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Filing date: **03/21/2011**

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

Proceeding	92053547
Party	Plaintiff VER Sales, Inc.
Correspondence Address	JESSIE K REIDER BUCHALTER NEMER 1000 WILSHIRE BOULEVARD, SUITE 1500 LOS ANGELES, CA 90017 UNITED STATES jreider@buchalter.com, trademark@buchalter.com
Submission	Motion to Amend Pleading/Amended Pleading
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Filer's e-mail	trademark@buchalter.com
Signature	/jkr/
Date	03/21/2011
Attachments	VER First Amended and Restated Petition for Cancellation.PDF ( 19 pages ) (557476 bytes )

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

In the Matter of Registration No. 3025887  
For the Mark VER  
Filed on September 23, 2004  
Issued on December 13, 2005

VER Sales, Inc.,	)	
	)	
Petitioner	)	Cancellation No. 92053547
	)	
v.	)	Registration No. 3,025,887
	)	
Full Throttle Films, Inc.,	)	Mark: VER (words only)
	)	
Registrant.	)	

**FIRST AMENDED AND RESTATED PETITION FOR CANCELLATION**

VER Sales, Inc., a corporation organized and existing under the laws of the State of California with a principal place of business of 2509 N. Naomi Street, Burbank, California, 91504 (hereinafter "Petitioner") believes that it will be damaged by the continued registration of the above identified trademark registration in the name of Full Throttle Films, Inc., a corporation organized under the laws of the State of California with a registered place of business of 912 Ruberta Avenue, Glendale, California 91201 (hereinafter "Registrant") and hereby petitions to cancel the same.

As grounds for this petition, it is alleged that:

1. Petitioner, and through its predecessors in interest and related companies, has used the VER mark, and stylized versions thereof, in connection with wholesale, rental, retail and online retail store services featuring safety, construction, theatrical, mountain climbing, hardware, entertainment and specialty equipment and supplies; custom manufacture of safety,

construction, theatrical, hardware, entertainment and specialty equipment and supplies (hereinafter "Petitioner's Mark"). Petitioner has used the VER mark in connection with these services since as early as 1972.

2. Petitioner's use of the VER mark has been continuous since its first use of the VER mark in 1972.

3. Petitioner owns extensive common law rights in and to Petitioner's Mark.

4. In addition to use of the VER trademark, Petitioner's corporate persona and identity is as VER Sales and/or VER. Petitioner has been incorporated as a California limited liability company since as early as 1972 under "Ver Sales, Inc." A copy of Petitioner's corporate status is attached as Exhibit A.

5. Petitioner holds itself out to consumers as "Ver", including through its website and its signage. Printouts reflecting Petitioner's corporate identity as "Ver" are attached as Exhibit B.

6. Petitioner has held itself out to the public as Ver for so long that consumers are likely to recognize and associate Petitioner, as an entity, as "Ver".

7. Consumers recognize Petitioner as "Ver", as evidenced by the communications between Petitioner and its customers.

8. On November 29, 2010, Petitioner filed an application to register Petitioner's mark, Serial No. 85/186,727. On November 29, 2010, Petitioner also filed an application to

register the VER and DESIGN mark, Serial No. 85/188,635 (together, collectively, “Petitioner’s Applications”).

9. Petitioner has promoted, marketed and provided services throughout the United States and has developed valuable goodwill in and to Petitioner’s Mark.

10. Petitioner has expended considerable effort and expense in promoting Petitioner’s Mark, and, as a result, the purchasing public has come to recognize Petitioner’s Mark as indicative of the services provided by Petitioner.

11. Petitioner has developed and maintained a loyal customer base, all of whom recognize Petitioner as the source of the services marketed under Petitioner’s Mark.

12. Due to Petitioner’s long and successful use of Petitioner’s Mark, the mark has achieved a position of recognition and fame.

13. Notwithstanding Petitioner’s prior rights in and to the VER mark, Registrant has obtained United States Trademark Registration No. 3025887 for the VER mark for *rental of equipment, namely, broadcast equipment* in Class 038 and *rental of equipment, namely, audio, video and camera equipment* in Class 041. The registration issued on December 13, 2005 and claims a first use date of September 1990 for both classes of services. A copy of that Certificate of Registration is attached hereto as Exhibit C.

14. Petitioner’s use of Petitioner’s Mark is prior to Registrant’s use of Registrant’s VER mark. As such, Petitioner is the senior user and entitled to registration of Petitioner’s Mark.

15. In the past several years, there have been instances of actual confusion between the services offered by Registrant and the services offered by Petitioner, both under the VER mark.

16. Instances of actual confusion include, *inter alia*, Petitioner's receipt of payment for services rendered by Registrant, issued by Registrant's customers and Petitioner's receipt of phone calls and additional correspondence meant for Registrant.

17. In 2011 alone, Petitioner has received over \$1200 in payments to its bank account for services rendered by Registrant, from Registrant's customers. Registrant has not taken any action to stop the consumer confusion.

18. The instances of actual confusion between Petitioner's Mark and Registrant's VER mark have recently increased.

19. Registrant admits that Registrant's VER mark and Petitioner's VER marks, in connection with the relevant services, are confusingly similar.

20. Registrant makes no claim that its use of the VER mark predates Petitioner's first use.

21. Registrant initially used the mark VIDEO EQUIPMENT RENTALS. Registrant also used the mark VER VIDEO EQUIPMENT RENTALS as a composite mark. Registrant changed its mark to VER after becoming aware of Petitioner's use of the VER mark and to use Applicant's goodwill in the VER mark to Registrant's advantage.

22. Registrant expanded the services it offers once it became aware of the demand for services similar to Petitioner's services. Upon information and belief, Registrant became aware of the demand for additional services based on misdirected communications meant for Petitioner.

23. Registrant used and uses the VER mark to take advantage of the consumer base created by Petitioner and to mislead those consumers as to the source of services.

24. Registrant's registration for the VER mark is being used by Registrant so as to misrepresent the source of the services on or in connection with which the VER mark is used.

25. Registrant's VER mark is identical to Petitioner's previously used corporate name, identity and/or corporate persona, "Ver", and Registrant's use of the VER mark is likely to create a false connection with Petitioner's identity or corporate persona.

26. Registrant's VER mark is a simulation of Petitioner's corporate identity. When the VER mark is used on Registrant's services, a connection with Petitioner will be presumed by consumers.

27. Consumers' false association between Petitioner and Registrant is evidenced by the number of payments issued to Petitioner by Registrant's customers. Registrant's customers believe that there is an association and/or connection between Petitioner and Registrant.

28. Registrant has blatantly and aggressively misused Petitioner's mark in order to trade on Petitioner's goodwill.

29. Registrant has an intent to trade on the goodwill associated with Petitioner's VER marks.

30. Registrant's misuse of the VER mark is evidenced by Registrant's unwillingness to change its mark in spite of misdirected payments, and potential lost revenue. Petitioner works in good faith to identify any misdirected funds, but fears that Registrant's ongoing use of Petitioner's mark will lead to incorrect payments made to both Registrant and Petitioner.

31. Registrant's failure to mitigate actual confusion based on use of the VER mark is evidence of Registrant's bad faith intent to profit from Petitioner's goodwill.

32. Registrant's business dealings with consumers confused as to the source of services is evidence of Registrant's misuse of Petitioner's marks.

33. Registrant is deliberately using the VER mark in such manner in order to blur the distinctions which may have previously existed between the marks and services of the parties, including Registrant's previous use of "Video Equipment Rental," so as to confuse and deceive purchasers.

34. Petitioner further seeks cancellation of Registration No. 3025887 based on fraud. Registration No. 3025887 was obtained fraudulently in that the formal application papers filed by Registrant, under notice of Section 1001 of Title 18 of the United States Code, stated that the Registrant:

...to the best of his/her knowledge and belief no other person, firm corporation or association has the right to use the mark in commerce, either in identical form thereof or in such near resemblance thereto as to be likely, when used in connection with the goods/services of such other person, firm, corporation, or association to cause confusion, or to cause mistake, or to deceive...

35. Said statement was made by an officer of Registrant, Registrant's President, Scott Dundee, on September 13<sup>th</sup>, 2004, with the intent to induce agents of the United States Patent and Trademark Office to grant said registration, and, reasonably relying upon the truth of said false statement, the United States Patent and Trademark Office did, in fact, grant such registration.

36. Prior to filing of the application, Registrant was aware of Petition and Petitioner's business. Registrant had attended the same trade shows as Petitioner and had discussed Petitioner's brand with Petitioner. Notwithstanding such knowledge, Petitioner submitted a sworn statement that there were no other entities with the right to use VER.

37. To the best of Petitioner's knowledge, Registrant had knowledge of Petitioner's mark and of Petitioner's prior use of the VER mark in commerce. To the best of Petitioner's knowledge, at the time the application for Registrant's VER mark was filed, Registrant knew that Petitioner had the superior right to use the VER mark.

38. The representations made by Registrant on September 14<sup>th</sup>, 2004 were false.

39. Registrant knew that the representations were false.

40. Registrant knowingly made a material misrepresentation to the Trademark Office to procure a registration for Registrant's VER mark.

41. Registrant intended to deceive the Trademark Office.

42. The Trademark Office relied on the representations when issuing a registration for Registrant's VER mark.

43. The Trademark Office would not have registered Registrant's VER mark but for the misrepresentation.

44. Registrant's actions in the filing of Registrant's application to register the VER constitute fraud *ab initio*, thereby invalidating Registrant's registration for the VER mark. Accordingly, Registrant's registration for the VER mark should be struck from the register in its entirety.

45. If Registrant is permitted to retain the registration sought to be cancelled herein, Petitioner will be damaged by such registration, as the ongoing existence of the registration would support and assist Registrant in use of the VER mark that is the subject of the registration, and thereby create further confusion, in addition to the actual confusion already present in the marketplace.

46. If Registrant is permitted to retain the registration sought to be cancelled herein, Petitioner may also be damaged by virtue of its inability to register its trademarks. Petitioner has much to be gained in being granted a federal trademark registration for use of Petitioner's Mark. The ongoing inability of Petitioner to do so will cause direct and irreparable damage to Petitioner, effectively limiting Petitioner's ability to protect and enforce its valuable trademark.

47. If Registrant is permitted to retain the registration sought to be cancelled herein, Petitioner will be damaged by such Registration, as the ongoing existence of the registration would support and assist registrant in use of the VER mark that is the subject of the registration, and thereby dilute Petitioner's rights in Petitioner's Mark.

48. Registrant's use and registration of the VER mark interferes with Petitioner's Mark and will damage Petitioner, its business and its goodwill.

WHEREFORE, Petitioner deems that it is now and will continue to be damaged by Registration No. 3,025,887 and seeks cancellation of the same.

Please direct all correspondence relating to this matter to the undersigned attorney for Petitioner. The Patent and Trademark Office is authorized to charge any relevant filing fees to Deposit Account No. 500977.

Respectfully Submitted,

**VER Sales, Inc.**



Jessie K. Reider  
Attorney for Petitioner  
Buchalter Nemer  
1000 Wilshire Blvd., Suite 1500  
Los Angeles, California 90017  
Phone: 231.891.5031  
Fax: 213.630.5745  
Email: [trademark@buchalter.com](mailto:trademark@buchalter.com)

Dated: March 21, 2011

**CERTIFICATE OF SERVICE**

Petitioner VER Sales, Inc., hereby certifies that a copy of this FIRST AMENDED AND RESTATED PETITION FOR CANCELLATION has been served upon the attorney of record for Cancellation Number 92053547, on this 21<sup>st</sup> day of March, 2011, by First Class U.S. Mail, at the following address:

George Tseng  
Arent Fox LLP  
555 West Fifth Street, 48th Floor  
Los Angeles CA 90013-1065



Jessie K. Reider  
Attorney for Petitioner

## **EXHIBIT A**



**Business Entities (BE)**

Online Services

- **Business Search**
- **Disclosure Search**
- **E-File Statements**
- **Processing Times**

**Main Page**

**Service Options**

**Name Availability**

**Forms, Samples & Fees**

**Annual/Biennial Statements**

**Filing Tips**

**Information Requests**  
(certificates, copies & status reports)

**Service of Process**

**FAQs**

**Contact Information**

Resources

- **Business Resources**
- **Tax Information**
- **Starting A Business**
- **International Business Relations Program**

**Customer Alert**

(misleading business solicitations)

**Business Entity Detail**

Data is updated weekly and is current as of Friday, March 18, 2011. It is not a complete or certified record of

<b>Entity Name:</b>	VER SALES, INC.
<b>Entity Number:</b>	C0669816
<b>Date Filed:</b>	11/27/1972
<b>Status:</b>	ACTIVE
<b>Jurisdiction:</b>	CALIFORNIA
<b>Entity Address:</b>	2509 N NAOMI ST
<b>Entity City, State, Zip:</b>	BURBANK CA 91504
<b>Agent for Service of Process:</b>	PAUL RYAN
<b>Agent Address:</b>	2509 N NAOMI ST
<b>Agent City, State, Zip:</b>	BURBANK CA 91504

\* Indicates the information is not contained in the California Secretary of State's database.

- If the status of the corporation is "Surrender," the agent for service of process is automatically revoked. Corporations Code **section 2114** for information relating to service upon corporations that have surrendered.
- For information on checking or reserving a name, refer to **Name Availability**.
- For information on ordering certificates, copies of documents and/or status reports or to request a more **Information Requests**.
- For help with searching an entity name, refer to **Search Tips**.
- For descriptions of the various fields and status types, refer to **Field Descriptions and Status Definitions**.

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**EXHIBIT B**



Learn more about what VER SALES, INC. can do for you by watching our video.

# VER SALES, INC.

2509 N. Naomi St. Burbank, Ca. 91504  
(800) 229-0518 · (818) 567-3000 · Fax: (818) 567-3018

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- Bungee
- Cable Ties
- Chain
- Duracell Batteries
- Fall Protection
- Fittings
- Fittings
- Nicopress
- Rops
- Safety Cables
- Setwear Gloves
- Slings
- Span Sets
- Tape
- Theatrical Supplies
- Other Items

#### Latest News

Welcome to VER Sales Inc. new online store

#### Visit Our Other Sites



Thank you for visiting [www.versalestore.com](#). VER Sales Inc's online store. VER Sales Is your complete source for Rigging, Chain, Nicopress Tools & Sleeves, Fall Protection, Turnkey Engineered Systems, Custom Cable Assemblies, Bungee Cord, Bungee Assemblies, Safety Supplies, and much more. If you are unable to find what you are looking for, then give us a call us at 800-229-0518 or 1-800-300-WIRE (California Residents) for all your custom applications, large quantity discounts, or any other technical or products related questions you may have. We don't list everything we stock in our warehouses on our website. You can also email us at [support@versalestore.com](mailto:support@versalestore.com)



Felco Cutters



Sale





### Holiday Gifts



**Felco C7 Wire Rope & Cable Cutter** ~~Hot~~ **New!**

[More Info...](#)

Product ID: TOOLS-FELCO-C7

Our Price **\$52.75** Each

[Add to Wishlist](#)

Quantity  **ADD TO CART**



**Saint LED Surefire Headlamp (Black)** ~~Hot~~

[More Info...](#)

Product ID: FL-SF-HS1-A-BK

Our Price **\$200.00** Each

[Add to Wishlist](#)

Quantity  **ADD TO CART**



**Saint Minimus LED Surefire Headlamp (Black)** ~~Hot~~

[More Info...](#)

Product ID: FL-SF-HS2-A-BK

Our Price **\$139.00** Each

[Add to Wishlist](#)

Quantity  **ADD TO CART**



**6P LED Surefire Flashlight (Black)** ~~Hot~~

[More Info...](#)

Product ID: FL-SF-6PL-BK

**Single-Output LED**

Our Price **\$89.00** Each

[Add to Wishlist](#)

Quantity  **ADD TO CART**



**6P Original Surefire Flashlight (Black)** ~~Hot~~

[More Info...](#)

Product ID: FL-SF-6P-BK

**Single-Output Incandescent**

Our Price **\$62.00** Each

[Add to Wishlist](#)

Quantity  **ADD TO CART**



**Felco C9 Wire Rope & Cable Cutter** ~~Hot~~ **New!**

[More Info...](#)

Product ID: TOOLS-FELCO-C9

Our Price **\$117.72** Each

[Add to Wishlist](#)

Quantity  **ADD TO CART**



**6PX Tactical Surefire Flashlight (Black)** ~~Hot~~

[More Info...](#)

Product ID: FL-SF-6PX-A-BK

Our Price **\$69.00** Each

[Add to Wishlist](#)

Quantity  **ADD TO CART**



**Felco C12 Wire Rope & Cable Cutter** ~~Hot~~ **New!**

[More Info...](#)

Product ID: TOOLS-FELCO-C12

Our Price **\$195.50** Each

[Add to Wishlist](#)

Quantity  **ADD TO CART**



Tan Leather Setwear Gloves - SWP-09-007 thru 012 ~~40%~~

More Info...

- Pro Leather Glove
- One Tough Glove
- High Grade Leather

Our Price **\$39.95** Per Pair

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Select Your Size

Quantity

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## **EXHIBIT C**

**Int. Cls.: 38 and 41**

**Prior U.S. Cls.: 100, 101, 104 and 107**

**United States Patent and Trademark Office**

**Reg. No. 3,025,887**

**Registered Dec. 13, 2005**

**SERVICE MARK  
PRINCIPAL REGISTER**

**VER**

FULL THROTTLE FILMS, INC. (CALIFORNIA CORPORATION)  
912 RUBERTA AVENUE  
GLENDALE, CA 91201

FIRST USE 9-0-1990; IN COMMERCE 9-0-1990.

FOR: RENTAL OF EQUIPMENT, NAMELY, BROADCAST EQUIPMENT, IN CLASS 38 (U.S. CLS. 100, 101 AND 104).

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

FIRST USE 9-0-1990; IN COMMERCE 9-0-1990.

SER. NO. 76-613,615, FILED 9-23-2004.

FOR: RENTAL OF EQUIPMENT, NAMELY, AUDIO, VIDEO, AND CAMERA EQUIPMENT, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

JENNIFER KRISP, EXAMINING ATTORNEY