



Exhibits TMB

12-04-2001

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #58

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

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 In re Registration of: :  
 :  
**Richard Dale Christy** :  
**Betty Ann Christy<sup>1</sup>** :  
 :  
 Registration No. 1,667,579 :  
 :  
 Registration Date: December 10, 1991 :  
 :  
 Mark: **IN-SYNC PUBLICATIONS (stylized)** :  
 -----X

ZEEKS, INC. :  
 Petitioner, :  
 :  
 v. : Cancellation No.  
 :  
 RICHARD DALE CHRISTY :  
 BETTY ANN CHRISTY :  
 Respondents. :  
 -----X

**PETITION FOR CANCELLATION**

Zeeks, Inc. (hereinafter, Petitioner) is a Delaware corporation, with his principal place of business at c/o Philip Baker-Shenk, Dorsey & Whitney LLP, 1001 Pennsylvania Avenue, N.W., Suite 300 South, Washington, D.C. 20004.

To the best of Petitioner's knowledge, the name and address of the current owners of the registration are Robert L. Christy and Jennifer Christy, individuals located at 2821 W. Clark Avenue, Burbank, California 91505.

12/05/2001 CMAY11 00000148 1667579  
01 FC:376 300.00 DP

<sup>1</sup> Petitioner notes that Betty Ann Christy passed away on March 14, 1993, however, the remaining registrant has not filed documents with the Assignment Division to update the change in ownership. Thus, the U.S. Patent and Trademark Office's records still identify both individuals as joint owners of the subject trademark registration.

The above-identified Petitioner believes that Respondents' registration was obtained fraudulently, and pursuant to Section 14(3), 15 U.S.C. § 1064(3), hereby petitions for the cancellation thereof.

The specific grounds for cancellation are as follows:

1. Petitioner is a corporation wholly owned by the five individual members of the popular musical group known as \*NSYNC.
2. Petitioner is the owner of two pending United States Trademark Applications filed on April 19, 2000: NSYNC and Design, Serial No. 75/981,214 for the goods "books, newsletters, pamphlets, magazines, magazine supplements all in the field of entertainment and music; sheet music; posters; stickers; decals; note cards, stationery, calendars; trading cards; mounted and unmounted photographs; temporary tattoos" in International Class 16 and NSYNC, Serial No. 75/981,217 for the goods "books, newsletters, pamphlets, magazines, magazine supplements all in the field of entertainment and music; posters; stickers; decals; note cards; stationery; calendars; trading cards; mounted and unmounted photographs; temporary tattoos" in International Class 16. Copies of filing receipts for these applications are attached at Exhibit A.
3. Petitioner is being and will be damaged by the continued registration of Respondents' trademark; namely, the trademark IN-SYNC PUBLICATIONS (stylized), as this registration has been cited as the only basis for a likelihood of confusion final refusal by the Examining Attorney of both of Petitioner's applications described in Paragraph 2. Although Petitioner believes that there is no likelihood of confusion between its marks for the specified goods and Respondents' registration for its specified goods, Petitioner seeks the cancellation of Respondents' registration.

4. On information and belief, based on the file wrapper of Respondents' registration, Respondents committed fraud when they filed their Combined Affidavit of Use and Incontestability under Sections 8 and 15 of the Trademark Act of 1946, as amended, on June 27, 1997. Such fraud amounts to fraudulently "obtaining" a registration under Section 14(3) of the Trademark Act, 15 U.S.C. 1064(3) and serves as a basis for cancellation of a trademark registration.<sup>2</sup>

5. Respondents' IN-SYNC PUBLICATIONS (stylized) trademark registered on December 10, 1991 for the goods "trade magazine for the motion picture and video industry" in International Class 16. The registrants in the Certificate of Registration are identified as Richard Dale Christy and Betty Ann Christy, joint registrants as husband and wife.

6. Pursuant to 15 U.S.C. § 1058, in order to maintain this trademark registration, Respondents were required to file a Section 8 Affidavit after the end of the fifth year of registration and before the end of the sixth year of registration, between December 10, 1996 and December 10, 1997 respectively.

7. On June 27, 1997 a Combined Affidavit of Use and Incontestability under Sections 8 and 15 of The Trademark Act of 1946, as amended, was filed with the United States Patent and Trademark Office for the subject registration. The Combined Affidavit purports to have been executed by Betty Ann Christy on June 22, 1997 as owner of the registration. The

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<sup>2</sup> In *Volkswagenwerk A.G. v. Advance Welding & Mfg. Corp.*, 184 U.S.P.Q. 367, 368 (TTAB 1974), the Board stated that it "adheres to its decision that fraud in the execution of affidavits or other documents attendant upon the maintaining of a registration rather than the securance thereof constitutes a ground for the cancelation [sic] thereof within the purview of Section 14(c)."

Combined Affidavit states that Betty Ann Christy is “warned that willful false statements . . . may jeopardize the validity of this document. . . and that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.” The Combined Affidavit further contains an Express Mail Statement signed by Robert Christy. The Combined Affidavit was accompanied by a cover letter purportedly signed by Betty Ann Christy which included a contact address of 5344 Seabreeze Way, Oxnard, California 93035. See Exhibit B.

8. For several reasons, acceptance of Respondents’ Combined Affidavit filed on June 27, 1997 was withheld as stated in the August 26, 1997 letter from Post Registration Examiner Constance M. Moore. See Exhibit C.

9. In response to the August 26, 1997 letter from the U.S. Patent and Trademark Office, Robert Christy, an individual not identified as an owner of the registration in the Registration Certificate, filed a second Combined Affidavit of Use and Incontestability under Sections 8 and 15 of The Trademark Act of 1946, as amended, on November 6, 1997. See Exhibit D. In this second Combined Affidavit, Robert Christy identified himself as the individual owner of the Registration but the Declaration of truthfulness therein was executed by both Robert Christy and Jennifer Christy as “owner.” Thus, it is unclear as to which parties were now claiming ownership to the registration, just Robert Christy or both Robert Christy and Jennifer Christy. Nevertheless, neither Robert Christy nor Jennifer Christy were the original owners of the registration. No documentary evidence was presented to support a change in ownership of the registration as required in footnote 2 on the Combined Affidavit form provided by the U.S. Department of Commerce.

10. Again, because of several deficiencies in the second Combined Affidavit, a second letter was issued by Catherine R. Hill, an Affidavit/Renewal Examiner in the Post Registration Division, on June 8, 1998 stating that acceptance of the Combined Affidavit was again being withheld because, among other reasons, the present claimant must establish ownership of the registration. See Exhibit E.<sup>3</sup>

11. On August 24, 1998, Richard Dale Christy, one of the initial registrants, wrote a letter to Ms. Catherine R. Hill in response to her letter of June 8, 1998. See Exhibit F. In efforts to explain the change in ownership of the registration, Richard Dale Christy stated that his wife and joint registrant, Betty Ann Christy, passed away on March 14, 1993. Richard Dale Christy further filed with the U.S. Patent and Trademark Office a copy of the death certificate of Betty Ann Christy issued by Ventura County, California, on March 23, 1993.<sup>4</sup>

12. The Certificate of Death from the County of Ventura, California states that Betty Ann Christy died on March 14, 1993. Her residence is listed as 5344 Seabreeze Way, Oxnard, California 93035, the same address used in the cover letter filed with the U.S. Patent and Trademark Office on June 27, 1997 by the alleged living owner Betty Ann Christy. See Exhibit H.

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<sup>3</sup> The acceptance was withheld because Robert Christy improperly identified the registered mark as merely IN-SYNC and not as IN-SYNC PUBLICATIONS (stylized), the mark depicted in registration No. 1,667,579; improperly identified the goods claimed in the registration; misstated the date of registration of the mark; failed to submit the required filing fee; and improperly stated the current use of the mark on the goods.

<sup>4</sup> Richard Dale Christy's efforts to correct the deficiencies with respect to the second Combined Affidavit appeared to have been successful as Catherine R. Hill issued a notice of acceptance of the Combined Affidavit on September 3, 1999. See Exhibit G.

13. Based on the foregoing facts, Petitioner believes that Respondents committed fraud on June 22, 1997 when someone other than Betty Ann Christy, who had by that time been deceased for more than four years, intentionally and knowingly forged the decedent's signature on the first Combined Affidavit and accompanying cover letter and filed the documents with the U.S. Patent and Trademark Office on June 27, 1997.

14. The registrants and named Respondents, in particular Richard Dale Christy, the surviving joint registrant, fraudulently maintained their trademark registration by knowingly allowing a false Combined Affidavit to be filed on June 27, 1997 in the name of his deceased wife Betty Ann Christy.

15. Petitioner further believes that this fraudulent Combined Affidavit was intentionally prepared and endorsed by Robert Christy under the disguise of his mother, the deceased Betty Ann Christy. Petitioner's belief is based on the fact that Robert Christy is the individual who signed the Express Mail Statement on the bottom left-hand corner of the June 22, 1997 Combined Affidavit. Because Robert Christy now claims to be the sole owner of this trademark registration based on his filing on November 6, 1997 and Richard Dale Christy's letter of August 18, 1998, Petitioner asserts such fraudulent trademark maintenance actions intentionally and knowingly committed by Richard Dale Christy and Robert Christy should negatively impact their authority to maintain the same trademark registration and the same should be canceled.

16. In further support of Petitioner's belief that Respondents have committed fraudulent acts during the maintenance of their registration, Petitioner notes that Richard Dale Christy stated in his August 18, 1998 letter to Ms. Catherine R. Hill that he sold the trademark

IN-SYNC PUBLICATIONS to his son, Robert Christy, in January 1996. Richard Dale Christy attached a copy of the Contract of Sale of Business in support of his claim. See Exhibit I.

17. The Contract of Sale of Business is dated January 1, 1996 and claims that Richard Christy and Susie Christy sold their magazine business including “all trade, goodwill, and other intangible assets” to Robert Christy and Jennifer Christy.<sup>5</sup> From Richard Dale Christy’s August 18, 1998 letter it is apparent that it was his intent to include the subject trademark registration in the January 1, 1996 Contract of Sale of Business as an “intangible asset” to be sold to his son, Robert Christy, and Jennifer Christy.

18. Based on the Contract of Sale of Business and the Certificate of Death which were made part of the official trademark record for this registration on August 18, 1998 when they were attached as exhibits to Richard Dale Christy’s letter, it is Petitioner’s belief that two fraudulent statements were made in the June 22, 1997 Combined Affidavit.

19. First, the statement that Betty Ann Christy “owns the above identified registration” was false as of June 22, 1997 for two reasons. First and foremost, because Betty Ann Christy died on March 14, 1993, she could not have owned the trademark registration as of June 22, 1997. Petitioner knows of no law that enables a deceased registrant to maintain ownership of a trademark registration after death. Second, the remaining registrant, Richard Dale

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<sup>5</sup> Petitioner has not been able to ascertain the relationship between Richard Dale Christy and Susie Christy. Nor has Petitioner been able to determine when or how Susie Christy obtained rights in the trademark registration IN-SYNC PUBLICATIONS (stylized). Thus, it appears that another link in the ownership history for this trademark registration is missing. Furthermore, the Contract of Sale of Business makes Richard Dale Christy’s August 18, 1998 statement that he individually sold the trademark IN-SYNC PUBLICATIONS (stylized) to his son, Robert Christy, false since both Richard Christy and Susie Christy are identified as joint sellers in the January 1, 1996 Contract of Sale of Business.

Christy, claims he and a Susie Christy sold the trademark registration to Robert Christy and Jennifer Christy on January 1, 1996 thereby making Betty Ann Christy's claim of ownership of the registration as of June 22, 1997 false even if she were not deceased.

20. Second, the inherent statement that the June 22, 1997 Combined Affidavit was being presented on behalf of and executed by Betty Ann Christy, one of the initial joint registrants, was false because Betty Ann Christy died on March 14, 1993. Another individual must have prepared the Combined Affidavit, intentionally and knowingly forged Betty Ann Christy's signature, and filed the Combined Affidavit with the U.S. Patent and Trademark Office claiming to be Betty Ann Christy.

21. Petitioner asserts that such intentionally and knowingly false actions and statements amount to the fraudulent maintenance of a trademark registration and serve as the basis for canceling Respondents' registration.

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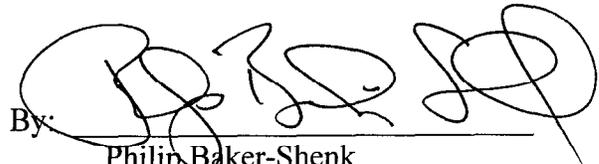
WHEREFORE, Petitioner respectfully prays that this Petition for Cancellation be granted and that Registration No. 1,667,579 be canceled. This Petition is submitted in duplicate, together with a filing fee in the amount of \$300.00. Please debit any additional fee or credit any overpayment to the deposit account of the undersigned, Account No. 04-1425 and refer to our docket number 449126-8.

Respectfully submitted,

DORSEY & WHITNEY LLP

Attorneys for Petitioner  
1001 Pennsylvania Avenue, N.W.  
Suite 300 South  
Washington, D.C. 20004

Dated: December 4, 2001

By:   
Philip Baker-Shenk  
Rebecca L. Roby

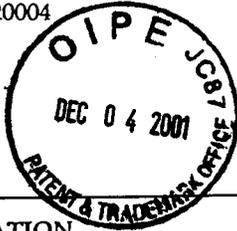
To: Assistant Commissioner for Trademarks  
**Trademark Trial + Appeal Board**  
 From: Dorsey & Whitney, LLP  
 1001 Pennsylvania Avenue NW; Suite 300 South  
 Washington, D.C., 20004  
 Tel. 202-824-8800



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2001-453

Dorsey & Whitney Filing Number



12/3/01  
 Filing Date

<p><b>DEPOSIT ACCOUNT AUTHORIZATION</b></p> <p><input type="checkbox"/> Please debit any other charges or credit any overpayment to Deposit Acct No. 04-1425 and cite our Ref. No. _____</p> <p><u>Rebecca L Roby</u>        Rebecca Roby (Kelsey)</p>	<p>Application/Registration No.: <u>1,667,579</u>        Trademark: <u>IN-SYNC PUBLICATIONS</u>        Client No.: <u>449126-8</u></p> <p>Express Mail No. _____</p>
<p> </p>	<p> </p>

The following items/fees are submitted herewith to the U.S. Patent & Trademark Office:

ITEMS	U.S. PTO FEES ENCLOSED
<input checked="" type="checkbox"/> Transmittal Sheet	_____ Filing Fee
<input type="checkbox"/> New U.S. ITU TM Application including, Declaration, Power of Attorney, Drawing Page, and Return Postcard	_____ New Application Fee
<input type="checkbox"/> Priority Document - Cert. copy of Application	_____ Recordation
<input type="checkbox"/> Request for Corrected Filing Receipt	_____ Extension Fee
<input type="checkbox"/> Amendment and Response	_____ Notice of Opposition Fee
<input type="checkbox"/> Request to Divide Application + Exhibit	_____ Petition to Cancel Fee
<input type="checkbox"/> Request for Extension of Time	_____ Petition to Revive Fee
<input type="checkbox"/> Declaration under §8 with <u>1</u> specimen per class	_____ Statement of Use Fee
<input type="checkbox"/> Declaration under §§ 8 & 15 incl. <u>1</u> specimen per class	_____ § 8 Affidavit Fee
<input type="checkbox"/> Renewal Application incl. specimen (1 per class)	_____ §§ 8 and 15 Affidavit Fee
<input type="checkbox"/> Assignment with Cover Sheet	_____ TM Renewal Application Fee
<input type="checkbox"/> Amendment to Allege Use or Statement of Use with _____ specimen per class	_____ Expedited Processing Fee
<input type="checkbox"/> Power of Attorney	_____ Amendment to Allege Use Fee
<input type="checkbox"/> Attorney's Change of Address	_____ Fee to Amend Mark
<input type="checkbox"/> Withdrawal of Application/Express Abandonment	_____ Request to Divide Application
<input type="checkbox"/> Petition to Revive	_____ Additional Class Fee
<input type="checkbox"/> Request to Remove Suspension	_____ No Fee
<input checked="" type="checkbox"/> Petition For Cancellation (2 copies)	<u>\$300</u> Total Fee (Deduct from Dep. Acct No. 04-1425)

CLASS-5 FILING

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