

ESTTA Tracking number: **ESTTA285634**

Filing date: **05/22/2009**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Couch/Braunsdorf Affinity, Inc.		
Entity	Corporation	Citizenship	New Jersey
Address	2561 Territorial Road St. Paul, MN 55114 UNITED STATES		

Attorney information	Philip A. Jones Brinks Hofer Gilson & Lione P.O. Box 10395 Chicago, IL 60610 UNITED STATES officeactions@brinkshofer.com, pjones@brinkshofer.com Phone:312-321-4200		
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Registration Subject to Cancellation

Registration No	3355480	Registration date	12/18/2007
Registrant	12 Interactive, LLC Suite 144 3501 N. Southport Avenue Chicago, IL 60657 UNITED STATES		

Goods/Services Subject to Cancellation

Class 035. First Use: 2006/08/00 First Use In Commerce: 2006/08/00 All goods and services in the class are cancelled, namely: administration of a program for enabling participants to obtain discounts from retailers and service providers

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	1786961	Application Date	11/16/1990
Registration Date	08/10/1993	Foreign Priority Date	NONE
Word Mark	PERKS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1988/03/24 First Use In Commerce: 1988/03/24		

	providing volume discount buying services to others		
U.S. Registration No.	2580914	Application Date	05/17/2000
Registration Date	06/18/2002	Foreign Priority Date	NONE
Word Mark	PERKSCARD		
Design Mark	PERKSCARD		
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1997/05/00 First Use In Commerce: 1997/05/00 Buying services, namely, providing volume discounts for consumer products and services		
U.S. Registration No.	3210654	Application Date	10/21/2005
Registration Date	02/20/2007	Foreign Priority Date	NONE
Word Mark	PERKS		
Design Mark	Perks		
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1988/03/24 First Use In Commerce: 1988/03/24 Buying services, namely, providing volume discounts for consumer products and services via a magnetically encoded card		
U.S. Registration No.	3156685	Application Date	04/11/2005
Registration Date	10/17/2006	Foreign Priority Date	NONE
Word Mark	PERKSCARD		

Design Mark	<h1>PerksCard</h1>
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 1997/01/05 First Use In Commerce: 1997/01/05 Buying services, namely, providing volume discounts for consumer products and services

Attachments	76051909#TMSN.gif (1 page)(bytes) 78737799#TMSN.jpeg (1 page)(bytes) 78606012#TMSN.jpeg (1 page)(bytes) Perks_1.PDF (10 pages)(281830 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Philip A.Jones/
Name	Philip A. Jones
Date	05/22/2009

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

COUCH/BRAUNSDORF AFFINITY, INC.)	
)	
Petitioner,)	Cancellation No. _____
)	
v.)	Reg. No. 3,355,480
)	
12 INTERACTIVE, LLC)	
)	
Registrant.)	

PETITION FOR CANCELLATION

Couch/Braunsdorf Affinity, Inc. (“Perks”), a corporation duly organized and existing under the laws of the State of New Jersey, with its principal place of business in St. Paul, Minnesota, believes it is being damaged by the existing registration for the mark PERKSPOT, Reg. No. 3,355,480, (the “Registered Mark”) owned by **12 Interactive, LLC**, 4611 N. Ravenswood Avenue, Suite 204, Chicago, IL 60640 or 3501 N. Southport Avenue, Suite 144, Chicago, IL 60657 (“Registrant”), and therefore petitions for cancellation of the Registered Mark pursuant to 15 U.S.C. §1064. In support of this Petition, Perks states as follows:

1. Perks is a leading business in the affinity and promotional industry, providing volume discounts for consumer products and services to others. Perks owns and uses in commerce, the distinctive service marks PERKS and PERKSCARD in connection with these services.
2. Perks contracts with employers to negotiate discounts and services offered by third parties for employees. Perks provides discount cards under the PERKSCARD mark to employees that may be utilized at third party businesses or over the internet. For example, employees may receive discounts on food, clothing, trips, day care and medical benefits.

3. Over the past 20 years, Perks has grown its business. Perks now has contracts with many national employers. Perks has distributed millions of PERKSCARD discount cards nationwide to employees.

4. PERKS has been used in commerce since at least as early as March 24, 1988, and has been used continuously in commerce since that date. PERKSCARD has been used in commerce since at least as early as May 1997, and has been used continuously in commerce since that date.

5. Perks has invested considerable money, time and effort into the development of the PERKS and PERKSCARD marks. These marks have become assets of incalculable value for Perks as immediately recognizable and well-known indicators of source of the company's high quality services, or at least a single source for the services.

6. Perks owns a number of federal trademark registrations for the PERKS and PERKSCARD marks as set forth below:

Mark	Reg. No.	Reg. Date	Goods/Services
PERKS	1,786,961	August 10, 1993	Providing volume discount buying services to others
PERKSCARD	2,580,914	June 18, 2002	Buying services, namely, providing volume discounts for consumer products and services
PERKS	3,210,654	February 20, 2007	Buying services, namely, providing volume discounts for consumer products and services via a magnetically encoded card
PERKSCARD	3,156,685	October 17, 2006	Buying services, namely, providing volume discounts for consumer products and services

7. Copies of the federal registration certificates for the above-referenced marks are attached as Exhibit 1. These federal registrations are valid, subsisting and in full force and effect. Perks' federal registration certificates are prima facie evidence of the validity of

these marks as well as Perks' ownership and exclusive right to use these marks in connection with the identified services. 15 U.S.C. § 1057(b).

8. Perks' right to use in commerce PERKS and PERKSCARD is incontestable pursuant to 15 U.S.C. § 1065.

9. Registrant owns U.S. Service Mark Reg. No. 3,355,480, for the mark PERKSPOT. Upon information and belief, Registrant is an Illinois Limited Liability Company, with its principal place of business in Chicago, Illinois.

10. After Perks first used the PERKS and PERKSCARD marks, and after the PTO issued federal registrations for the PERKS and PERKSCARD marks, Registrant adopted and first used the PERKSPOT mark in connection with a service of providing volume discounts for consumer products and services to others.

11. After Perks first used the PERKS and PERKSCARD marks, and after the PTO issued federal registrations for PERKS and PERKSCARD marks, Registrant applied to register the PERKSPOT mark, Serial No. 77/142,966. This application matured into the Registration, and has an identification of services which reads "administration of a program for enabling participants to obtain discounts from retailers and service providers" in Class 35.

12. At the time it adopted, first used, and filed its application for PERKSPOT, Registrant had constructive knowledge of Perks' rights in its PERKS and PERKSCARD marks, and, upon information and belief, had actual knowledge of Perks' use of the PERKS and PERKSCARD marks.

13. Perks has priority of use over Registrant.

14. Perks and Registrant offer similar services, and are competitors in the marketplace.

15. PERKSPOT is confusingly similar to the PERKS and PERKSCARD marks. The Registration and use of PERKSPOT by Registrant in association with the identified services is likely to cause confusion as to the source or origin of Registrant's services, and is likely to mislead consumers, all to Perks' damage.

16. PERKSPOT, as used in connection with the identified services, is likely to cause confusion in the minds of the public, and is likely to deceive purchasers. The relevant public, upon seeing PERKSPOT in connection with Registrant's services, is likely to believe that such services originate with, or have some connection with, Perks, when that is not the case. Perks is aware of at least one instance which it believes to represent actual confusion. Accordingly, the Registration is seriously damaging Perks, and the Registration therefore should be cancelled pursuant to 15 U.S.C. §1052(d).

WHEREFORE, Perks believes that it is being damaged by the Registration, Reg. No. 3,355,480, and therefore respectfully requests that the Registration be cancelled on the grounds of likelihood of confusion.

The Director hereby is authorized to charge the filing fee for this Petition of Cancellation to Deposit Account No. 23-1925.

Respectfully submitted,

COUCH/BRAUNSDORF AFFINITY GROUP, INC.

Dated: 5-22-09 By: /Philip A. Jones/

Philip A. Jones
BRINKS HOFER GILSON & LIONE
P.O. Box 10395
Chicago, IL 60610
(312) 321-4200

Attorney for Petitioner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of the foregoing **PETITION FOR CANCELLATION**, was served on opposing counsel by first class mail on this 22ND day of May, 2009, addressed as follows:

12 Interactive, LLC
Suite 144
3501 N. Southport Avenue
Chicago, IL 60657

12 Interactive, LLC
4611 N. Ravenswood Avenue
Suite 204
Chicago, IL 60640

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Neal, Gerber & Eisenberg
Two North LaSalle Street
Chicago, IL 60602-3801

/Philip A. Jones/

EXHIBIT 1

Int. Cl.: 35

Prior U.S. Cl.: 101

United States Patent and Trademark Office

Reg. No. 1,786,961

Registered Aug. 10, 1993

**SERVICE MARK
PRINCIPAL REGISTER**

PERKS

PERKS UNLIMITED, INC. (NEW YORK COR-
PORATION)
153 MAIN STREET
SAYVILLE, NY 11782

FOR: PROVIDING VOLUME DISCOUNT
BUYING SERVICES TO OTHERS, IN CLASS 35
(U.S. CL. 101).

FIRST USE 3-24-1988; IN COMMERCE
3-24-1988.

SER. NO. 74-116,046, FILED 11-16-1990.

G. MAYERSCHOFF, EXAMINING ATTORNEY

Int. Cl.: 35

Prior U.S. Cls.: 100, 101 and 102

United States Patent and Trademark Office

Reg. No. 2,580,914

Registered June 18, 2002

**SERVICE MARK
PRINCIPAL REGISTER**

PERKSCARD

PERKS UNLIMITED, INC. (NEW YORK COR-
PORATION)
565 ROUTE 25A
MILLER PLACE, NY 117642600

FOR: BUYING SERVICES, NAMELY, PROVID-
ING VOLUME DISCOUNTS FOR CONSUMER PRO-
DUCTS AND SERVICES, IN CLASS 35 (U.S. CLS. 100,
101 AND 102).

FIRST USE 5-0-1997; IN COMMERCE 5-0-1997.

OWNER OF U.S. REG. NO. 1,786,961.

SER. NO. 76-051,909, FILED 5-17-2000.

NICHOLAS ALTREE, EXAMINING ATTORNEY

Int. Cl.: 35

Prior U.S. Cls.: 100, 101 and 102

United States Patent and Trademark Office

Reg. No. 3,210,654

Registered Feb. 20, 2007

**SERVICE MARK
PRINCIPAL REGISTER**

Perks

COUCH BRAUNSDORF/AFFINITY, INC. (NEW
JERSEY CORPORATION)
701 MARTINSVILLE ROAD
LIBERTY CORNER, NJ 07938

FOR: BUYING SERVICES, NAMELY, PROVID-
ING VOLUME DISCOUNTS FOR CONSUMER PRO-
DUCTS AND SERVICES VIA A MAGNETICALLY
ENCODED CARD, IN CLASS 35 (U.S. CLS. 100, 101
AND 102).

FIRST USE 3-24-1988; IN COMMERCE 3-24-1988.

THE MARK CONSISTS OF STANDARD CHAR-
ACTERS WITHOUT CLAIM TO ANY PARTICULAR
FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 1,786,961, 2,580,914,
AND 3,045,459.

SER. NO. 78-737,799, FILED 10-21-2005.

ESTHER A. BORSUK, EXAMINING ATTORNEY

Int. Cl.: 35

Prior U.S. Cls.: 100, 101 and 102

United States Patent and Trademark Office

Reg. No. 3,156,685

Registered Oct. 17, 2006

**SERVICE MARK
PRINCIPAL REGISTER**

PerksCard

COUCH/BRAUNSDORF AFFINITY, INC. (NEW
JERSEY CORPORATION)
701 MARTINSVILLE ROAD
LIBERTY CORNER, NJ 07938

FOR: BUYING SERVICES, NAMELY, PROVID-
ING VOLUME DISCOUNTS FOR CONSUMER PRO-
DUCTS AND SERVICES, IN CLASS 35 (U.S. CLS. 100,
101 AND 102).

FIRST USE 1-5-1997; IN COMMERCE 1-5-1997.

THE MARK CONSISTS OF STANDARD CHAR-
ACTERS WITHOUT CLAIM TO ANY PARTICULAR
FONT, STYLE, SIZE, OR COLOR.

SER. NO. 78-606,012, FILED 4-11-2005.

HOWARD SMIGA, EXAMINING ATTORNEY