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

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|---|---|
| Proceeding | 91203462 |
| Party | Plaintiff<br>Raj Abhyanker |
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| Date | 10/03/2014 |
| Attachments | Final Opposer Response Supplemental Brief.pdf(3719809 bytes ) |

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

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| **RAJ ABHYANKER**<br><br>Opposers,<br><br>v.<br><br>**NEXTDOOR.COM INC.,**<br><br>Applicant. | **Opposition Nos.** 91214783 and 91203462<br><br>**Mark(s): NEXTDOOR**<br><br>**Serial No.** 85/236,918<br><br>**Published: January 10, 2012** |

**OPPOSER'S OPPOSITION RESPONSE TO APPLICANT NEXTDOOR.COM, INC.'S SUPPLEMENTAL BRIEF IN SUPPORT OF ITS NOTICE OF JUDGMENT IN FAVOR OF NEXTDOOR.COM AND RAJ ABHYANKER'S DISMISSAL WITH PREJUDICE OF ALL CLAIMS**

On November 6, 2012, the Board stayed Opposition Nos. 91203462 and 91203762 pursuant to a "CONSENTED MOTION TO SUSPEND PENDING TERMINATION OF RELATED FEDERAL TRADEMARK LITIGATION" between the parties: *Nextdoor.com. Inc. v. Raj Abhyanker*, Case No. CV-12-5667 (the "Civil Action"). Specifically, the proceeding was stayed until the parties, in the Civil Action, resolve the following four Issues:

COUNT I: Declaratory Judgment Under 28 U.S.C. § 2201 whether Nextdoor.com Inc. ("Nextdoor") is lawfully using the NEXTDOOR Mark and has priority of use of the NEXTDOOR Mark;

COUNT II: Declaratory Judgment Under 28 U.S.C. § 2201 whether Nextdoor is lawfully using the NEXTDOOR Mark and is not committing infringement onto Opposer's FATDOOR Mark;

COUNT III: Whether Opposer is in Violation of 15 U.S.C.A. § 1125(d)(1) for allegations of Cyberpiracy; and

COUNT IV: Whether Opposer is in Violation of 15 U.S.C.A. § 1125(A) for allegations of violations of the Lanham Act.

*See* Exhibit A.

Subsequently, Applicant is now improperly attempting to assert that a dismissal of this proceeding is warranted based on a dismissal of Count I in the Civil Action, and a recent order by the same Court dismissing Count II, all while admitting that Nextdoor still has two pending claims in the Civil Action, specifically, Counts III, for cyberpiracy, and Counts IV, for violations of the Lanham Act. *See* Exhibit B at 2, Footnote 1.

## I. Background

On August 11, 2014, Applicant, in the Civil Action, filed its Motion to Dismiss its claims for declaratory relief. *See* Exhibit C.

On September 11, 2014, Applicant, in the Civil Action, preemptively to any ruling on its August 11 motion, filed a Motion for Summary Judgment as to Counts II and IV. *See* Exhibit D.

On September 19, 2014, in the Civil Action, the Court issued an order granting Applicant's Motion to Dismiss Count II without prejudice. *See* Exhibit E.

On September 26, 2014, in the Civil Action, Opposer filed its response to Applicant's motion for summary judgment on Counts II and IV. *See* Exhibit F.

On October 2 and 3, 2014, in the Civil Action, Applicant filed its Reply in support of its Motion for Summary Judgment and its Administrative Motion to Seal Portions of Its Reply. *See* Exhibit G.

In sum, Applicant's attempt to dismiss this proceeding based on the "without prejudice" dismissal of Count II in the Civil Action, in spite of the fact that half of Applicant's counts in the Civil Action are yet to be adjudicated, is improper and in bad faith.

## II. APPLICANT HAS IMPROPERLY AND IN BAD FAITH INTERPRETED THE CIVIL COURTS SEPTEMBER 19 ORDER DISMISSING COUNT II OF THE CIVIL ACTION

Applicant wants the board to believe that simply because the Court in the Civil Action dismissed Applicant's count II without prejudice, Opposer has lost all claims against Nextdoor or the Nextdoor mark.

Applicant dubiously interprets this development to signify that all of Opposer's claims against Applicant have been adjudicated on the merits, however, Applicant fails to note that the Court's order was specific only to Applicants Motion to Dismiss, and Opposer's voluntary dismissal of his counter claims. The Court did not resolve the remaining claims in the Civil Action or otherwise in dispute.

Moreover, Applicant indecorously wants the Board to accept that the Court rejected Opposer's TTAB claims as "mistaken and irrelevant", yet suspiciously fails to note that the counter arguments referenced do not revolve around this TTAB proceeding, but rather, Opposer's arguments that (a) Opposer still may bring claims against other infringing conduct, specifically, future infringement by Applicant and other parties, and (b) that a licensee of Opposer's FATDOOR Mark could enforce the same trademark rights against Applicant, both in reference to the at issue Declaratory Relief that Applicant was pursuing a dismissal off. *See* Exhibit E at 3 and 4. The rights of licensees of Opposer's mark in relation to Applicant's rights are still at issue, as well as issues regarding infringement of downstream users of Applicant's

mark, to which the present matter before the Board can adequately address in terms of likelihood of confusion and rights to the marks as listed in the subject applications and registration.

Even interpreting Applicant's flawed assertion that "the TTAB matter did not leave an issue open that permitted declaratory relief", most favorable to Applicant, this does not preclude the Board from resolving the still pending issues as to whether Applicant's NEXTDOOR Mark is confusingly similar to Opposer's FATDOOR Marks, and/or, whether preclusion is warranted in light of the fact that the Court's September 19 Order solely based on Opposer's voluntary dismissal of his counter claims in the Civil Action and not an analysis of whether the at issue Marks of the respective parties are sufficiently similar for likelihood of confusion. Specifically, having dismissed COUNT II without prejudice does not resolve the controversy as to confusion between the at issue marks and any future disputes by the parties and/or licensees of Opposer. Since the Court's order is merely predicated on Opposer's voluntary dismissal, rather than adjudication on the merits, future claims for, by way of example, likelihood of confusion, declaratory relief, and/or fraud remain ripe. Thus, final adjudication of the remaining Civil Action claims are paramount to the Board's final decision of Counts I and II on this proceeding. Therefore, in the interest of justice, Opposer respectfully requests that the Board continue the stay in this proceeding.

## III. APPLICANT ERRONEOUSLY ASSERTS THAT OPPOSER'S CLAIMS IN THIS PROCEEDING ARE BARRED BY THE DOCTRINE OF RES JUDICATA

By citing the TTAB, Applicant has eloquently orchestrated untenable arguments based on the doctrine of res judicata for why this proceeding should be dismissed with prejudice. Suspiciously, Applicant neglects to mention the Court of Appeals for the Federal Circuit's ("CAFC") opinion regarding the effect of res judicata in Board proceedings. Specifically, in a

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