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February 25, 2002

Jeffrey A. Handleman
Name of Applicant, Assignee or
Registered Representative

Jeffrey A. Handleman
Signature

February 25, 2002
Date of Signature

02-28-2002
U.S. Patent & TMO/c/TM Mail Rcpt Dt. #66

Our Case No.: 9604/5

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

JACOB ZIMMERMAN,)
)
Petitioner,)

Cancellation No. 92040141

v.)

NATIONAL ASSOCIATION OF)
REALTORS,)
)
Respondent.)

RESPONDENT'S MOTION TO SUSPEND

RESPONDENT'S MOTION TO CONSOLIDATE

I. Introduction

Jacob Zimmerman ("Petitioner" or "Zimmerman") has filed the present petition to cancel Registration No. 519,789, covering the mark REALTOR. The petition is based on genericness grounds. The challenged registration, which was granted in 1950, is owned by National Association of Realtors ("Respondent" or "NAR").

J.A

NAR hereby moves to suspend the present proceeding pending disposition of Cancellation Nos. 27,885 and 28,047. In addition, NAR moves to consolidate this proceeding with Cancellation No. 32,360. The reasons in support of these motions are set forth below.

II. Discussion

A. Motion to Suspend

The issue in this case has been raised in another cancellation proceeding that is presently pending before the Board. Specifically, in Cancellation No. 27,885, petitioner Arleen Freeman has petitioned to cancel the same registration, also based on genericness grounds.

Notably, the attorney for the petitioner in this proceeding, David Barry, is the same attorney representing the petitioner in Cancellation No. 27,885. For the Board's convenience, copies of the petitions filed in this cancellation proceeding and the prior one are attached hereto as Exhibits A and B, respectively.

It should be noted that the petitioner in prior Cancellation No. 27,885 also petitioned to cancel another registration owned by NAR, Registration No. 515,200 for the mark REALTORS, in Cancellation No. 28,047. The Board consolidated these two prior proceedings (hereinafter referred to as Cancellation Nos. 27,885 and 28,047).

Although the present proceeding was filed only relatively recently, proceedings in Cancellation Nos. 27,885 and 28,047 are nearing completion. All of the evidence in Cancellation Nos. 27,885 and 28,047 has been submitted and briefing has been completed. The oral argument was held on February 8, 2002.

As is apparent, the outcome of Cancellation Nos. 27,885 and 28,047 will have a direct bearing on the present proceeding. The prior proceedings and the present one involve the same challenged registration and the same ground for cancellation, *i.e.*, alleged genericness. Indeed, as mentioned, the same attorney is representing the petitioner in each case. Accordingly, NAR hereby requests that the present proceeding be suspended pending final disposition of Cancellation Nos. 27,885 and 28,047. *See* Trademark Rule 2.117(c). Given the direct parallels between the present case and the pending proceedings, and the fact that the pending proceedings have already been briefed and argued, suspension of the present case is appropriate. It will conserve precious Board and administrative resources, avoid duplication of effort, and save potentially unnecessary legal expenses.

The answer in this proceeding is due on February 25, 2002. It is respectfully requested that the time for NAR to answer or otherwise plead in this case be extended until after the Board rules on the present motion to suspend. If the Board grants the motion to suspend and thereafter proceedings are resumed, NAR requests that the Board set a date for NAR to answer or otherwise plead after resumption of the proceedings.

B. Motion To Consolidate

Petitioner Zimmerman also has filed a petition to cancel another registration owned by NAR, Registration No. 515,200, covering the mark REALTORS, in Cancellation No. 32,360. That petition also is based on genericness grounds. NAR has moved to suspend Cancellation No. 32,360 for the same reasons that it is moving to suspend the present proceeding. That motion to suspend is presently pending.

The present proceeding and Cancellation No. 32, 360 involve the same parties, related marks, and the same legal and factual issues. Accordingly, NAR respectfully requests that

the Board consolidate Cancellation No. 32,360 and the present proceeding. Consolidation will achieve savings of time, effort and expense and serve the interest of justice.

III. Conclusion

For all the foregoing reasons, NAR respectfully requests that the Board grant its motion to suspend and issue an order consolidating Cancellation No. 32,360 with the present proceeding.

Respectfully submitted,

NATIONAL ASSOCIATION OF
REALTORS

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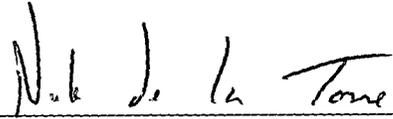
Attorneys for Respondent

Dated: February 25, 2002

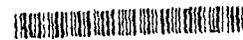
CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing Respondent's Motion to Suspend and Motion to Consolidate was served on counsel for Petitioner by facsimile transmission and by First Class Mail, postage prepaid, on this 25th day of February, 2002, in an envelope addressed as follows:

David Barry
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11/15



11-23-2001

U.S. Patent & TMOR/TM Mail Rep Dt #28

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

10 In the Matter of

11 Registration No. 519,789 Registered Jan. 10 1950: REALTOR

12 JACOB ZIMMERMAN

No.

13 Petitioner

PETITION TO CANCEL

14 vs.

15 NATIONAL ASSOCIATION OF REALTORS

16 Registrant

17 1. Petitioner Jacob Zimmerman is an individual doing business under the fictitious
 18 business name BuildIdeas.com, located at 208 Dryden Road, No. 507, Ithaca, New York 14850.

19 2. Registrant National Association of Realtors (NAR) is an Illinois corporation with
 20 principal place of business at 430 North Michigan Ave., Chicago, Illinois 60611-4087. It owns the
 21 collective membership mark "realtor" No. 519,789 issued Jan. 10, 1950 to the National Association
 22 of Real Estate Boards. The latter organization changed its name to the National Association of
 23 Realtors and the mark ownership renewed each decade.

24 3. Petitioner has and will continue to be damaged by the above-identified registration and
 25 hereby petitions to cancel the same.

26 4. The subject mark "realtor" is generic. In common usage, it means a real estate agent, a
 27 phrase synonymous with realty agent.

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1 5. The members of NAR are realty agents. NAR allows only those members to use the
2 word "realtor" in connection with their businesses. NAR advises its members and all others that
3 the use of the word "realtor" in connection with a web site name is contrary to the rules of NAR.
4 NAR also advises members and nonmembers that it will take legal action against any person using
5 the word "realtor" in a web site name.

6 6. Petitioner is not a member of NAR, and has never been a member of NAR. He is not a
7 real estate broker. Petitioner is in the business of buying and selling website addresses containing
8 the word "realtor", such as, batonrouge-realtor.net, anaheim-realtors.net, abolinerealtors.com,
9 siliconvalley-realtor.net. His business also includes providing services in connection with such
10 web site addresses. For instance, petitioner has attempted to develop such sites as
11 bostonrealtors.org as a location offering a selection of real estate agents in the Boston area who
12 would pay petitioner to promote their services in the Boston area.

13 7. Petitioner owns approximately 1,900 web site names incorporating the term "realtor"
14 and a geographic designation.

15 8. Petitioner is not permitted by NAR to use the word "realtor" in his web site names
16 because he is not a member of NAR, and because NAR forbids the use of the word "realtor" in
17 web site names.

18 9. Petitioner has been injured in his business by the continuance of the registration of the
19 "realtor" mark. Potential purchasers of petitioner's web site are mainly real estate agents. Many
20 such realty agents are aware of NAR's threats to file suit against any person using the term
21 "realtor" in web site names, and are therefore unwilling to purchase any of petitioner's web site
22 names. In addition, realty agents are unwilling to pay petitioner for placement on such web sites
23 as bostonrealtors.org because of the threat by NAR to enjoin the use of such web site names.
24 NAR's continuing registration of the "realtor" mark has severely lowered the demand for
25 petitioner's web site names and petitioner's promotional services.

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10. Petitioner is simultaneously filing a petition to cancel the collective membership mark "realtors", also owned by NAR.

WHEREFORE,

Petitioner requests relief as follows:

- 1. For cancellation of the mark "realtor", No. 519,789 on the ground that such is generic, under section 14 of the Lanham Act, 15 U.S.C. 1064(3), and
- 2. For such further relief as the Commissioner deems appropriate.

Dated: Aug. 11, 2001


 Barry and Associates, by David Barry,
 Attorneys for Petitioner Jacob Zimmerman

File no.: 805.1
Petition to cancel REALTOR


 08-16-2001
 U.S. Patent & TM Office Mail Room DL #11

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#1

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U.S. Patent & TMO/c/TM Mail Rcpt Dt. #64
07-27-1998

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TRADEMARK TRIAL AND APPEAL BOARD

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

In the Matter of

Registration No. 519,789. Registered Jan. 10, 1950: REALTOR

11 ARLEEN FREEMAN
12 Petitioner

Cancellation No. 27,885

PETITION TO CANCEL

13 VS.

14 NATIONAL ASSOCIATION OF REALTORS,
15 Registrant

17 1. Petitioner Arleen Freeman is an individual real estate broker licensed under California
18 law. She does business under the trade name Freeman Realty at 1940 Hornblend Street, San
19 Diego, CA 92109.

20 2. Registrant National Association of Realtors (NAR) is an Illinois corporation with
21 principal place of business at 430 North Michigan Ave., Chicago, Illinois 60611-4087. It owns the
22 collective membership mark "realtor", No. 519,789, issued Jan. 10, 1950, to the National
23 Association of Real Estate Boards. The latter organization changed its name to the National
24 Association of Realtors, and the mark ownership was renewed to NAR on Jan. 10, 1990.

25 3. Petitioner has and will continue to be damaged by the above-identified registration, and
26 hereby petitions to cancel the same. The grounds for cancellation are as follows.

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1 4. The subject mark "realtor" is generic. In common usage, it means a real estate agent, a
2 phrase synonymous with realty agent. To NAR, realtor means a real estate agent who is a
3 member of NAR. Not all real estate agents are members of NAR.

4 5. The members of NAR are realty agents. NAR allows only those members to call
5 themselves realtors.

6 6. Petitioner is not a member of NAR; she is a competitor of the NAR members working
7 in San Diego County.

8 7. Petitioner is not permitted by NAR to call herself a realtor because she is not a member
9 of NAR.

10 8. Petitioner would like to call herself a realtor, because the buyers and sellers she has
11 dealt with in the past, and continues to deal with, use "realtor" as a generic word meaning realty
12 agent.

13 9. The people that petitioner comes in contact with, including clients and prospective
14 clients, repeatedly refer to her as a realtor. Petitioner has had to repeatedly correct them and
15 explain that: 1) realtor is a mark owned by NAR; 2) it is defined by NAR to mean a realty agent
16 who is a member of NAR; 3) she is not a member of NAR, and therefore not a realtor; but 4) she
17 is fully licensed under law to assist them in real estate matters. Giving that speech has been, and
18 will continue to be, a distraction to petitioner's efforts to attend to the matters of clients and
19 prospective clients.

20 10. Even after petitioner's explanation, those people remain confused as to her status.
21 They do not understand the explanation, because they "know" that realtor is a generic word, and
22 have a difficult time accepting that a generic word can be owned as a registered mark.

23 11. In introducing herself to people, including prospective clients, Freeman would prefer
24 to describe herself as a realtor, because in common parlance, the word realtor is the most
25 descriptive word for her line of work. Instead, she has been forced to introduce herself as a "real
26 estate agent", which is accurate, but not as succinct or successful in conveying to people what she
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1 does. The continued status of realtor as NAR's registered mark injures Freeman by depriving her
2 of the most correct word for her occupation.

3 12. Rather than put up with the confusion that petitioner does as to what realtor means,
4 about 500,000 real estate agents in the United States have joined NAR at a cost per agent of about
5 \$64 annually. Those agents would not have joined NAR if realtor were not a registered mark.

6 13. For many years prior to and through 1996, petitioner paid dues to NAR and was a
7 member of NAR. Such dues were \$64 in 1996. Petitioner would not have paid such dues, or
8 joined NAR, had the realtor registration not existed. Petitioner was damaged by the payment of
9 such dues, caused in substantial part by the registration of the realtor mark.

10 14. Petitioner is simultaneously filing a petition to cancel the collective membership mark
11 "realtors", also owned by NAR.

12
13 WHEREFORE,

14 Petitioner requests relief as follows:

- 15 1. For cancellation of the mark "realtor", No. 519,789, on the ground that such mark is
16 generic, under section 14 of the Lanham Act, 15 U.S.C. 1064(3), and
17 2. For such further relief as the Commissioner deems appropriate.

18
19 Dated July 27, 1998

20 David Barry
21 Barry and Associates, by David Barry.
22 Attorneys for Petitioner Arleen Freeman
23
24
25
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