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

Proceeding	92055343
Party	Plaintiff William R. Simon Jr. and Tom Parashos dba San Diego Law Firm
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Attachments	006 Amended Petition to Cancel X KNG.pdf(321726 bytes )



DIEGO LAW FIRM marks 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, Mack, LLP ("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 by Registrant.

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. On March 15, 2012, Petitioners initiated the current action to cancel Registrant's Cited Registration. Registrant filed its motion to dismiss Petitioner's second ground for cancellation: that Registrant's mark does not function as a trademark. Petitioner filed its opposition to the motion on March 1, 2013, to which Registrant filed a reply on March 14, 2013. The Board issued a decision on Registrant's FRCP 12(b) motion on June 17, 2012. The Board dismissed Petitioners' second ground for cancellation with free leave to amend. Petitioners now submit their First Amended Petition to Cancel Registrant's Cited Registration.

## II. PETITIONERS' GROUNDS FOR CANCELLATION.

7. In general, a registration on the Principal Register that is less than five years old may be canceled based on any ground that would have prevented registration initially.

*International Order of Job's Daughters v. Lindeburg & Co.*, 727 F.2d 1087 (Fed. Cir. 1984); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943 (Fed. Cir. 2000) (for a registration less than five years old, "any ground that would have prevented registration in the first place qualifies as a valid ground for cancellation"). As such, Petitioners allege the following grounds to cancel Registrant's Cited Registration:

### A. Priority and Likelihood of Confusion.

8. Cited Registration should be cancelled because SDLF, 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. SDLF therefore has priority of use over Registrant.

9. 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.

10. 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.

**B. Registrant's Cited Registration is not Used as a Trademark.**

11. In the alternative, the Cited Registration should be cancelled because Registrant's slogan for which Registrant obtained registration is merely informational in nature, and thus, Registrant's Cited Registration does not function as a trademark/service mark, nor is registrant using the Cited Registration as a trademark.

12. Registrant operates a law firm in the San Diego, California area, and holds itself out to the public as Higgs, Fletcher, Mack, LLP, for which Registrant has already obtained registration (Registration No. 3777698) (hereinafter referred to as the "HIGGS REGISTRATION"). Under the HIGGS REGISTRATION, Registrant also offers its services under the same Subject Services ("*Legal Services*") as the Cited Registration.

13. Petitioners allege that Registrant is using the Contested Registration as a slogan that is mere advertising, informational in nature, and so highly descriptive that the use of Registrant's Cited Registration does not function as trademark use. According to Merriam-Webster, a slogan is defined as

"(2): a brief attention-getting phrase used in advertising or promotion." Merriam-Webster.com, search of "slogan," <http://www.merriam-webster.com/dictionary/slogan> (June 24, 2013).

Registrant's use of the attention-getting phrase "SAN DIEGO'S LAW FIRM SINCE 1939" is an effort to advertise and/or promote Registrant's law firm services under its HIGGS REGISTRATION, and falls squarely within the above-cited definition of "slogan."

14. While some slogans may be registerable as trademarks and/or service marks, *TMEP* Section 1202.04 clearly delineates that 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 registrable. *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455 (TTAB 1998) (DRIVE SAFELY perceived as an everyday, commonplace safety admonition that does not function as a mark; see also *In re Manco Inc.*, 24 USPQ2d 1938, 1942 (TTAB 1992) (THINK GREEN and design found unregistrable for weatherstripping and paper products, the Board stating, “[R]ather than being regarded as an indicator of source, the term ‘THINK GREEN’ would be regarded simply as a slogan of environmental awareness and/or ecological consciousness...”).

15. Moreover, to function as a service mark, a designation must be used in a manner that would be perceived by purchasers as identifying and distinguishing the source of the services rather to convey advertising or promotional information. *TMEP* Section 1301.02(a); see also *In re Standard Oil Co.*, 275 F.2d 945 (1960) (GUARANTEED STARTING found to be ordinary words that convey information about the services, not service mark for the services of “winterizing” motor vehicles); *In re Melville Corp.*, 228 USPQ 970 (TTAB 1986) (BRAND NAMES FOR LESS found to be informational phrase that does not function as a mark for retail store services).

16. In this case, Registrant’s Cited Registration merely conveys information regarding Registrant’s overall history as a law firm, and does not serve to distinguish either particular goods/services offered by Registrant, nor the source of Registrant’s goods/services. SAN DIEGO’S LAW FIRM SINCE 1939 does not serve to function as a mark for “*Legal Services*,”

and does not function as a source identifier, rather, it merely serves as a component of advertising matter that conveys a characteristic of Registrant's overall history as a long-standing law firm in the San Diego area.

17. Further, because Petitioners allege Registrant's slogan does not function as a trademark, and is therefore incapable of continued registration, Registrant's Cited Registration has not and cannot become distinctive of Registrant's good/services as alleged in the Cited Registration, despite Registrant's §2(f) claim in its initial application to register.

18. Generally speaking, when matter sought to be registered is determined not registrable because it is not a mark within the meaning of the Trademark Act, a claim that the matter has acquired distinctiveness under §2(f) as applied to the applicant's goods or services does not overcome the refusal. *See, e.g., TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33, 58 (2001) ("Functionality having been established, whether MDI'S dual spring design has acquired secondary meaning need not be considered."); *In re R.M. Smith, Inc.*, 734 F.2d 1482, 1484-85 (Fed. Cir. 1984) ("Evidence of distinctiveness is of no avail to counter a de jure functionality rejection."); *Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1554 (TTAB 2009) (stating that a product design may become generic and, thus, cannot be registered, regardless of applicant's claim of acquired distinctiveness); *In re Tilcon Warren, Inc.*, 221 USPQ 86, 88 (TTAB 1984) ("Long use of a slogan which is not a trademark and would not be so perceived does not, of course, transform the slogan into a trademark."); *In re Mancino*, 219 USPQ 1047, 1048 (TTAB 1983) ("Since the refusal ... was based on applicant's failure to demonstrate technical service mark use, the claim of distinctiveness under Section 2(f) was of no relevance to the issue in the case."). For the foregoing reasons, 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.

19. 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), was not trademark use.

20. SDLF 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.

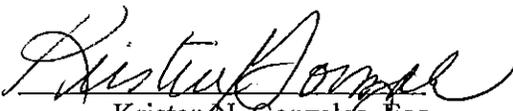
**PRAYER FOR RELIEF**

SDLF prays that U.S. Reg. No. 3777696 be canceled for all goods, and that this Petition be sustained in favor of Petitioners.

Respectfully submitted,

SAN DIEGO LAW FIRM

Date: July 1, 2013

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