

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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DMM/gmm

Mailed: November 10, 2015

Cancellation No. 92054683

The Hispanic National Bar Association, Inc.

v.

The Hispanic National Bar Foundation, Inc.

By the Trademark Trial and Appeal Board:

This order vacates and supersedes the Board's order dated November 4, 2015.

Petitioner's amended complaint (filed on May 19, 2014) seeks cancellation of Respondent's subject registrations on the grounds of likelihood of confusion and abandonment.

On January 16, 2015, and January 23, 2015, respectively, Respondent's subject Registration 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) requiring Respondent to show cause why such cancellation should not result in entry of judgment against Respondent. On April 17, 2015, Respondent replied to the Board's order by indicating that prior to commencement of this proceeding Respondent made a business decision to change its overall branding and transition to a new mark, and for that reason alone, and not to avoid judgment in

this proceeding, Respondent did not file the declarations of use required to maintain the subject registrations.

In view of Respondent's concession that it had abandoned the subject marks, in an order dated August 12, 2015, the Board entered judgment against Respondent on the pleaded ground of abandonment. With respect to the pleaded ground of likelihood of confusion, the Board determined that Respondent's failure to file the 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. Therefore, the Board discharged the show cause order with respect to the ground of likelihood of confusion only and allowed Petitioner the opportunity to advise the Board whether it wished to go forward to obtain a determination on the likelihood of confusion issue.

On September 10, 2015, Petitioner responded by indicating that it does not wish to go forward on its likelihood of confusion claim. Accordingly, Petitioner's claim of likelihood of confusion is dismissed without prejudice as moot. The Petition for Cancellation is granted on the ground of abandonment, as indicated in the Board's August 12, 2015 order.