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Filing date: **10/27/2006**

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

Proceeding	92045147
Party	Plaintiff Metro Q Metro Q  ,
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Submission	Motion to Amend Pleading/Amended Pleading
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Signature	/Kenneth R. Glaser/
Date	10/27/2006
Attachments	MetroQ Pet's Reply in Support of Motion to file 1st Amended Pet.pdf ( 7 pages ) (4285469 bytes )

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

METRO Q	§	
	§	
Petitioner,	§	
	§	
v.	§	Cancellation No. 92045147
	§	Registration No. 2,119,139
GAY & LESBIAN YELLOW PAGES, INC.,	§	
	§	
Respondent/Registrant.	§	

**PETITIONER'S REPLY IN SUPPORT OF MOTION FOR LEAVE TO  
FILE FIRST AMENDED PETITION AND FOR FILING CORRECTED  
FIRST AMENDED PETITION**

In Registrant's Response in opposition to Petitioner's motion for leave to file its first amended petition, among other grounds, Registrant contended that Petitioner lacked standing for failure to allege the specifics of how it is being damaged by the registration sought to be cancelled. While Petitioner contends that such damage is inherently contained in its original allegations, Petitioner recognized that the amended petition inadvertently omitted the paragraph giving specific details of the damage. Accordingly, since the Board has not yet ruled on Petitioner's motion, a corrected first amended petition for cancellation accompanies this Reply which includes the omitted paragraph 9. Given the history of this proceeding, however, Registrant cannot credibly argue that it had not had "fair notice" of this damage claim.

Registrant has also opposed the filing of Petitioner's first amended petition on the ground that it does not have "fair notice" of Petitioner's fourth ground for cancellation. Petitioner disagrees. The Lanham Act expressly recites that a mark is "abandoned" when "acts of omission" on the part of the trademark owner "causes the mark to become the generic name for the goods or services... or otherwise to lose its significance as a mark." 15 U.S.C. § 1127.

Paragraph 7 of Petitioner's proposed amended petition clearly gives fair notice of this fourth ground for cancellation—the widespread use of trade names essentially identical to Respondent's alleged mark and the failure or "omission" of Registrant to take action to avoid the mark's loss of significance, if any. It is incongruous for Registrant/Respondent to contend that it does not have "fair notice" of the reason for Petitioner's fourth ground while at the same time obviously having enough notice to deny this specifically pleaded reason.

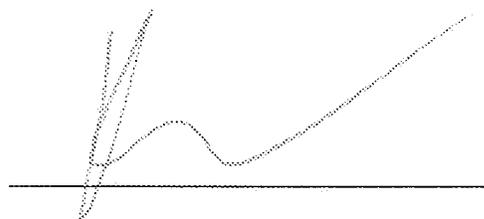
Petitioner also traverses Respondent's argument that Petitioner's fourth ground of cancellation is cumulative of the third ground. The third ground for cancellation relates to Respondent's granting of license and permission to others to use its registered mark without adequately controlling the nature and quality of the goods and services with which the mark has been used, thus constituting a legally prohibited "naked license." Thus, the third ground of abandonment pertains to acts of commission, resulting in the registered mark being abandoned, while the fourth ground relates to acts of omission.

Accordingly, Petitioner prays that its motion be granted and its corrected First Amended Petition for Cancellation of Registration 2,119,139 be filed.

Respectfully submitted,

Date: \_\_\_\_\_

10/21/06



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CERTIFICATE OF SERVICE

This is to certify that on the 27<sup>th</sup> day of October, 2006, a true and correct copy of the above and foregoing document was served via U.S. Mail and by facsimile to counsel for Registrant as follows:

John S. Egbert  
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\_\_\_\_\_  
Lisa R. Hemphill

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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

METRO Q	§	
	§	
Petitioner,	§	
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v.	§	Cancellation No. 92045147
	§	Registration No. 2,119,139
GAY & LESBIAN YELLOW PAGES, INC.,	§	
	§	
Respondent/Registrant.	§	

(Corrected) **FIRST AMENDED PETITION FOR  
CANCELLATION OF REGISTRATION 2,119,139**

Petitioner, MetroQ (“Petitioner”), hereby files this its first amended petition for cancellation, as follows:

1. Petitioner believes and alleges that it is being damaged by Registration No. 2,119,139 and hereby petitions to cancel the same for the reasons set out hereinafter.

2. Based upon the records of the Patent and Trademark Office, Respondent Gay & Lesbian Yellow Pages, Inc. is the owner of Registration No. 2,119,139 of GAY YELLOW PAGES for telephone directories and related advertising services directed at various gay and lesbian communities and markets nationwide (“Respondent’s Mark”).

**First Ground for Cancellation – Registered Mark is Generic.**

3. The term GAY YELLOW PAGES is a generic name for the goods and services for which it was registered. Therefore, it is not now, nor was it ever, subject to proper registration, and is subject to cancellation pursuant to 15 U.S.C. § 1064(3).

## Second Ground for Cancellation – Fraudulent Oaths.

4. Registration No. 2,119,139 was fraudulently obtained, in that Respondent knowingly filed a series of false declarations in connection with its application for registration of Respondent's Mark, which were relied upon by the Patent and Trademark Office. Specifically, on May 6, 1996, Respondent executed an erroneous Declaration ("First Declaration") which was filed on July 1, 1996 with the application for registration of the GAY YELLOW PAGES mark. The First Declaration stated that to the best of Respondent's knowledge, "no other person, firm, corporation or association" had the right to use Gay Yellow Pages, in commerce, "either in the identical form thereof or such near resemblance thereto as to be likely...to cause confusion..." Respondent has complained of Petitioner's use of the term "Gay Pages," contending that "Gay Pages" is essentially identical to "Gay Yellow Pages." The First Declaration was therefore false in that, contrary to Respondent's sworn representation to the Trademark Office, other business entities were in fact using not only "Gay Pages", but also "Gayellow Pages," and such entities were known by Respondent to be operating with those names at the time this First Declaration was executed. Respondent therefore knew its sworn statement to be false at the time it was made, and thereafter.

5. Additionally, following the rejection of the application for the present registration by the examining attorney, Respondent filed a second false Declaration ("Second Declaration"), executed June 24, 1997, swearing under oath that Respondent's use of Gay Yellow Pages had been substantially exclusive for a period of five years preceding the date of the second Declaration. Contrary to that assertion, however, Respondent was aware at the time of numerous business entities bearing the names "gay pages" and "*gayellow pages*", as well as names similar thereto.

**Third Ground for Cancellation – Abandonment for Lack of Control of Mark.**

6. Upon information and belief, the Respondent has permitted the use of the GAY YELLOW PAGES mark by others, but has failed to adequately control the quality and nature of the goods and services with which such mark has been used. Accordingly, the Respondent has legally abandoned the GAY YELLOW PAGES mark.

**Fourth Ground for Cancellation – Abandonment for Failure to Monitor Marketplace.**

7. Since at least as early as the date of Registration No. 2,119,139, a plethora of companies have commenced business, and are continuing to conduct business, under trade names essentially the same or deceptively similar to Respondent's Mark made the subject of Registration No. 2,119,139. Upon information and belief, Respondent has omitted taking any and/or sufficient action to prevent this proliferation.

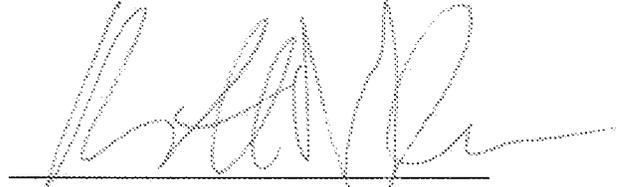
8. As a consequence of Respondent's omissions, Respondent's Mark has become the generic name for the goods and services of Registration No. 2,119,139 and/or has otherwise lost any significance as an enforceable mark. Respondent's Mark has therefore become abandoned.

**Damage**

9. Petitioner is being damaged by Registration No. 2,119,139. Specifically, Petitioner is using the phrase "Gay Pages" to identify an on-line directory that it is publishing. Respondent, relying principally upon its registered mark sought to be cancelled herein, has threatened Petitioner with legal action if it continues to use such phrase, contending that Petitioner's use of "Gay Pages" is an infringement of Respondent's alleged rights in its registered "Gay Yellow Pages" trademark. Therefore, Registration No. 2,119,139 is a threat to Petitioner's (and others) right to use this descriptive/generic term.

WHEREFORE, by reason of the aforementioned grounds, Petitioner prays that, pursuant to the authority of 15 U.S.C. 1064, this cancellation petition be granted and that the above-identified registration of Respondent, Registration No. 2,119,139, be canceled.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "K. R. Glaser", is written over a solid horizontal line.

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