

ESTTA Tracking number: **ESTTA463523**

Filing date: **03/23/2012**

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 party requests to cancel indicated registration.

Petitioner Information

Name	Randy H. McMurray P.C.		
Entity	Corporation	Citizenship	California
Address	333 S Grand Avenue, Suite 2300 c/o CBLH Los Angeles, CA 90071 UNITED STATES		

Attorney information	Victor K. Sapphire, Esq. CONNOLLY BOVE LODGE & HUTZ LLP 333 S GRAND AVE STE 2300 LOS ANGELES, CA 90071 UNITED STATES trademarks@cblh.com, vsapphire@cblh.com Phone:2137872523		
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Registration Subject to Cancellation

Registration No	2930153	Registration date	03/08/2005
Registrant	COCHRAN FIRM, P.C., THE 163 W. MAIN STREET DOTHAN, AL 36301 UNITED STATES		

Goods/Services Subject to Cancellation

Class 042. First Use: 1998/05/00 First Use In Commerce: 1998/05/00 All goods and services in the class are cancelled, namely: Professional legal services
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Grounds for Cancellation

Deceptiveness	Trademark Act section 2(a)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Abandonment	Trademark Act section 14
The registration is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.	Trademark Act section 14

Mark Cited by Petitioner as Basis for Cancellation

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	THE COCHRAN FIRM; THE COCHRAN FIRM LOS ANGELES		

Goods/Services	PROFESSIONAL LEGAL SERVICES
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Attachments	COCHRANcancel.pdf (6 pages)(954800 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	/victor sapphire/
Name	Victor K. Sapphire, Esq.
Date	03/23/2012

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

Randy H. McMurray P.C.,

Petitioner,

v.

The Cochran Firm, P.C.

Registrant

Cancellation No. _____

Registration No. 2,930,153

Mark: THE COCHRAN FIRM

PETITION FOR CANCELLATION

Commissioner for Trademarks
PO Box 1451
Alexandria, VA 22313-1451

Petitioner Randy H. McMurray P.C. ("McMurray"), believes it will be damaged by the continued registration of the mark THE COCHRAN FIRM in Registration No. 2,930,153 in connection with "professional legal services" in International Class 42. The '153 Registration for the mark is allegedly owned by The Cochran Firm, P.C., a corporation with its business address at 163 W. Main Street, Dothan, Alabama 36301 ("Registrant"), and Petitioner hereby petitions for cancellation of said registration.

As grounds for the cancellation, it is alleged that:

1. Petitioner is the owner of valuable rights in the mark THE COCHRAN FIRM in connection with services similar or identical to those identified in the '153 Registration, as well as of the business and goodwill connected therewith.

2. Petitioner is a professional corporation organized under the laws of California comprising Randy H. McMurray, an individual and attorney. Petitioner's renown stemming from his many years of work, including as an associate and partner of the renowned attorney Johnnie Cochran, and as a member of his law firm, which has long been known as "The Cochran Firm", as well as his continuing work with and management of the principal office in Los Angeles of the firm after the death of Mr. Cochran and formation of a new law partnership under the "The Cochran Firm Los Angeles" name (the "LA Partnership"), extends throughout Southern California and North America.

3. On information and belief, Registrant is a professional corporation organized under the laws of Alabama with a principal address of 163 West Main Street, Post Office Box 927, Dothan, Alabama 36302.

4. After the 2005 death of the original registrant, Johnnie Cochran, ownership of the registration appears to have passed to his estate. However, in the absence of an assignment and continuing license addressing the goodwill from the firm's ongoing activities under the THE COCHRAN FIRM mark, the rights of the Estate of Johnnie L. Cochran Junior (the "Estate") are believed to have extinguished at that time as a result of a naked assignment and non-use by the assignee, the Estate.

5. Notwithstanding the foregoing, in 2007, The Estate executed and had recorded in the U.S. Trademark Office an Assignment of its entire interest in the registration to Registrant.

6. On information and belief, neither Mr. Cochran nor his estate had in place any written or other license agreement governing the use of the THE COCHRAN FIRM mark by the law firm.

7. On information and belief, the business and goodwill in the THE COCHRAN FIRM mark were not transferred to the Estate. The assignment of rights in the

subject mark of the '153 Reg. to Registrant was therefore a naked license, and the Registration is invalid.

8. Even if the foregoing assignment of the '153 Reg. is valid, which Petitioner does not concede, there is no license agreement between Registrant and Petitioner, either as an individual member or as managing partner of the LA Partnership in the principal office of the late Mr. Cochran's firm, which has for several years operated as a California limited liability partnership under the name "The Cochran Firm Los Angeles". The parties have not replaced terms governing good will in connection with the mark, or quality control; therefore there is no valid license that may be found to exist even implicitly between the parties, and the Registration is invalid.

9. On information and belief, Registrant has no license agreements with any of the Registrant's other purported licensees/affiliates providing for good will generated by use of the subject mark of the '153 Reg. to inure to Registrant.

10. Petitioner and the LA Partnership are not and for many years have not been members of the Registrant's organization and/or professional corporation, and the parties to this proceeding are thus not part of one single firm, nor otherwise comprising a common entity, as such terms are commonly understood in the context of law practices.

11. On June 7, 2011, Registrant filed a Declaration of Continuing Use under Section 8 in the '153 Reg. with a supporting specimen. According to the Declaration, the supporting specimen comprises "the Cochran Firm brochure".

12. The specimen identifies a number of cities, including Los Angeles, as locations where Registrant maintains offices. However, the LA Partnership is a separate and distinct business organization from Registrant, as is borne out in the LA Partnership's Amended and Restated Partnership Agreement dated as of January 1, 2010, which does not identify Registrant nor any of its individual members as partners or members of the LA Partnership.

13. The specimen fraudulently misrepresents Registrant as a firm where "The Partners of The Cochran Firm have won" a variety of impressive verdicts, specifically:

- Eleven verdicts in excess of \$100 Million;

- Over 36 verdicts in excess of \$10 Million;
- Hundreds of verdicts or settlements in excess of \$1 Million;
- Over \$1 Billion obtained in environmental settlements or verdicts,

while in truth, Registrant's partners/shareholders have not obtained those results between them.

14. The specimen fraudulently misrepresents Registrant as "America's Law Firm", where consumers are led to believe the firm is operating in 21 cities throughout the country, in Atlanta, Birmingham, Chicago, Dallas, Detroit, Dothan, Houston, Huntsville, Jackson, Las Vegas, Los Angeles, Memphis, Miami, Minneapolis, Milwaukee, Mobile, New Orleans, New York, Philadelphia, Tuskegee, and Washington, DC.

15. On information and belief, Registrant is not organized as a law firm partnership or corporation with satellite offices in the cities identified in Paragraph 14, above.

16. On information and belief, Registrant operates a naked licensing scheme with law practitioners in the cities identified in Paragraph 14 concerning use of the THE COCHRAN FIRM mark, where said practitioners are not required to maintain any level of quality controlled or enforced by Registrant, therefore the statements in the specimen are false and fraudulently misrepresentative, tainting the Section 8 Declaration of Use.

17. Registrant has not won verdicts and settlements amounting to the sums alleged in Paragraph 13, above, either alone or through licensees operating under valid trademark licenses.

18. Registrant does not operate as a single firm nor as an association through valid licenses in the 21 cities identified in its specimen supporting its Section 8 Declaration.

19. Petitioner has developed strong trademark rights and goodwill in the THE COCHRAN FIRM mark since becoming the director and managing partner of the Los Angeles office after the death of Mr. Cochran. He has maintained and grown the practice since that time, operating in and from the Los Angeles office, which was the principal office of the firm during the period that Mr. Cochran was practicing and managing the firm, and the Los Angeles office is still regarded by consumers as the principal location of "THE COCHRAN FIRM".

20. Petitioner first learned of the '153 Registration when, on February 6, 2012, Registrant sent Petitioner a threatening letter demanding Petitioner cease and desist use of THE COCHRAN FIRM mark, notwithstanding the good will that has inured to Petitioner over the course of the past several years of Petitioner's and the LA Partnership's use.

21. Registrant does not have valid and enforceable rights in the THE COCHRAN FIRM mark as a result of the naked assignment and/or naked licensing of the mark by Registrant and/or its predecessor(s) in interest, *inter alia*.

22. Registrant's improper use of its fraudulent and invalid registration is threatening Petitioner's ability to conduct its business and is interfering with same, to the detriment of Petitioner and Petitioner's clients. Petitioner's lawful use of its THE COCHRAN FIRM mark will be impaired by continued registration of Registrant's mark and thus, Petitioner believes it will be damaged by the continuance of registrant's registration.

WHEREFORE, in accordance with Section 13 of the Trademark Act (15 U.S.C. Section 1063), Petitioner prays that this Cancellation be sustained and that Registration No. 2,930,153 be cancelled.

Respectfully submitted,

Dated: March 23, 2012

By: 
Victor K. Sapphire
Attorneys for Petitioner
CONNOLLY BOVE LODGE & HUTZ LLP
333 S. Grand Avenue, Suite 2300
Los Angeles, California 90071
(213) 787-2500

CERTIFICATE OF SERVICE

It is hereby certified that a true copy of the foregoing PETITION TO CANCEL is being transmitted via first-class mail addressed to the Registrant as follows:

The Cochran Firm, P.C.
163 W. Main Street
Dothan, Alabama 36301

Dated: 3/23/12 By: 