

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

BLACK DIAMOND PROPERTIES, INC.)
Petitioner,)
v.)
NEW FLORIDA PROPERTIES CORPORATION)
Registrant.)
_____)

CANCELLATION ACTION
NO. _____



06-30-2003

U.S. Patent & TMO/TM Mail Rpt Dt. #22

PETITION FOR CANCELLATION

BLACK DIAMOND PROPERTIES, INC., a Florida corporation, with its principal place of business at 2600 W. Black Diamond Circle, Lecanto, Florida 34461 (hereinafter "Petitioner") believes that it is and will be damaged by U.S. trademark Registration No. 2,087,938 for the mark **WHITE DIAMOND** as directed to "real estate development services," which issued on the Principal Register on August 12, 1997 to NEW FLORIDA PROPERTIES CORPORATION, a Florida corporation, whose address is 4775 Collins Avenue, Miami, Florida 33104 (hereinafter "Registrant"), and hereby petitions to cancel the registration of this mark for these services pursuant to Lanham Act Sec. 14, 15 U.S.C. §1064.

As grounds of cancellation, it is alleged that:

COUNT I

1. On April 17, 1998, Petitioner filed an application to register its mark **BLACK DIAMOND RANCH & DESIGN** (the "Application") with the U.S. Patent and Trademark

Office. This application attested to the Petitioner's use of the mark **BLACK DIAMOND RANCH & DESIGN** in interstate commerce on or in connection with "real estate development services" in International Class 37 since at least as early as 1986. The Application was assigned serial number 75/469,398.

2. In Office Actions dated August 24, 1998 and December 31, 2002, the U.S. Patent and Trademark Office has refused registration of the Application for the mark **BLACK DIAMOND RANCH & DESIGN** on the grounds that, in the Examining Attorney's view, confusion is likely between this mark and the Registrant's mark **WHITE DIAMOND** as directed to "real estate development services." Thus, Petitioner has been damaged by the Registrant's trademark registration in that the registration has impeded registration of Petitioner's mark **BLACK DIAMOND RANCH & DESIGN**.

3. Upon information and belief, Registrant has abandoned the mark contained in Registration No. 2,087,938.

4. If Registrant is permitted to continue to maintain its registration, the U.S. Patent and Trademark Office may continue to refuse to register Petitioner's mark **BLACK DIAMOND RANCH & DESIGN** as noted in paragraph 2, above.

WHEREFORE, Petitioner deems that it is or will be damaged by Registration No. 2,087,938 and prays that this registration be canceled pursuant to Lanham Act Sec. 14, 15 U.S.C. §1064.

COUNT II

5. Petitioner realleges and incorporates the allegations set forth in paragraphs 1 through 4 as though fully set forth herein.

6.. Since at least as early as 1986, Petitioner has provided real estate development services in interstate commerce in connection with its mark **BLACK DIAMOND RANCH & DESIGN**.

7. On information and belief, on June 21, 1993, Registrant filed its application to register the mark **WHITE DIAMOND** as applied to "real estate development services" in International Class 37 on the basis of intent to use. Subsequently, upon information and belief, Registrant submitted a Statement of Use on March 8, 1995, attesting to first use of the mark **WHITE DIAMOND** in interstate commerce in connection with said services on November 14, 1994.

8. Upon information and belief, at the time that the Registrant's application was filed, and at the time that Registrant first used its mark in commerce, Petitioner had continuously used and established priority rights in the mark **BLACK DIAMOND RANCH & DESIGN**.

9. Upon information and belief, through its continuous use of the mark **BLACK DIAMOND RANCH & DESIGN** and through its substantial investment of time, energy and resources, Petitioner had developed extensive goodwill in its mark when the Registrant's application was filed and prior to the first use of the mark **WHITE DIAMOND** by the Registrant. On information and belief, as a result, at the time Registrant filed its application, the

public had come to recognize Petitioner as the source of real estate development services in connection with the mark **BLACK DIAMOND RANCH & DESIGN**.

10. Upon information and belief, use of the Registrant's mark **WHITE DIAMOND** as applied to real estate development services as set forth in Registration no. 2,087,938 is likely to cause confusion with Petitioner's mark **BLACK DIAMOND RANCH & DESIGN** because the marks are confusingly similar in appearance, sound, meaning and commercial impression and are used in connection with the identical services offered by the Petitioner in connection with the Petitioner's mark **BLACK DIAMOND RANCH & DESIGN**.

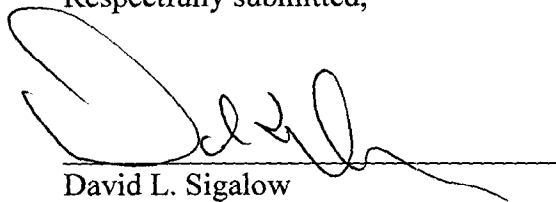
11. On information and belief, Petitioner has been and will be greatly damaged by such confusion because any defects, objections or faults found with the services performed by Registrant in connection with its mark **WHITE DIAMOND** will reflect negatively upon and seriously injure the reputation Petitioner has established for high quality services offered in connection with the mark **BLACK DIAMOND RANCH & DESIGN**. Upon information and belief, consumer confusion resulting from Registrant's use of the mark **WHITE DIAMOND** is likely to result in a loss of sales to Petitioner and damage its reputation.

12. In Office Actions dated August 24, 1998 and December 31, 2002, the U.S. Patent and Trademark Office has refused registration of the Application for the mark **BLACK DIAMOND RANCH & DESIGN** on the grounds that, in the Examining Attorney's view, confusion is likely between this mark and the Registrant's mark **WHITE DIAMOND** as directed to "real estate development services." Thus, despite having priority of use, Petitioner has been damaged by the Registrant's trademark registration in that the registration has impeded registration of Petitioner's mark **BLACK DIAMOND RANCH & DESIGN**.

WHEREFORE, Petitioner deems that it is or will be damaged by Registration No. 2,087,938 and prays that this registration be canceled pursuant to Lanham Act Sec. 14, 15 U.S.C. §1064.

A duplicate Petition for Cancellation is being filed herewith along with the filing fee as required in Section 2.61(e).

Respectfully submitted,



Date: June 27, 2003

David L. Sigalow
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRANSMITTAL FORM

Registrant: New Florida Properties Corporation

Docket No.: 35030

Reg. No.: 2,087,938

Mark: WHITE DIAMOND

Registered: August 12, 1997

Class(es): 37

Petitioner: Black Diamond Properties, Inc.



06-30-2003

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Enclosed herewith for filing in respect of the above-noted matter are:

1. Petition for Cancellation (in duplicate).
2. Check in the amount of \$300 (petition fee).
3. Postcard.
4. Duplicate copy of this letter.

The Commissioner is authorized to charge any amounts due or to credit any overpayment to our firm's Deposit Account No. 01-0484. **A duplicate copy of this letter is enclosed for such purpose.**

Respectfully submitted,

Date: June 27, 2003

David L. Sigalow
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CERTIFICATE OF MAILING

I HEREBY CERTIFY that the foregoing **PETITION FOR CANCELLATION** for the foregoing has been forwarded by U.S. Mail, postage paid, to the TTAB - FEE, Assistant Commissioner of Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, this 27th day of June 2003.

Theresa Andujar