

ESTTA Tracking number: **ESTTA480800**

Filing date: **06/28/2012**

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

Proceeding	91205245
Party	Defendant VLP Law Group LLP
Correspondence Address	BRIAN M. DAVIS VLP LAW GROUP LLP 5960 FAIRVIEW RD STE 400 CHARLOTTE, NC 28210-3119 bdavis@vlplawgroup.com
Submission	Answer and Counterclaim
Filer's Name	Jason M. Sneed
Filer's e-mail	JSneed@SneedLegal.com, Litigation@SneedLegal.com, BDavis@VLPLawGroup.com
Signature	/Jason M. Sneed/
Date	06/28/2012
Attachments	2012-06-28 VLP Law Group Answer & Counterclaims - No. 91205245.pdf (10 pages)(191202 bytes)

Registrations Subject to the filing

Registration No	3145677	Registration date	09/19/2006
International Registration No.	NONE	International Registration Date	NONE
Registrant	GLP S.R.L. Piazzale Cavedalis, 6/2 I-33100 UDINE, ITALY		
Grounds for filing	The registered mark has been abandoned.		

Goods/Services Subject to the filing

Class 041. All goods and services in the class are requested, namely: Arranging and conducting educational conferences; conducting workshops and seminars in industrial property; teaching in the field of industrial property
Class 042. All goods and services in the class are requested, namely: Patent agent and industrial property consultation

Registration No	3441102	Registration date	06/03/2008
International Registration No.	NONE	International Registration Date	NONE
Registrant	GLP S.R.L. Piazzale Cavedalis, 6/2 I-33100 UDINE (UD) ITALY		

Goods/Services Subject to the filing

Class 041.

All goods and services in the class are requested, namely: Arranging and conducting educational conferences; conducting workshops and seminars in industrial property; teaching in the field of industrial property

Class 042.

All goods and services in the class are requested, namely: Patent agency, namely, patent agent services; industrial property consultation

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

Appl. Serial No. 85/289,484 for the mark VLP

Appl. Serial No. 85/385,746 for the mark VLP VLP LAW GROUP LLP & Design

Reg. No. 3,145,677 for the mark GLP

Reg. No. 3,441,102 for the mark GLP (Stylized)

GLP S.R.L.,)	
)	
Opposer / Respondent,)	
)	
v.)	Opposition No. 91205245
)	
VLP LAW GROUP LLP,)	
)	
Applicant / Petitioner.)	
)	

**ANSWER OF APPLICANT VLP LAW GROUP LLP
AND PETITION FOR CANCELLATION OF REG. NOS. 3,145,677 AND 3,441,102**

Applicant VLP Law Group LLP (“VLP Law Group”), pursuant to 37 C.F.R. §§ 2.106 and 2.111, herein asserts its Answer to the Notice of Opposition of Opposer GLP S.R.L. (“Opposer” or “GLP”) and its petition to cancel U.S. Reg. Nos. 3,145,677 and 3,441,102, as set forth herein.

Answer to Notice of Opposition

Applicant responds to the specifically-numbered paragraphs of Opposer’s Notice of Opposition as follows:

1. Applicant is without information or knowledge sufficient to form a belief as to the corporate identity or principal place of business of Opposer, GLP, and therefore denies the allegations contained in Paragraph 1 of the Notice of Opposition.

2. Applicant admits the allegations contained in Paragraph 2 of the Notice of Opposition.

3. Applicant admits the allegations contained in Paragraph 3 of the Notice of Opposition.

4. Applicant admits the allegations contained in Paragraph 4 of the Notice of Opposition.

5. Applicant is without information or knowledge sufficient to form a belief as to the truth of the allegations contained in Paragraph 5 of the Notice of Opposition, and therefore denies the same.

6. Applicant is without information or knowledge sufficient to form a belief as to the truth of the allegations contained in Paragraph 6 of the Notice of Opposition, and therefore denies the same.

7. While denying that the registrations described in Paragraph 7 of the Notice of Opposition are valid or subsisting, Applicant admits the ownership allegations contained in Paragraph 7 of the Notice of Opposition.

8. Applicant denies the allegations contained in Paragraph 8 of the Notice of Opposition.

9. Applicant is without information or knowledge sufficient to form a belief as to the truth of the allegations contained in Paragraph 9 of the Notice of Opposition, and therefore denies the same.

10. Applicant denies the allegations contained in Paragraph 10 of the Notice of Opposition.

11. Applicant denies the allegations contained in Paragraph 11 of the Notice of Opposition.

12. Applicant denies the allegations contained in Paragraph 12 of the Notice of Opposition.

13. Applicant is without information or knowledge sufficient to form a belief as to the truth of the allegations contained in Paragraph 13 of the Notice of Opposition, and therefore denies the same.

14. Applicant denies the allegations contained in Paragraph 14 of the Notice of Opposition.

15. Applicant denies the allegations contained in Paragraph 15 of the Notice of Opposition.

16. Applicant denies the allegations contained in Paragraph 16 of the Notice of Opposition.

17. Applicant denies the allegations contained in Paragraph 17 of the Notice of Opposition.

18. Applicant denies the allegations contained in Paragraph 18 of the Notice of Opposition.

19. Applicant denies each and every allegation in the Notice of Opposition not specifically addressed herein, and Applicant denies that Opposer is entitled to any of the relief sought by Opposer in its Notice of Opposition.

WHEREFORE, Applicant respectfully requests that the Board deny and dismiss the Notice of Opposition, with prejudice, and issue registrations to VLP Law Group pertaining to

U.S. Appl. Serial Nos. 85/389,484 for the mark VLP and 85/385,746 for the mark VLP VLP LAW GROUP & Design.

Defenses and Affirmative Defenses

Pursuant to 37 C.F.R. § 2.106(b), VLP Law Group asserts the following defenses and affirmative defenses to the Notice of Opposition:

1. Opposer has abandoned both of the registrations asserted against Applicant, namely Reg. No. 3,145,677 for the mark GLP and Reg. No. 3,441,102 for the mark GLP (Stylized), together with the underlying marks, pursuant to Section 14 of the Lanham Act, 15 U.S.C. § 1064, having failed to use or discontinued the use in this country of the marks with intent not to resume the use thereof.
2. Notwithstanding the abandonment of Opposer's asserted marks in this country, there is no likelihood of confusion by or among the marks GLP and GLP (Stylized), on the one hand, and the marks VLP or VLP VLP LAW GROUP LLP & Design, on the other hand.
3. Opposer is barred from contesting the rights of Applicant because of Opposer's own unclean hands.
4. Opposer has acquiesced to Applicant's relevant rights in this country, having failed to oppose or otherwise contest U.S. Reg. No. 3,596,343 for Applicant's related mark, VLP VIRTUAL LAW PARTNERS LLP & Design, registered in conjunction with the identical services described in Applicant's two applications involved in this proceeding.
5. Opposer lacks standing to contest U.S. Appl. Serial Nos. 85/289,484 for the mark VLP and Appl. Serial No. 85/385,746 for the mark VLP VLP LAW GROUP LLP & Design.
6. Opposer's U.S. Reg. Nos. No. 3,145,677 for the mark GLP and Reg. No. 3,441,102 for the mark GLP (Stylized), together with the underlying marks, are not valid or

subsisting and Opposer is not entitled to ownership of such registrations in this country, having not engaged in use of the subject marks in commerce in the United States, or having abandoned any rights.

CANCELLATION PETITION AGAINST REG. NOS. 3,145,677 AND 3,441,102

Pursuant to 37 C.F.R. 2.111, 15 U.S.C. § 1064 and 15 U.S.C. § 1127, VLP Law Group LLP (“VLP Law Group” or “Petitioner”), seeks the cancellation of U.S. Reg. Nos. 3,145,677 and 3,441,102, due to the abandonment by GLP S.r.l. (“GLP” or “Registrant”) of the GLP and GLP (Stylized) marks in this country, and VLP Law Group will be harmed by the continued registration of said marks to Registrant. VLP Law Group, in further support of this cancellation petition, states and alleges as follows:

1. Petitioner VLP Law Group is a California Limited Liability Partnership with its principal place of business at 555 Bryant St., Suite 820, Palo Alto, California 94301.

2. Registrant GLP S.r.l. is, on information and belief, an Italian law firm with a principal place of business at Piazzale Cavedalis 6/2, 33100 Udine, Italy. Registrant has no offices located in the United States, and no attorneys of the firm reside in or are authorized to practice law in any jurisdiction in the United States.

3. Registrant is the owner of two registrations cited against VLP Law Group in Registrant’s Notice of Opposition against U.S. Appl. Serial Nos. 85/289,484 for the mark VLP and Appl. Serial No. 85/385,746 for the mark VLP VLP LAW GROUP LLP & Design, namely:

- a. U.S. Reg. No. 3,145,677 for the mark GLP (in all-caps) in conjunction with “Arranging and conducting educational conferences; conducting workshops and seminars in industrial property; teaching in the field of industrial property” in International Class 41 and “Patent agent and industrial property consultation” in International Class 42, filed March 7, 2005 pursuant to Section 66A and registered September 19, 2006; and

- b. U.S. Reg. No. 3,441,102 for the mark GLP (Stylized, in lower case letters) in conjunction with “Arranging and conducting educational conferences; conducting workshops and seminars in industrial property; teaching in the field of industrial property” in International Class 41 and “Patent agency, namely, patent agent services; industrial property consultation” in International Class 42, filed July 27, 2007 pursuant to Section 66A and registered June 3, 2008.

(Hereinafter the “GLP Registrations”).

4. Registrant has not made use in commerce in this country, or has discontinued the use in commerce, of the GLP mark and the GLP (Stylized) mark (hereinafter, the “GLP Marks”) and the related GLP Registrations.

5. In particular, Registrant has not made use in commerce in this country, or has discontinued the use in commerce since September 19, 2006, of the GLP mark subject to Reg. No. 3,145,677, in connection with the following services:

- a. Arranging and conducting educational conferences;
- b. conducting workshops and seminars in industrial property;
- c. teaching in the field of industrial property;
- d. patent agent and industrial property consultation.

6. In particular, Registrant has not made use in commerce in this country, or has discontinued the use in commerce since June 3, 2008, of the GLP (Stylized) mark subject to Reg. No. 3,441,102, in connection with the following services:

- a. Arranging and conducting educational conferences;
- b. conducting workshops and seminars in industrial property;
- c. teaching in the field of industrial property
- d. patent agency, namely, patent agent services;
- e. patent agency, namely, industrial property consultation.

7. Registrant does not maintain any offices in the United States. Registrant, at its website, www.glp.it, lists five offices at which it does business, four of which are in Italy and one of which is in Switzerland.

8. Registrant does not have, as a partner or employee, any lawyer who is licensed to practice law in any federal or state court in the United States. Registrant, at its website, www.glp.it, identifies 17 lawyers at its website, none of whom are licensed to practice law in any jurisdiction in the United States.

9. No lawyer, member, shareholder, partner or employee of Registrant is authorized to practice patent law or is an authorized patent agent before the U.S. Patent and Trademark Office.

10. Registrant, at its website, www.glp.it, lists 187 representative cases that lawyers from Registrant's firm have handled. Not a single case listed was before a U.S. court or administrative board. Registrant has not conducted any business before or practiced law before any U.S. court or administrative board.

11. Registrant, at its website, www.glp.it, also identifies the conferences at which its attorneys have spoken or been involved, going back to the year 2000. Among the dozens of conference participations or speaking occasions identified, only one identified speaking opportunity is shown as taking place in the United States, a 2007 speech at an AIPLA meeting in Boston. Notwithstanding this one speaking occasion, such activity and any related speaking occasions in the United States do not constitute "arranging and conducting" educational conferences or "conducting workshops and seminars" sufficient to establish use of such services in this country.

COUNT I: CANCELLATION OF U.S. REG. NO. 3,145,677 FOR ABANDONMENT

12. Petitioner incorporates by reference the allegations set forth above at Paragraphs 1 through 11.

13. Registrant, GLP, has not used the GLP mark subject to U.S. Reg. No. 3,145,677 in this country, or, alternatively, GLP has discontinued without the intent to resume the use of the mark in this country, such that U.S. Reg. No. 3,145,677 should be cancelled pursuant to 15 U.S.C. § 1064.

14. The continued registration of U.S. Reg. No. 3,145,677 on the Principal Register harms and causes damage to Petitioner, such that it should be cancelled.

COUNT II: CANCELLATION OF U.S. REG. No. 3,441,102 FOR ABANDONMENT

15. Petitioner incorporates by reference the allegations set forth above at Paragraphs 1 through 14.

16. Registrant, GLP, has not used the GLP (Stylized) mark subject to U.S. Reg. No. 3,441,102 in this country, or, alternatively, GLP has discontinued without the intent to resume the use of the mark in this country, such that U.S. Reg. No. 3,441,102 should be cancelled pursuant to 15 U.S.C. § 1064.

17. The continued registration of U.S. Reg. No. 3,441,102 on the Principal Register harms and causes damage to Petitioner, such that it should be cancelled.

WHEREFORE, Petitioner, VLP Law Group LLP, respectfully requests that the Board grant judgment in VLP Law Group LLP's favor as to VLP Law Group LLP's cancellation counterclaims, and against Registrant, GLP S.r.l., and that the Board strike from the Principal Register U.S. Reg. Nos. 3,145,677 and 3,441,102.

Respectfully submitted this 28th day of June, 2012.

/Jason M. Sneed/

Jason M. Sneed, Esq.
SNEED PLLC
610 Jetton St., Suite 120-107
Davidson, North Carolina 28036
Tel.: 704-779-3611
JSneed@SneedLegal.com

Brian M. Davis, Esq.
VLP LAW GROUP LLP
5960 Fairview Road
Charlotte, North Carolina 28210-3119
Tel.: 704-998-8014
BDavis@VLPLawGroup.com

*Attorneys for Applicant & Petitioner,
VLP Law Group LLP*

Certificate of Filing

The undersigned hereby certifies that on this 28th day of June 2012, the foregoing pleading was filed with the Trademark Trial and Appeal Board by electronic means through the Electronic System for Trademark Trial and Appeals.

Dated: June 28, 2012

/Jason M. Sneed/

An Attorney for Applicant and Petitioner

Certificate of Service

The undersigned hereby certifies that on the 29th day of June 2012, a copy of the foregoing ANSWER OF APPLICANT VLP LAW GROUP LLP AND PETITION FOR CANCELLATION OF REG. NOS. 3,145,677 AND 3,441,102 was served by placing in U.S. Mail, postage prepaid, and addressed to the following counsel of record:

Jeffrey B. Sladkus, Esq.
The Sladkus Law Group
1827 Powers Ferry Road, Building, Suite 200
Atlanta, GA 30339
Attorneys for Opposer / Registrant GLP S.r.l.

Dated: June 28, 2012

/Jason M. Sneed/

An Attorney for Applicant and Petitioner