant rights – including rights to sue, control over product, and to prosecute the trademark application. *See id.* When asked how Adar, Inc. a separate company could pledge the ‘739 Application to financial institutions, and make the representations made under the security agreements filed with the USPTO, Vladimirskiy simply stated he did not know. *Id.*

Vladimirskiy signed a trial testimony declaration that he admitted was written by his attorney, and signed it under oath, even though he knew or should have known that statements made therein were inaccurate. (63 TTABVUE 15-16, Vladimirskiy Transcript. 14:8-15:20) (Q: “Did your draft the statements within the document?” A: “No.” Q: “Okay. Who drafted the statements in the document?” A: “My attorneys”).

There is also a question of how Petitioner “used” the mark in commerce. Vladimirskiy concedes that on the claimed date of first use, he considers social media and online announcements to

count as public use. (63 TTABVUE 30, Vladimirskiy Tr. 29:12). However, advertising without a sale of goods or rendering of services does not qualify as a use in commerce. *Aycock Engineering v. Airflite Inc.*, 560 F.3d 1350, 1360 (Fed. Cir. 2009) .

In Petitioner’s trial declaration, Mr. Vladimirskiy further states under oath that the mark “Nerdio” is used on all of the services covered by Petitioner’s ‘739 Application, when that is not the case. Section IV.B.2., *supra*. Vladimirskiy concedes on cross examination that the services currently offered are actually a much smaller subset. *Id.*

Not only are there no records of use or priority, but there is no record of continuing use at all – the only financial document in evidence is a 2020 profit and loss statement. (49 TTABVUE 19, Exhibit 14 to Vladimirskiy Declaration (confidential)). Tellingly, there are no documents from any customers or third parties who could attest to any use by the Petitioner.

Petitioner does not dispute that the only services offered by Petitioner are really “helpdesk” services that support a third-party provider Microsoft Azure, services which arose are much later than its June 21, 2016 application. (73 TTABVUE 16-17).

Vladimirskiy alternatively implies that “Nerdio” was a replacement name for an existing service (48 TTABVUE 3, Vladimirskiy Decl. ¶ 8) but also a completely new service that needed to be trialed through beta testing. (67 TTABVUE; 63 TTABVUE 79, Vladimirskiy Tr. 78:17).

Petitioner claims that the trial tests were earlier than Respondent’s Constructive Use Date, however upon inspection the supporting documents attached to Vladimirskiy reveal the beta tests to be later.

Vladimirskiy admits he does not know if any of the documents attached to his trial testimony declaration are business records, despite his own statement to the contrary. He cannot explain any of the documents that are attached to his trial testimony declaration, despite his statement of knowledge. The conflicting and unreliable statements of Petitioner through Vladimirskiy simply cannot support cancellation of Respondent’s registration.

**2. *The Unreliable Testimony of a Single Witness Is Insufficient as Proof of Priority.***

Petitioner relies on testimony of only two witnesses. A single witness's testimony may be sufficient to establish rights earlier than a registered trademark—when the testimony is “clear, convincing, consistent, uncontradicted, and sufficiently circumstantial to convince the Board of its probative value.” *See Bass Pro Trademarks, LLC v. Sportsman’s Warehouse, Inc.*, 89 USPQ2d 1844, 1856 (TTAB 2008). Petitioner’s testimony is none of those things.

Elizabeth Hoscheid’s testimony is limited to authenticating emails that purport to suggest that Adar’s LinkedIn account was using the alleged mark as of June 7, 2016 – a fact which, even if true, does not show use of the mark in commerce. (51 TTABVUE). Moreover, Ms. Hoscheid’s testimony is hearsay and lacks foundation.

Petitioner’s other witness, Vladimirskiy, is completely unreliable, self-interested, and biased. The unreliable testimony of one (or even two) witnesses is insufficient proof of priority or use. *See, e.g., Glow Concept Inc. v. Too Faced Cosmetics, LLC*, Cancellation No. 92067143, at \*23 (TTAB Nov. 2, 2020) [Not Precedential] (finding priority not established after testimony of a witness was “not particularly clear,” and the corroborating testimony of a second witness was unilluminating as to the manner in which petitioner used the asserted mark as a trademark on or in connection with the claimed goods prior to the constructive use date). The testimony of “a single witness, [which] is both vague on critical points and riddled with inconsistencies,” is not persuasive evidence for the Board. *See Vans, Inc. v. Branded, LLC*, Cancellation No. 92066876, at \*49 [Not Precedential] (TTAB Aug. 11, 2022). Because of the many inconsistencies between Vladimirskiy’s testimony and his admissions upon cross-examination described herein, purported evidence of priority from Vladimirskiy should not be deemed credible. With no credible witnesses and a limited record, Petitioner cannot meet its burden of proof.

**D. THE *DUPONT* FACTORS WEIGH IN FAVOR OF RESPONDENT.**

Even though there is no evidence of Petitioner’s earlier rights, Respondent will also evaluate the relevant factors of *In re E.I. DuPont DeNemours & Co.*, 476 F2d 1357, 177 USPQ 563 (CCPA 1973) for the Board. *See Exec. Coach Builders Inc, v. SPV Coach Company, Inc.*, 123 USPQ2d 1175, 1199 (TTAB 2017) (if a petitioner relying on prior use does not establish a date of priority before respondent’s priority date, likelihood of confusion need not be addressed because, without proof of its priority, the petitioner cannot prevail). In its Trial Brief, Petitioner argues that the first eight factors are relevant for the likelihood-of-confusion analysis and weigh in its favor. (73 TTABVUE 34). However, other than factors one (the identity of the marks) and six (the lack of other “nerdio” formative marks on the registry), the remaining six factors do not weigh in favor of Petitioner. As explained below, Petitioner’s evidence fails to establish that there is a likelihood of confusion between the two marks.

**1. *DuPont Factor 2: Petitioner Has Not Presented Any Evidence That the Parties’ Respective Services Are Highly Related.***

The second *DuPont* factor looks at the similarity and nature of the parties’ services. *See DuPont*, 177 USPQ at 567. Petitioner failed to enter specific evidence connecting the Parties’ services and instead relies on a high-level overview that the parties’ services both relate to “general computer and IT-related services, consulting and management of cloud-based computing services, computer technology design and implementation, IT consulting, and computer technology support services.” (73 TTABVUE 36). This is not enough. *See Embarcadero Techs., Inc. v. Rstudio, Inc.*, 105 USPQ2d 1825, 1837 (TTAB 2013) (“[G]iven that computer software is employed in nearly all industries and facets of life, the fact that both parties’ goods are computer software is not sufficient, in and of itself, to establish a relationship between the goods.”); *M2 Software, Inc. v. M2 Communications, Inc.*, 450 F.3d 1378, 1383, 78 USPQ2d 1944, 1948 (Fed. Cir. 2006) (“Moreover, given the pervasiveness of software and software-related goods in society, it would be inappropriate

to presume relatedness on the mere basis of goods being delivered in the same media format. . . .”); *Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460, 1463 (TTAB 1992) (“All computer software programs process data, but it does not necessarily follow that all computer programs are related. Given the ubiquitous use of computers in all aspects of business in the United States today, this Board and its reviewing Court have rejected the view that a relationship exists between goods and services simply because each involves the use of computers.”).

The relevant comparison is between the services recited in Respondent’s registration and the services Petitioner actually offers. Here, Petitioner admits to offering a few of the services from its application and as to even those services, has no supporting evidence to show the rendering of those services. As explained in the Chow Testimonial Declaration, Petitioner’s actual services are:

“more limited than what is described in the [‘739 Application]. For instance, it appears that the Petitioner currently is a third-party software re-seller, consultant, and integrator for Microsoft Azure products. The entirety of the Petitioner’s website is directed to its support for Microsoft Azure services, such as Azure Virtual Desktop (AVD). For the Petitioner’s customers, Azure has become the cloud for the managed IT infrastructure, and not the Petitioner’s private cloud anymore. Yet the language of the service description in Petitioner’s trademark application includes private network and private cloud computing IT and application systems, rather than essentially serving as a value-added re-seller of a third-party managed IT infrastructure.”

66 TTABVUE 8-9, Chow Decl. ¶22 (internal citation omitted). Chow’s characterization is not disputed. Accordingly, it is clear that Petitioner’s services are limited to nothing more than third-party support for Microsoft Azure products. *See* 66 TTABVUE ¶¶ 22-23. Tellingly, evidence Petitioner cites in its Trial Brief for other reasons is indicative of the differences between the Parties’ services. (*See* 73 TTABVUE 24-25.) The distinctions between Respondent’s services and Petitioner’s were highlighted when Petitioner’s counsel questioned Chow about Respondent’s service offerings. This questioning by Petitioner highlights that the Parties’ respective services do not overlap at all:



Q. 66. Does NerdIO Limited offer virtual workstation implementation services in the United States?

A. No.

Q. 67. Does NerdIO Limited offer Azure services in the United States?

A. No.

Q. 68. Does NerdIO Limited offer MSP Channel Partners services in the United States?

A. No.

Q. 71. Has any representative of NerdIO Limited attended an ID Agent show in Orlando, Florida?

A. No.

Q. 72. Does NerdIO Limited offer WVD implementation services in the United States?

A. No.

*Id.*

Petitioner presented no evidence to support its argument that the relevant services are sufficiently similar that confusion is likely. Thus, Petitioner has not met its burden on this factor.

**2. *DuPont Factors 3 and 4: There Is No Record Evidence To Show Overlap of Trading Channels, Purchasing Conditions, or Consumers.***

Petitioner has not met its burden of proving that the channels of trade, purchasing conditions, or consumers have any overlap.

It is unclear how Petitioner offers any of its services. This is not an action based on Petitioner's registration, for which it hypothetically would be presumed to have valid use and to offer its services through all normal channels, without restriction. TBMP § 1207.01(a)(iii). To the contrary, Petitioner is required to prove use and – because its rights are merely common-law—to also prove its channels of trade and purchasing conditions. *See Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017) (no presumptions attach to unregistered common

law mark). Petitioner submitted absolutely no evidence on its trading channels, so the breadth of any alleged channels may not be presumed. *Id.* Petitioner argues that the parties' trade channels are "identical" because its services are offered via the "internet." (73 TTABVUE 37). But without evidence, Petitioner cannot show whether its channel of trade is the internet, cold calls, or perhaps through networking personal relationships. Indeed, when asked by interrogatory to identify "all sales channels," Petitioner's response did not indicate that it uses the internet. Its full answer is shown below:

[REDACTED]

(67 TTABVUE 76, Exhibit FF, Interrogatory No. 7; *See also* 70 TTABVUE Exhibit LL

(confidential)). [REDACTED]

[REDACTED].

Even if Petitioner had submitted the requisite evidence showing the internet as its channel of trade, that is insufficient to weigh in favor of a likelihood of confusion between the marks. It is well settled that common use of the internet is not probative as to likelihood of confusion. *See Network Automation, Inc. v. Advanced Sys. Concepts, Inc.*, 638 F.3d 1137, 1151 (9th Cir. 2011) ("Today, it would be the rare commercial retailer that did not advertise online, and the shared use of a ubiquitous marketing channel does not shed much light on the likelihood of consumer confusion."). Without more to show the overlap "the mere fact that goods and services may both be advertised and offered through the Internet is not a sufficient basis to find that they are sold through the same channels of trade. The Internet is such a pervasive medium that virtually everything is advertised and sold through the Internet." *Parfums de Couer Ltd. v. Lazarus*, 83 USPQ2d 1012, 1021 (TTAB 2007). The Petitioner presented no evidence that the Parties' services are offered through the same online sources, nor does Petitioner argue that the services are offered through the same online sources;

Petitioner’s Trial Brief instead claims that “both parties advertise their services on their websites.” On similar facts, with parties each offering their products through their separate websites, the Board found trade channels to be dissimilar. *In re IAC Search & Media, Inc.*, No. 92060041, at \*16 (TTAB Aug. 31, 2018) [Not Precedential]; *In Re Spiritual Warrior Inc.*, No. 88459695, at \*12 (TTAB Apr. 21, 2021) [Not Precedential] (“Although the goods and services and services appear on the Internet, the third parties post the goods and services on distinct websites and, thus, the evidence is not sufficient to establish an overlap in the channels of trade.”). Similarly here, there is no record evidence that Petitioner and Respondent offer services in the same channel of trade because the services are offered on distinct websites.

Further illustrative of the fact that there is no likelihood of confusion is that these services are highly technical and would only be purchased by consumers after careful selection. *See In re GENBAND Inc.*, Serial No. 77627106, at \*5 (TTAB March 30, 2011) [not precedential] (the Board agreed that as to the conditions of purchase of software the goods “have a considerable cost and [purchasers] would not be made without deliberation and input from technical personnel”); *Embarcadero Techs.*, 105 USPQ2d at 1842 (“That is not to say that there is no possibility of any overlap between the two classes of consumers. However, as seen under the fourth *du Pont* factor, any overlap between the two will involve sophisticated users in both professions.”). In Chow’s unobjected-to declaration, he highlighted the different means of sales between the Parties. Respondent’s services are bespoke software product development, including but not limited to for virtual patent marking, as well as quality improvements on existing software. (66 TTABVUE 3-4, Chow Decl. ¶¶ 2-3). Respondent also provides services and technology for cloud-based patent marking and related protection of intellectual property associated therewith. (66 TTABVUE 4, Chow Decl. ¶ 3). These services are personal to an individual customer and accordingly payment for such services are specific to the particular services rendered. (66 TTABVUE 4-5, Chow Decl. ¶ 9). Petitioner’s model is completely different, as support for a third-party enterprise platform is priced on

a monthly subscription basis, priced for the number of users who have access to these subscription support services. (66 TTABVUE 4-5, Chow Decl. ¶ 9).

Because there is no overlap in channels of trade and the purchasing conditions are distinct, *duPont* factors 3 and 4 weigh against a likelihood of confusion.

**3. *DuPont Factor 5: Petitioner's Mark is Not "Famous."***

Despite Petitioner's argument that it is "famous to the relevant consuming public," (73 TTABVUE 39), Petitioner has not put forth any evidence that its actions have made "Nerdio" a famous mark. Because of the extreme deference that the Board accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of Petitioner to "clearly prove" its mark is famous. *See Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1438 (TTAB 2014). Petitioner has not met this burden.

There are no surveys, testimonials, or other indicia of fame. There is no contextualization of the numbers presented by Petitioner in order to determine fame for these purposes. *See, e.g. The North Face Apparel Corp. v. Sanyang Indus. Co., Ltd.*, 116 USPQ2d 1217, 1225 (TTAB 2015) (refusing to find opposer's mark famous in spite of "millions of dollars" of annual sales because opposer failed to provide "any context for these figures"). There is absolutely no testimony at all about the Petitioner's market, its consumers, and market share or a comparison to other brands, which means there is no basis on which to find Petitioner's mark "famous." *See id.; see also Carl Karcher Enterprises, Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125 (T.T.A.B. 1995) (refusing to find mark famous in spite of evidence of forty-five years' of use and annual sales of over \$614 million and annual advertising expenditures of \$39.2 million).

**4. DuPont Factors 7 and 8: Petitioner's Purported Evidence of Confusion is Extremely Minimal.**

On April 21, 2021, Petitioner responded to Interrogatory 18 to “[i]dentify all documents and state with specificity all facts with respect to any instance where a person or entity has been confused, mistaken, and/or deceived as to whether any services advertised or sold under Registrant’s Mark were those of Registrant, and for each such instance provide the date of such instance, the identity of the person or entity, and a detailed description of the circumstances of such confusion, mistake, and/or deception.” 67 TTABVUE 76, Exhibit FF, Interrogatory No. 18. Petitioner unequivocally stated:

Petitioner is not aware of any instances of actual confusion between Petitioner’s Mark and Registrant’s Mark.

(67 TTABVUE 76, Exhibit FF, Interrogatory No. 18.).

Now, in its Trial Brief, Petitioner purports to show confusion based on a handful of misdirected emails from third parties looking for technical support for their Microsoft Azure products. (73 TTABVUE 23-24). These misdirected emails occurred in 2020 and there have been no further accidental communications despite more than three years’ of coexistence. The limited timeframe of the misdirected emails and by only a few individuals shows that “a significant portion of the general public is not likely to be confused.” *See Kendall-Jackson Winery, Ltd. v. E. & J. Gallo Winery*, 150 F.3d 1042, 1052 (9th Cir. 1998). To the extent that the emails are similar to internet comments, these do not support a finding of confusion as to product or source. *See Uber Promotions, Inc. v. Uber Technologies, Inc.*, 162 F. Supp. 3d 1253, 1272 (N.D. Fl. 2016). At most, such comments may only suggest that the internet user “appears to be someone so easily confused that even trademark law cannot protect her.” *Id.*

This evidence is not persuasive given the low quantity, and quality, of misdirected internet emails compared to Petitioner’s level of sales volume. *See Scott Paper Co. v. Scott’s Liquid Gold*,

*Inc.*, 589 F.2d 1225, 1231 (3rd Cir. 1978). Here, Petitioner has alleged only [REDACTED] [REDACTED] (73 TTABVUE 16). In *Scott Paper*, [REDACTED]—and determined this was “extremely minimal evidence” of actual confusion. *Scott Paper*, 589 F.2d at 1231. Applying the logic of *Scott Paper*, Petitioner’s evidence is similarly “extremely minimal” and therefore insufficient to create a likelihood of confusion.

Notably, Respondent’s use of its URL, [www.nerdio.com](http://www.nerdio.com), must be considered separately from its use of the NERDIO mark. This is a rare circumstance where evidence of confusion with a URL is not evidence of marketplace confusion in use of the Parties’ respective marks. For example, DELTA airlines and DELTA faucets are permitted to coexist, but the former owns [www.delta.com](http://www.delta.com) while the latter owns [www.deltafaucet.com](http://www.deltafaucet.com). The misdirected emails are nothing more than confusion with a domain name. Petitioner unsuccessfully attempted to purchase Respondent’s domain in May 2016 and is now using this action apparently to badger Respondent into giving up the domain. However, Respondent has owned its URL in good faith since 1999 and its rights to the URL will be unaffected by the outcome of this proceeding. Petitioner’s issue is and always has been with Respondent’s use of the domain, not with Respondent’s use of the mark.

## VI. CONCLUSION

For the foregoing reasons, Respondent respectfully urges the Board to dismiss this proceeding with prejudice.

Dated: October 23, 2023

Respectfully submitted,  
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**CERTIFICATE OF SERVICE**

I, Jacqueline M. Lesser, hereby certify that on October 23, 2023, a true and correct copy of the foregoing RESPONDENT'S TRIAL BRIEF was served by e-mail upon Counsel for Petitioner at:

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