

ESTTA Tracking number: **ESTTA462142**

Filing date: **03/15/2012**

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 parties request to cancel indicated registration.

Petitioner Information

Name	Tom Parashos		
Entity	Individual	Citizenship	UNITED STATES
Address	2828 University Ave. Suite 102 San Diego, CA 92104 UNITED STATES		

Name	William R. Simon Jr.		
Entity	Individual	Citizenship	UNITED STATES
Address	2828 University Ave Suite 102 San Diego, CA 92104 UNITED STATES		

Correspondence information	Kristen N. Gonzales Attorney of Record San Diego Law Firm 2828 University Ave Suite 102 San Diego, CA 92104 UNITED STATES kgonzales@sandiegolawfirm.com Phone:619-794-0243		
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Registration Subject to Cancellation

Registration No	3777696	Registration date	04/20/2010
Registrant	Higgs Fletcher & Mack LLP Suite 2600 401 West A Street San Diego, CA 92101 UNITED STATES		

Goods/Services Subject to Cancellation

Class 045. First Use: 2004/06/14 First Use In Commerce: 2004/06/14
All goods and services in the class are cancelled, namely: Legal services

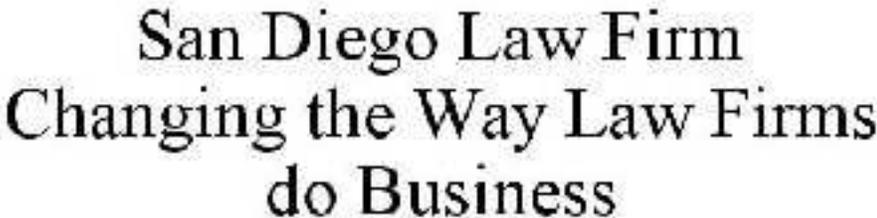
Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Does not function as a trademark

Related Proceedings	Applications for registration currently pending before the USPTO: 85328912 and 85328951
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Marks Cited by Petitioner as Basis for Cancellation

U.S. Application No.	85328912	Application Date	05/24/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	SAN DIEGO LAW FIRM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 045. First use: First Use: 2000/01/13 First Use In Commerce: 2000/01/13 Legal services		

U.S. Application No.	85328951	Application Date	05/24/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	SAN DIEGO LAW FIRM CHANGING THE WAY LAW FIRMS DO BUSINESS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 045. First use: First Use: 2000/01/13 First Use In Commerce: 2000/01/13 Legal services		

Attachments	85328912#TMSN.jpeg (1 page)(bytes) 85328951#TMSN.jpeg (1 page)(bytes) 004.1 Petition to Cancel X KNG.pdf (4 pages)(333397 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	/kngonzales/
Name	Kristen N. Gonzales
Date	03/15/2012

SDLF seeks to register the marks, SAN DIEGO LAW FIRM and SAN DIEGO LAW FIRM CHANGING THE WAY LAW FIRMS DO BUSINESS,(collectively referred to as "SAN DIEGO LAW FIRM MARKS") for "*Legal Services*" in Class 48.

2. As set forth in Serial Nos. 85328912, 85328951, SDLF has used the SAN DIEGO LAW FIRM mark in connection with the subject services since at least as early as January 2000.
3. During the course of prosecution of Serial Nos. 85328912, 85328951, the Examining Attorney refused registration of SDLF's SAN DIEGO LAW FIRM MARKS under Section 2(d) of the Trademark Act over U.S. Reg. No. 3777696.
4. Higgs, Fletcher, and Mack ("Registrant") is identified as the owner of U.S. Reg. No. 3777696 ("the Cited Registration"), which is for the mark "SAN DIEGO'S LAW FIRM SINCE 1939". The Cited Registration purports to cover the following services in Class 45: "*Legal Services*" ("the Subject Services"). The registration issued on April 20, 2010. During prosecution, the words "LAW FIRM SINCE 1939" were disclaimed.
5. Registrant filed the application (Serial No. 77820748) that ultimately issued as the Cited Registration on April 20, 2010. At the time of filing, Registrant claimed that the SAN DIEGO'S LAW FIRM SINCE 1939 mark was being used in commerce as a trademark for the Subject Services, and that it had been used as a mark for such goods since at least as early as June 14, 2004.
6. Cited Registration should be cancelled because San Diego Law Firm, prior to the filing of Serial Nos. 85328912, 85328951 (and indeed, prior to Registrant's claimed first use of the purported mark), was already using SAN DIEGO LAW FIRM as a trademark for legal services in Class 45. San Diego Law Firm therefore has priority of use over Registrant.
7. By way of the Cited Registration, Registrant claims the exclusive right to use the "SAN DIEGO'S LAW FIRM SINCE 1939" mark in connection with the Subject Services, namely, "*Legal Services*." Moreover, the Office has taken the position during prosecution of Serial Nos. 85328912, 85328951, that the use of SAN DIEGO LAW FIRM for the Class 45 services at issue in the San Diego Law Firm application is likely to cause confusion with the use of the "SAN DIEGO'S LAW FIRM SINCE 1939" mark for the services that are covered by the Cited Registration.
8. Consequently, pursuant to 15 U.S.C. §§ 1052(d), and 1064(1), U.S. Registration No. 3777696 should be cancelled because the SAN DIEGO LAW FIRM marks (in the view of the Office) consists of a mark that so resembles a mark previously used in the United States by another and not abandoned as to be likely to cause

confusion or mistake.

6. In the alternative, the Cited Registration should be cancelled because Registrant's statement that it was (and had been) using the "SAN DIEGO'S LAW FIRM SINCE 1939" mark as a trademark for the Subject Services was not true. As evidenced by the specimen that Registrant submitted in support of the Subject Registration, the phrase "SAN DIEGO'S LAW FIRM SINCE 1939" was being used by Registrant only as a slogan, not a trademark.
7. Further evidence in this regard can be found by reviewing the specimen submitted by Registrant when it first sought registration. The only specimen submitted was a business card displaying their slogan along with the name of the actual law firm.
8. Slogans and other terms that are considered to be merely information in nature, or to be common laudatory phrases or statements that would ordinarily be used in business or in the particular trade or industry are not registerable. *TMEP* Section 1202.04 (citing authority). As such, registration of the SAN DIEGO'S LAW FIRM SINCE 1939" mark should have been refused registration under Sections 1, 2, and 45 of the Trademark Act.
9. Accordingly, pursuant to 15. U.S.C. §§ 1051(a), 1052, and 1064(1) Registration No. 3777696 should be cancelled because the "SAN DIEGO'S LAW FIRM SINCE 1939" mark, as used by Registrant (as a slogan or tag line), was not functioning as a trademark.
10. San Diego Law Firm is likely to be damaged by the continued registration of U.S. Reg. No. 3777696 in Class 45 because, among other things, it seeks to register the mark SAN DIEGO LAW FIRM for the goods specified in Serial Nos. 85328912, and 85328951, which applications have been refused by the Office due to the existence of U.S. Registration No. 3777696.

PRAYER FOR RELIEF

San Diego Law Firm prays that U.S. Reg. No. 3777696 be canceled for all goods, and that this Petition be sustained in favor of San Diego Law Firm.

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PAYMENT OF FILING FEES

Payment of \$600.00 is being made herewith to cover the required filing fee.

Respectfully submitted,

SAN DIEGO LAW FIRM

Date: March 15, 2012

By: 
Kristen N. Gonzales, Esq.
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San Diego, CA 92104