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Filing date: **09/17/2024**

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

Proceeding no.	92085789
Party	Defendant Virtual X, Inc.
Correspondence address	VIRTUAL X, INC. 154 129TH AVE W MADEIRA BEACH, FL 33708 UNITED STATES Primary email: danyelle.paul@gmail.com 727-420-6707
Submission	Answer and Counterclaim
Filer's name	Danyelle Paul
Filer's email	danyelle.paul@gmail.com
Signature	/Danyelle Paul/
Date	09/17/2024
Attachments	VX Cancellation 92085789 Counterclaim.pdf(1421388 bytes)

Registration subject to the submission

Registration no.	3184599	Registration date	12/12/2006
Register	Principal		
Registrant	INNOVATION FIRST, INC. 6725 W. FM 1570 GREENVILLE, TX 75402 UNITED STATES		

Goods/services subject to the submission

Class 041. First Use: Aug 31, 2005 First Use In Commerce: Aug 31, 2005
All goods and services in the class are requested, namely: On-line educational services in the field of robots, namely, web-based training; on-line educational services, namely, arranging and conducting live seminars, online-workshops and virtual classes, all in the field of robotics [; entertainment services, namely, production and syndication of television shows; electronic publishing services, namely, publication of text and graphic works of others on CD, CD-ROM and DVD featuring information in the field of robotics; online publication of books and magazines; and] entertainment services, namely, organizing exhibitions, competitions and conducting contests and games, all in the field of robots

Grounds for cancellation

The mark is or has become generic	Trademark Act Section 14(3)

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

In the Matter of Registration No: 6856893-VX

Cancellation# 92085789

INNOVATION FIRST- INC.	*	
Petitioner	*	**RESPONDENT'S ANSWER,**
v.	*	**AFFIRMATIVE DEFENSE, MOTIONS,**
	*	**AND COUNTERCLAIM**
VIRTUAL X INC.	*	
RESPONDENT	*	

****

Respondent Virtual X Inc., through pro se, respectfully submits Answers, Affirmative Defenses, Motions, and Counterclaim in respnse to Petitioner's Cancellation, In support, Respondent may show this Board or Court as follows:

ANSWER

1. Paragraph one of the Petitioner Cancellation

Answer: Denied Unaware Petitioner Exists

2. Paragraph two of the Petitioner Cancellation

Answer: Denied Unaware Petitioner Exists

3. Paragraph three of the Petitioner Cancellation

Answer: Denied Unaware Petitioner Exists

4. Paragraph four of the Petitioner Cancellation

Answer: Denied Unaware Petitioner Exists

5. Paragraph five of the Petitioner Cancellation

Answer: Denied Unaware Petitioner Exists

6. Paragraph Six of the Petitioner Cancellation

Answer: Admitted

7. Paragraph Seven of the Petitioner Cancellation

Answer: Denied

8. Paragraph Eight of the Petitioner Cancellation

Answer: Admitted

9. Paragraph Nine of the Petitioner Cancellation

Answer: Denied

10. Paragraph Ten of the Petitioner Cancellation

Answer: Denied Unaware Petitioner Exists

WHEREFORE, Respondent impose the following affirmative defense:

FIRST AFFRIMATIVE DEFENSE
(Trademark)

Respondent owns U.S. Serial number 90904002, Registration No. 6856893, trademark "VX" for the following services: "*Video Arcade Services*" in International Class 41 which is the appropriate class since September 27, 2022, a drawing along with description submitted on August 26, 2021, to United States Patent and Trademark Office, which there was no likelihood of any confusion to them to grant the trademark VX on September 27, 2022.

Respondent paid all fees, followed all of the procedures, regulations and rules to obtain a trademark/wordmark for her corporation design, logo, and wordmark. The Respondent is entitled to keep her wordmark and be able to move forward without any further delays. The Respondent has not experienced any confusion or mistakes for over six and half years (6 1/2), the only way the Respondent knew that this corporation existed is by their action of filing an

Opposition to Extension of Time during the process of obtaining its trademark.

SECOND AFFIRMATIVE DEFENSE
(Retaliation)

Respondent can show and prove Petitioner counsel and Respondent's former counsel conspired to have the Respondent to agree and sign VEX Co-Existence Agreement without consent, knowledge or in our best interest. Both counsel knows or should have known it shows bad faith to act in an improper manner which may be considered bullying, intimidation, manipulation, or retaliation.

Petitioner states it is a well-known pioneer and world leader in the field of educational robotics and STEM, which means a corporation who has a large financial portfolio, which would like to take a small female business trademark and logo or if they can't have it; then they will file this petition of cancellation with the United States Patent and Trademark Office to try to intimidate, or cause them financial hardship by fighting this petition to keep what is actually their property, trademark and business according to the United States Patent and Trademark Office, laws and regulations.

Petitioner filed a request for an extension, then it was withdrawn. Now, the Petitioner filed a request for cancellation because the Respondent has fired their attorney over fee dispute and failure to act in the best interest for his client. Both counsel made an agreement to have VX owner to agree to the VEX Co-Existing Agreement and because the Petitioner is a big corporation with deep financial means and can cause duress for the owner. Since the

Respondent fails to agree and sign VEX Co-Existing Agreement, the Petitioner filed a letter of cancellation against both trademarks and against same respondents without any merit.

WHEREFORE, Respondent interposes motion to dismiss as follows:

MOTION TO DISMISS
(FAILURE TO STATE A CLAIM)

Petitioner has no legal facts or grounds to bring this false petition to cancel, the allegations of the likelihood of confusion has no merit because the trademarks do not consist of any similarities, the descriptions are different, and the Respondent trademark does not include or limited to Robotics or STEM. There are no legal facts of any priority of use by the Petitioner, the Respondent online Virtual Reality Arcade is for entertainment, and it is on the Reality side of the entertainment and believes the Petitioner trying to move toward the Reality side, as they create "Coding" as service and wants their trademark and logo.

MOTION TO DISMISS
(Retaliation)

Respondent has submitted a copy of the VEX Co-Existing Agreement which shows the Petitioner agreement only benefits them and its language in the agreement shows unfair and deceptive practices, and bad faith so Respondent declines to agree and sign.

In the agreement paragraph 11 states "the Petitioner shall not file any Opposition and/or further Extension of Time to Oppose the VX and design mark as long as the exclusion as enumerated herein are

included". Since there was no signed agreement, the Petitioner filed this petition of cancellation. **See Exhibit C**

MOTION FOR SANCTIONS
(RULE 11)

Respondent believes that the Petitioner and its counsel on record acting on behalf of the Petitioner actions, agreement, and the language used in the agreement, and misconduct shows intimidation, harassment, unfair and deceptive practices and warrants sanctions pursuing Rule 11, of the Federal Rule of Civil Procedures.

The opposing counsel knows or should have known that intimidation and retaliation is unjust and improper as rule of law, and there are consequences for any larger corporation to bully or manipulate any other corporation to dissolve their trademark or logo because of that large corporation wants a trademark and logo from this female corporation applied, complied with, paid the fees, hired an attorney and complied with all laws and regulations under the United States Patent and Trademark, that is not how the law works.

WHEREFORE, Respondent interposes a counterclaim as follows:

COUNTERCLAIM
(Facts)

I. Petitioner is a corporation located in the State of Texas, which their trademark VEX has used as early as March 2005, described as education, wherein they provide Robotic based educational and curriculum services and organize and conduct exhibitions, competitions, contents, events, and games for schooled aged children and educators.

Then later on down the line, Petitioner trademark VEX, in 2005 to include STEM, but still educational robotic services, which was granted and trademarked without any likelihood of confusion, mistakes even during 2021, when the Respondent filed its application to trademark VX or Virtual Reality Arcade, there was no likelihood of confusion, which granted and trademark in 2022.

II. Respondent is a female corporation located in the State of Florida, which has existed since 2018, described as virtual arcade services, and the category for Virtual Reality Entertainment purposes.

III. Both corporations are in the same class 41, which is appropriate for both corporations to be in, however, the Petitioner has not shown any sufficient legal facts, and this petition for cancellation has no grounds, and should be dismissed with prejudice. There are several other VX trademarks, and logos but the Petitioner has not filed any Opposition or Extension of Time to Oppose on all corporations or businesses including, but not limited to VX.

IV. Respondent believes and opposes this petition of cancellation and/or Extension for Time To Oppose is out of retaliation, and intimidation to damage our corporation and financial portfolios and the Respondent will go bankrupt or cancelled by United States Patent and Trademark Office or Board, which may allow the Petitioner to obtain the Respondent trademark and logo without any co-existing agreement or free and clear.

FIRST CLAIM FOR RELIEF
(RETALIATION)

V. Paragraphs I - IV are restated and realleged herein by reference.

VI. On July 24, 2024, Petitioner and the opposing counsel knew there was no factual or legal basis for this petition of cancellation, their Trademark VEX, do not have any likelihood of confusion, due to VEX will be considered a word, the Respondent's trademark VX will be considered two letters, not a word and it would not be mistaken as a word or have anything to do with Robotic or STEM or educational services.

VII. Respondent believes the Petitioner wants to venture into the reality online side of Class 41, and now, they see and want the Respondent's trademark and logo to be cancelled so they can either submit their trademark and logo, which may have been submitted already and denied by the United States Patent and Trademark Office due to the false allegations stated in this petition of cancellation, or they can used the Respondent's if they are cancelled by this Board.

SECOND CLAIM FOR RELIEF
(Unfair and Deceptive Practices)

VIII. Paragraphs I - VII are restated and realleged herein by reference.

IX. Petitioner's conduct as alleged was in commerce and affected commenced defined in Section 5(a) of the Federal Trade Commission Act, 15 U.S.C. $ 45, or anticompetitive conduct with the VEX Co-Existing Agreement

X. Petitioner's and its opposing counsel conduct as alleged violated Federal bans and prohibition on Unfair Method of Competition and unfair and deceptive act or practices as provided in Section 5(a) of the Federal Trade Commission Act

Third Claim for Relief
(Defamation, Slander, and Libel)

XI. Paragraphs I - X are restated and realleged herein by reference.

XII. Due to this false letter of cancellation filed on behalf of the Petitioner against the Respondent, it is a likelihood that the Respondent corporation may be suffering from Defamation, Slander and Libel. The United States Patent and Trademark agency has to provide public notice of the letter of cancellation against the Respondent's corporation, which may cause this corporation financial duress due to current or future contracts for services that the Respondent Corporation provides to their consumer or to the public.

WHEREFORE, Respondent prays for relief by the Board or Court as follows:

1. Requests for oral argument hearing
2. That Petition for Cancellation dismiss with prejudice in favor of Respondent
3. Respondent request for an order for imposed sanction under Rule 11, against Petitioner and opposing counsel under the First Claim for relief

4. Respondent requests an order for cease-and-desist injunction relief order against Petitioner and opposing counsel under Second Claim for Relief
5. Respondent request an order for treble punitive damages in the amount of $3,725,000 under Second Claim for Relief
6. Respondent requests an order taxing all or any cost and fees against Petitioner
7. Any other relief this Board or Court finds deem just and proper as rule of law

Respectfully submitted 23 day of August 2024

/Danyelle Paul,/
Virtual X Inc.
154 129th Ave W
Madeira Beach, Fl 33708
727-420-6707
Owner of Virtual X Inc.

VEX CO-EXISTENCE AGREEMENT

This Co-Existence Agreement ("Agreement") is made as of this ----- day of June 2023 ("Effective Date"), by and among Innovation First, Inc., a Texas corporation with offices at 6725 W. FM 1570, Greenville, Texas ("IFI") and Virtual X, Inc. DBA VX, a Florida corporation located at 154 129th Ave W Madeira Beach FLORIDA 33708 ("VXI").

NOW, THEREFORE, for good and valuable consideration, and the mutual exchange of promises and obligations contained herein, the receipt and sufficiency of which the parties acknowledge IFI, and VXI agree as follows:

WHEREAS IFI owns trademark rights in and to the following "VEX" United States Trademark Registrations. IFI also owns trademark rights in "VEX" variant trademark Registrations and Applications in the United States and owns foreign trademarks rights in "VEX" and "VEX" variant marks shown in attached **Exhibit A**. ("IFI VEX Marks")

Mark: **VEX**
Registration: 3,108,065
Goods: **IC 009:** Educational robotic kits comprising all of the following (1) robot construction building elements, programmable on-board electronic control, motors and sensors, remote controller, all for building motorized robots, (2) computer software and manual for designing and remotely controlling motorized robots (3) electronic computer interface for controlling motorized robots, and (4) electrical power transformer for motorized robots.

Mark: **VEX**
Registration: 3,184,599
Goods: **IC 041:** On-line educational services in the field of robots, namely, web-based training; on-line educational services, namely, arranging and conducting live seminars, online-workshops and virtual classes, all in the field of robotics; entertainment services, namely, organizing exhibitions, competitions and conducting contests and games, all in the field of robots.

Mark: **VEX**
Registration: 3,113,039
Goods: **IC 009:** Educational personal robots, each with a programmable microcontroller and sensor array for the detection and navigation of the surrounding environment, for educational, hobby or personal use; Educational computer programs for designing and remotely controlling motorized toys.

Mark: **VEX**
Registration: 3,172,264
Goods: **IC 016:** Educational instructional manuals for use in teaching engineering, math, science, technology, and means for building robots.

Mark: **VEX**

Exhibit C

Registration: 4,306,335
Goods: **IC 028:** Construction toys.

Mark: **VEX**
Registration: 4,867,088
Goods: **IC 035:** Online retail store services featuring consumer goods.

WHEREAS VXI is using and/or has applied for the following United States Trademark Registration VX VIRTUAL REALITY ARCADE and design and VXI is using and has registered the VX word mark (Collectively the "VX marks"). If the VX marks are referred to individually they will be known as the "VX word mark" and the "VX and design mark" the details of which are set out below:

Mark:  **VX VIRTUAL REALITY ARCADE** (Serial Number: 90/682,56)

Services: **IC 041:** Video arcade services.

Mark: VX (Registration Number 6,856,893)

Services: **IC 041:** Video arcade services.

WHEREAS IFI filed a Request for Extension of Time to File a Notice of Opposition with the Trademark Trial and Appeal Board of the United States Patent and Trademark Office (TTAB) against the VX composite mark.

To amicably resolve this matter, IFI and VXI agree as follows:

OBLIGATIONS:

1. VXI shall not use the VX and design mark or any similar variations thereof including VEX or any similar variations in the field of "*robotic kits and accessories*," "*educational and teaching robots*," "*educational and entertainment services in the field of robotics*" or "*robotic competitions of any kind*" or "*robotic toys, namely, toy robots, toy robot building kits, construction toys, and parts and accessories thereof.*"

2. VXI shall not register the VX and design mark or any similar variations thereof including VEX or any similar variations in the field of "*robotic kits and accessories*," "*educational and teaching robots*," "*educational and entertainment services in the field of robotics*," "*robotic competitions of any kind*", or "*robotic toys, namely, toy robots, toy robot building kits, construction toys, and parts and accessories thereof.*"

3. VXI shall only use the VX and design mark in the presentation shown in attached Exhibit B.

4. VXI shall never use and /or attempt to register the VX word mark or any similar variations thereof including VEX and any similar variations without the wording "VIRTUAL REALITY ARCADE" directly in front, behind, or adjacent to VX.

5. Within fifteen (15) days of the effective date, VXI shall voluntarily surrender their United States trademark registration for the VX word mark (Registration No. 6,856,893).

6. VXI will provide IFI's counsel with a copy of the PTO filing receipt for the voluntary surrender of the VX word mark trademark registration no. 6,856,893.

7. It is agreed and acknowledged that IFI shall consent to VXI filing a new United States trademark application for the word mark "VX VIRUAL REALITY ARCADE" for "Video arcade services" in class 41.

8. If VXI files a new United States trademark application for the word mark "VX VIRUAL REALITY ARCADE" the identification of services must include the following express disclaimer language: "*Video arcade services,* ***except and excluding any other products or services in the field of "robotic kits and accessories," "educational and teaching robots," "educational and entertainment services in the field of robotics," "robotic competitions of any kind" or "robotic toys, namely, toy robots, toy robot building kits, construction toys, and parts and accessories thereof."***

9. Within ten (10) days of the effective date, VXI shall file an amendment to the VX and design mark at the United States Patent and Trademark Office ("PTO") to include an express disclaimer in the identification of services which reads as follows:

> ***Class 041*** – "*Video arcade services,* ***except and excluding any other products or services in the field of "robotic kits and accessories," "educational and teaching robots," "educational and entertainment services in the field of robotics," "robotic competitions of any kind" or "robotic toys, namely, toy robots, toy robot building kits, construction toys, and parts and accessories thereof."***

10. VXI will provide IFI's counsel with a copy of the amendments to the description of the services for the VX and design mark filed with the PTO.

11. IFI shall not file any Opposition and/or further Extensions of Time to Oppose the VX and design mark, so long as the exclusions as enumerated herein are included, nor shall it aid or assist others.

12. VXI agrees it will not interfere directly or indirectly in any capacity or way with the current use and/or registration of the IFI VEX Marks or the future use and/or registration of the IFI VEX Marks, nor shall it aid or assist others.

13. If either party believes that the other is in breach of any of the provisions of the Agreement, it shall so notify the other party in writing at the address provided below, and the notified party shall have 30 days to cure such breach or to take reasonable steps to prevent the recurrence of such breach. If the

breach is not cured within thirty days, the breaching party shall be responsible for reimbursement of all of the non-breaching party's reasonable attorney fees incurred in enforcing its rights hereunder.

If to IFI:

Christopher J. Bischoff, Esq.
Bischoff & Associates, Ltd.
1650 Payne Street
Evanston, IL 60201

If to VXI:

Russell Kinsey, Esq.
The Kinsey Law Office
2765 S Golden Way
Denver, CO 80227

14. Each Party shall bear its own attorneys' fees in the preparation of this Agreement.

15. This Agreement reflects the entire understanding of the parties concerning the subject matter hereof. This Agreement may not be modified except in writing signed by the parties. This Agreement shall be binding upon and inure to the benefit of the affiliates and subsidiaries of the parties that are controlled by, or under common control with, the parties.

16. No breach of any provision hereof can be waived unless in writing. The waiver of a breach of any provision hereof shall not be deemed to be a waiver of any other breach of any provision hereof.

17. If a court of competent jurisdiction holds that any one or more of this Agreement's provisions are invalid, illegal, or unenforceable in any respect, such invalidity, illegality, or unenforceability will not affect any of this Agreement's other provisions, and this Agreement shall be construed as if it had never contained such invalid, illegal or unenforceable provisions.

18. This Agreement may be executed in two or more counterparts, each of which together shall be deemed an original, but all of which together shall constitute one and the same instrument. If any signature is delivered by facsimile transmission or by e-mail delivery of a ".pdf" format data file, such signature shall create a valid and binding obligation of the party executing (or on whose behalf such signature is executed) with the same force and effect as if such facsimile or ".pdf" signature page was an original thereof.

19. IFI acknowledges that VXI may use and register the VX and design mark and the VX VIRTUAL REALITY ARCADE word mark in connection with "video arcade services," and consistent with the terms of this Agreement, the parties shall cooperate to carry out the spirit and intention of the Agreement, which cooperation may include but not be limited to execution of future consent to register and co-existence agreements on behalf of either party including IFI's VEX marks if needed before the United States Patent and Trademark Office (USPTO) or other trademark offices in other jurisdictions/territories.

20. This Agreement shall be governed by and construed and enforced in accordance with the laws of the United States and the State of Texas. This Agreement shall apply worldwide.

Wherefore, the parties have caused this Agreement to be executed by their duly authorized officer as of the Effective Date.

INNOVATION FIRST, INC.	**VIRTUAL X, INC.**
By: _____	By: _____
Name: _____	Name: _____
Title: _____	Title: _____

EXHIBIT B

I hereby certify that a true and complete copy of the foregoing Respondent Answers/Counterclaim to Cancellation 92085789 Registration Number 6856893 VX has been served on Bischoff & Associates, LTD. Christopher J. Bischoff and Raymond I. Geraldson III by forwarding said copy on September 17, 2024, chris@trademarksearch.com and ray@trademarksearch.com to: Bischoff & Associates, LTD. Christoper J. Bischoff & Raymond I Geraldson III 1650 Payne Street Evansion, Illinois 60201 847-491-9800 chris@trademarksearch.com & ray@trademarksearch.com.

Signature /Danyelle Paul/

Virtual X Inc.

154 129th Ave W

Madeira Beach, FL 33708

Danyelle.paul@gmail.com

Date September 17, 2024