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TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Alexandria, VA 22313-1451
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DM/GMM

Mailed: August 12, 2015

Cancellation No. 92054683

The Hispanic National Bar Association, Inc.

v.

The Hispanic National Bar Foundation, Inc.

**Before Richey, Deputy Chief Administrative Trademark Judge,
and Mermelstein and Bergsman, Administrative Trademark Judges:**

This case comes before the Board for consideration of Respondent's April 17, 2015, response to the Board's order requiring Respondent to show cause why the cancellation of its subject registrations pursuant to Section 8 of the Trademark Act should not be deemed the equivalent of a cancellation by request of Respondent without the consent of Petitioner and should not result in entry of judgment against Respondent. The matter has been fully briefed.

Petitioner's initial petition for cancellation, filed on October 19, 2011, sought cancellation of Respondent's subject Registration Nos. 3443817 and 3447638 on the ground of likelihood of confusion, pursuant to Section 2(d) of the Trademark Act. Subsequently, on May 19, 2014, Petitioner filed an amended petition to cancel, which was accepted and made the operative pleading by the Board's July 7, 2014, order. By its amended petition for cancellation, Petitioner seeks cancellation of

Respondent's subject registrations on the grounds of likelihood of confusion and abandonment. Respondent submitted an answer denying the salient allegations in the amended petition for cancellation.

On January 16, 2015, and January 23, 2015, respectively, Respondent's subject Registrations Nos. 3443817 and 3447638 were cancelled pursuant to Section 8 of the Trademark Act due to Respondent's failure to file declarations of continued use. Accordingly, on March 28, 2015, the Board issued an order pursuant to Trademark Rule 2.134(b) allowing Respondent until April 17, 2015, to show cause why such cancellation should not result in entry of judgment against Respondent.

In response to the Board's show-cause order, Respondent states that prior to October 19, 2011, the filing date of the initial petition for cancellation, Respondent made a deliberate business decision to change its overall branding and had begun transitioning to a new mark; that by the December 2014 deadline for filing its declarations of use Respondent had completed its transition to the new mark; and that for these reasons alone, and not to avoid judgment in this proceeding, Respondent did not file the declarations of use required to maintain the subject registrations.

Petitioner has filed a brief in opposition to Respondent's response to the Board's show-cause order. Petitioner, in its brief, points out the fact that Respondent, in its August 6, 2014, answer to the amended petition for cancellation, denied that the marks in the subject registrations had been abandoned or that Respondent had discontinued use of the marks. Petitioner further notes that Respondent, in its

August 1, 2014, response to Petitioner's requests for admissions, again denied that it had discontinued use of the marks and denied abandoning the marks.

In reply, Respondent asserts that it made the decision to transition away from its subject marks as early as February 2011; that some historic uses of the marks continued through August 2014; that in view of these historic uses, in August 2014 it would have been inaccurate and premature to admit that the marks had been abandoned, notwithstanding the fact that Respondent was in the process of transitioning away from the marks; and that Applicant's answers denying that it had abandoned or discontinued use of the marks were not inconsistent with its ongoing but, as yet, incomplete transition away from its marks. With its reply brief, Respondent, for the first time, offered support for its allegations in the form of the declaration of its President, Paula Zaval.

Turning to Petitioner's abandonment claim, Respondent, in its reply brief, indicates that it has completed its transition away from the marks shown in the subject registrations, and now does not dispute that it has abandoned the subject marks. Based on these circumstances and Respondent's concession, judgment is entered against Respondent on the ground of abandonment.

With respect to the ground of likelihood of confusion, however, Respondent has demonstrated to the Board's satisfaction that its failure to file Section 8 declarations of use was the result of a deliberate business decision made prior to the commencement of this proceeding and not for purposes of avoiding judgment. *See*

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Marshall Field & Co. v. Mrs. Fields Cookies, 11 USPQ2d 1154, 1156 (TTAB 1989);
see also, TBMP § 602.02(b) (2015).

The order to show cause therefore is discharged with respect to the ground of likelihood of confusion only.

Petitioner is allowed **thirty days** from the mailing date of this order in which to advise the Board whether it wishes to go forward to obtain a determination on the likelihood of confusion issue, failing which that claim will be dismissed without prejudice as moot and the Petition for Cancellation will be granted on the ground of abandonment.