

ESTTA Tracking number: **ESTTA494405**

Filing date: **09/13/2012**

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	Legend Pictures LLC		
Entity	Limited liability company	Citizenship	Delaware
Address	4000 Warner Boulevard, Building 76 Burbank, CA 91522 UNITED STATES		

Attorney information	Jordan P. Raphael O'Melveny & Myers LLP 400 South Hope Street, 18th Floor Los Angeles, CA 90071 UNITED STATES sgordon@omm.com Phone:(213) 430-7734
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Registration Subject to Cancellation

Registration No	4106459	Registration date	02/28/2012
Registrant	Davis, Quentin P.O.Box 47893 Tampa, FL 33646 UNITED STATES		

Goods/Services Subject to Cancellation

<p>Class 041. First Use: 1999/09/01 First Use In Commerce: 2011/06/29 All goods and services in the class are cancelled, namely: Entertainment in the nature of a live musical performances; Entertainment in the nature of live performances by a musical artist; Entertainment, namely, live music concerts; Live performances featuring prerecorded vocal and instrumental performances viewed on a big screen; Record production; Music production; Audio recording and production; Videotape production; Motion picture song production; Production of video discs for others; Recording studios; Entertainment services, namely, production and distribution of musical audio and video programs; Production and distribution of musical audio and video recordings for broadcast; Music composition and transcription for others; Song writing services; Music publishing services; Entertainment, namely, personal appearances by a musician or entertainer; Entertainment services, namely, live, televised and movie appearances by a professional entertainer; Entertainment services, namely, providing a web site featuring non-downloadable musical performances, musical videos, and photographs; Entertainment services, namely, providing non-downloadable prerecorded music, and providing information, commentary and articles about music, all online via a global computer network; Entertainment in the nature of live traveling tour performances by a professional entertainer featuring music</p>
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Grounds for Cancellation

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Non-Use of the mark in connection with the

	claimed services (Trademark Act section 1(a)(3); Partial cancellation (Trademark Act section 18)
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Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	3412677	Application Date	09/16/2004
Registration Date	04/15/2008	Foreign Priority Date	NONE
Word Mark	LEGENDARY PICTURES		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 2005/06/01 First Use In Commerce: 2005/06/01 Motion picture films, prerecorded videocassettes, digital versatile disks (DVDs), compact discs, and other recordable media, namely computer disks, CD-ROMs, audio discs, and audio tapes, featuring live action, computer generated, and animated motion pictures or combinations thereof; pre-recorded audio tapes, audio compact discs, and video tapes featuring musical entertainment</p> <p>Class 041. First use: First Use: 2005/06/01 First Use In Commerce: 2005/06/01 Entertainment services, namely, production, development and distribution of motion picture films, television programs, television program specials, music video programs, documentary television programs and motion pictures, animated television programs and motion pictures</p>		

U.S. Registration No.	3656926	Application Date	08/14/2008
Registration Date	07/21/2009	Foreign Priority Date	NONE
Word Mark	LEGENDARY PICTURES		
Design Mark			
Description of Mark	The mark consists of the words "LEGENDARY PICTURES" and a design.		
Goods/Services	<p>Class 009. First use: First Use: 2005/06/01 First Use In Commerce: 2005/06/01 Motion picture films featuring comedy, adventures, sports, romance and drama; digital media, namely, prerecorded videocassettes, DVDs, and compact discs all</p>		

	featuring comedy, adventures, sports, romance and drama; digital media, namely, prerecorded computer disks, CD-ROMs, audio discs and audio tapes all featuring comedy, adventures, sports, romance and drama; prerecorded audio tapes, audio compact discs and video tapes all featuring musical entertainment Class 041. First use: First Use: 2005/06/01 First Use In Commerce: 2005/06/01 Entertainment services, namely, production and distribution of motion picture films, television programs and television program specials; entertainment services, namely, production and distribution of music video programs, documentary television programs and documentary motion picture films; entertainment services, namely, production and distribution of animated television programs and animated motion picture films
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U.S. Registration No.	3621043	Application Date	05/18/2006
Registration Date	05/12/2009	Foreign Priority Date	NONE
Word Mark	LEGENDARY PICTURES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2005/06/01 First Use In Commerce: 2005/06/01 Entertainment services, namely, production and distribution of motion picture films, television programs, television program specials, music video programs, documentary television programs and motion pictures, animated television programs and motion pictures		

Attachments	78484868#TMSN.jpeg (1 page)(bytes) 77547603#TMSN.jpeg (1 page)(bytes) 78886660#TMSN.jpeg (1 page)(bytes) Petition to Cancel.pdf (11 pages)(85164 bytes) Proof of Service - Petition to Cancel.pdf (1 page)(22372 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 USPS Express Mail Post Office to Addressee on this date.

Signature	/Jordan P. Raphael/
Name	Jordan P. Raphael
Date	09/13/2012

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

IN THE MATTER OF REGISTRATION NO. 4,106,459
for the mark LEGENDARY
registered February 28, 2012

LEGEND PICTURES, LLC,)	Cancellation No. _____
)	
Petitioners,)	
v.)	
)	
QUENTIN DAVIS,)	
)	
Registrant.)	
_____)	

PETITION TO CANCEL

Legend Pictures LLC (“Petitioner”) is a Delaware limited liability company with an address at 4000 Warner Boulevard, Building 76, Burbank, California 91522.

Quentin Davis, an individual with a mailing address at P.O. Box 47893 Tampa, Florida 33646 (“Registrant”), is the owner of record of U.S. Registration No. 4,106,459 (the “Registration”), issued on February 28, 2012, for the mark LEGENDARY in International Class 41 for the following services:

Entertainment in the nature of a live musical performances; Entertainment in the nature of live performances by a musical artist; Entertainment, namely, live music concerts; Live performances featuring prerecorded vocal and instrumental performances viewed on a big screen; Record production; Music production; Audio recording and production; Videotape production; Motion picture song production; Production of video discs for others; Recording studios; Entertainment services, namely, production and distribution of musical audio and video programs; Production and distribution of musical audio and video recordings for broadcast; Music composition and transcription for others; Song writing services; Music publishing services; Entertainment, namely, personal appearances by a musician or entertainer; Entertainment services, namely, live, televised and movie appearances by a professional entertainer; Entertainment services, namely, providing a web site featuring non-downloadable musical performances, musical videos, and photographs; Entertainment services, namely, providing non-downloadable

prerecorded music, and providing information, commentary and articles about music, all online via a global computer network; Entertainment in the nature of live traveling tour performances by a professional entertainer featuring music.

Petitioner believes it will be damaged by Registrant's continued existence of the Registration and, through its authorized attorneys, hereby petitions pursuant to 15 U.S.C. § 1064 and 15 U.S.C. § 1068 to cancel or partially cancel the Registration. The grounds for cancellation are as follows:

Ground 1: Likelihood of Confusion Under 15 U.S.C. § 1052(d)

1. Petitioner is the owner of U.S. Registration No. 3,412,677 for the standard character mark LEGENDARY PICTURES.

2. U.S. Registration No. 3,412,677 was issued on April 15, 2008, and has a first use in commerce date of June 1, 2005. The registration covers the following goods and services:

Motion picture films, prerecorded videocassettes, digital versatile disks (DVDs), compact discs, and other recordable media, namely computer disks, CD-ROMs, audio discs, and audio tapes, featuring live action, computer generated, and animated motion pictures or combinations thereof; pre-recorded audio tapes, audio compact discs, and video tapes featuring musical entertainment. (International Class 9)

Entertainment services, namely, production, development and distribution of motion picture films, television programs, television program specials, music video programs, documentary television programs and motion pictures, animated television programs and motion pictures. (International Class 41)

3. Petitioner is also the owner of U.S. Registration No. 3,656,926 for the stylized mark:



4. U.S. Registration No. 3,656,926 was issued on July 21, 2009, and has a first use in commerce date of June 1, 2005. The registration covers the following goods and services:

Motion picture films featuring comedy, adventures, sports, romance and drama; digital media, namely, prerecorded videocassettes, DVDs, and compact discs all featuring comedy, adventures, sports, romance and drama; digital media, namely, prerecorded computer disks, CD-ROMs, audio discs and audio tapes all featuring comedy, adventures, sports, romance and drama; prerecorded audio tapes, audio compact discs and video tapes all featuring musical entertainment. (International Class 9)

Entertainment services, namely, production and distribution of motion picture films, television programs and television program specials; entertainment services, namely, production and distribution of music video programs, documentary television programs and documentary motion picture films; entertainment services, namely, production and distribution of animated television programs and animated motion picture films. (International Class 41)

5. Petitioner is also the owner of U.S. Registration No. 3,621,043 for the stylized mark:



6. U.S. Registration No. 3,621,043 was issued on May 12, 2009, and has a first use in commerce date of June 1, 2005. The registration covers the following services in

International Class 41:

Entertainment services, namely, production and distribution of motion picture films, television programs, television program specials, music video programs, documentary television programs and motion pictures, animated television programs and motion pictures.

PETITION TO CANCEL
U.S. REGISTRATION NO. 4,106,459

7. Petitioner also uses the marks LEGENDARY and LEGENDARY ENTERTAINMENT in connection with the production and distribution of entertainment properties, including motion picture films, Internet programs, and printed and electronic publications.

8. Petitioner has invested significant effort and substantial sums in promoting and developing the above-mentioned marks. As a result, Petitioner's marks have gained nationwide recognition, popularity, and fame.

9. The entirety of Registrant's mark LEGENDARY is incorporated within Petitioner's LEGENDARY PICTURES marks. Consequently, Registrant's mark LEGENDARY would appear to consumers to be a shortened form of Petitioner's LEGENDARY PICTURES marks. In fact, media reports have commonly referred to Petitioner using the shortened mark LEGENDARY. Consumers are therefore likely to mistakenly believe that Registrant's mark is associated or affiliated with Petitioner's mark.

10. Several of the Registration's identified goods and services are closely related and/or are likely to expand into the goods and services identified in Petitioner's registrations.

11. The continued existence of the Registration likely to cause confusion, mistake or deception and is also likely to create the erroneous impression that Petitioner and Registrant are somehow related or associated, or that Petitioner sponsors or approves Registrant's goods and services.

12. When used in connection with the goods and services identified in the Registration, Registrant's mark LEGENDARY is likely to cause confusion, deception or mistake, in violation of § 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

Ground 2: Fraud in Procurement of Trademark Registration

13. The Registration is based on application Serial No. 85/147,849 (the “Application”), which was filed as an Intent-to-Use application pursuant to 15 U.S.C. § 1051(b).

14. On December 27, 2011, Registrant submitted a Statement of Use pursuant to 15 U.S.C. § 1051(d) in support of the Application. In the Statement of Use, Registrant identified the following services in International Class 41:

Entertainment in the nature of a live musical performances; Entertainment in the nature of live performances by a musical artist; Entertainment, namely, live music concerts; Live performances featuring prerecorded vocal and instrumental performances viewed on a big screen; Record production; Music production; Audio recording and production; Videotape production; Motion picture song production; Production of video discs for others; Recording studios; Entertainment services, namely, production and distribution of musical audio and video programs; Production and distribution of musical audio and video recordings for broadcast; Music composition and transcription for others; Song writing services; Music publishing services; Entertainment, namely, personal appearances by a musician or entertainer; Entertainment services, namely, live, televised and movie appearances by a professional entertainer; Entertainment services, namely, providing a web site featuring non-downloadable musical performances, musical videos, and photographs; Entertainment services, namely, providing nondownloadable prerecorded music, and providing information, commentary and articles about music, all online via a global computer network; Entertainment in the nature of live traveling tour performances by a professional entertainer featuring music.

15. Registrant also averred that “The mark is in use in commerce on or in connection with *all goods or services* listed in the application or Notice of Allowance or as subsequently modified for this specific class.” (Emphasis added.)

16. Upon information and belief, Registrant does not use in commerce the mark LEGENDARY in connection with all of the services listed in the Statement of Use, including, *inter alia*, “Videotape production”; “Motion picture song production”; “Production of video discs for others”; and “Entertainment services, namely, production and distribution of musical audio and video programs.”

17. Upon information and belief, as of December 27, 2011, Registrant was not using in commerce the mark LEGENDARY in connection with all of the services listed in the Statement of Use, including, *inter alia*, “Videotape production”; “Motion picture song production”; “Production of video discs for others”; and “Entertainment services, namely, production and distribution of musical audio and video programs.”

18. Registrant knew or should have known that the statement in the Statement of Use that the mark LEGENDARY was in use in commerce for all of the services identified in the Application were false or misleading.

19. Registrant’s statement in the Statement of Use that the mark LEGENDARY was in use in commerce for all of the services identified in the Application constituted a knowingly false misrepresentation of material fact with the intent to deceive the United States Patent and Trademark Office.

20. But for the false statement in the Statement of Use, the United States Patent and Trademark Office would not have approved the Application for registration for all of the services identified in the Application.

21. Due to Registrant’s knowingly false statement in the Statement of Use, Registrant committed fraud on the United States Patent and Trademark Office.

22. In 2011, Petitioner filed applications with the U.S. Patent and Trademark Office to register the stylized mark LEGENDARY in International Classes 9, 16, and 41 (application Serial Nos. 85/331,782, 85/331,756). The Examining Attorney has suspended Petitioner’s pending applications, citing a possible finding of likelihood of confusion with the Registration.

23. Petitioner has been or will be damaged by Registrant's fraud on the United States Patent and Trademark Office because the Registration that was issued based on Registrant's fraudulent statements has been cited against Petitioner's pending trademark applications.

Ground 3: Non-Use of the Mark In Connection With the Claimed Services

24. A trademark applicant is not entitled to "a registration under Section 1 of the Trademark Act for goods or services upon which it has not used the mark." *Grand Canyon West Ranch, LLC v. Hualapai Tribe*, 78 U.S.P.Q.2d 1696, 1698 (T.T.A.B. 2006) (citing 15 U.S.C. § 1051).

25. In support of the application that matured into the Registration, Registrant submitted a Statement of Use on December 27, 2011, that asserted use in commerce for the following services in International Class 41:

Entertainment in the nature of a live musical performances; Entertainment in the nature of live performances by a musical artist; Entertainment, namely, live music concerts; Live performances featuring prerecorded vocal and instrumental performances viewed on a big screen; Record production; Music production; Audio recording and production; Videotape production; Motion picture song production; Production of video discs for others; Recording studios; Entertainment services, namely, production and distribution of musical audio and video programs; Production and distribution of musical audio and video recordings for broadcast; Music composition and transcription for others; Song writing services; Music publishing services; Entertainment, namely, personal appearances by a musician or entertainer; Entertainment services, namely, live, televised and movie appearances by a professional entertainer; Entertainment services, namely, providing a web site featuring non-downloadable musical performances, musical videos, and photographs; Entertainment services, namely, providing nondownloadable prerecorded music, and providing information, commentary and articles about music, all online via a global computer network; Entertainment in the nature of live traveling tour performances by a professional entertainer featuring music.

26. The Registration covers the same services.

27. Upon information and belief, Registrant does not use in commerce the mark

LEGENDARY in connection with all of the services listed in the Statement of Use, including,

inter alia, “Videotape production”; “Motion picture song production”; “Production of video discs for others”; and “Entertainment services, namely, production and distribution of musical audio and video programs.”

28. Upon information and belief, as of December 27, 2011, Registrant was not using in commerce the mark LEGENDARY in connection with all of the services listed in the Statement of Use, including, *inter alia*, “Videotape production”; “Motion picture song production”; “Production of video discs for others”; and “Entertainment services, namely, production and distribution of musical audio and video programs.”

29. As a result of Registrant’s non-use of the mark LEGENDARY for one or more of the services identified in the Registration, Registrant was not and is not entitled to a federal trademark registration for the mark LEGENDARY in connection with the services for which there has been no use in commerce.

30. Due to Registrant’s non-use, the Registration should be cancelled as void *ab initio* or partially cancelled with the Registration amended to eliminate the services for which there has been no use in commerce.

31. Petitioner has been or will be damaged by the continued existence of the Registration for all of its identified services because the Registration has been cited against Petitioner’s pending trademark applications.

Ground 4: Partial Cancellation Under 15 U.S.C. § 1068

32. Petitioner has filed an application with the U.S. Patent and Trademark Office, Serial No. 85/331,782, to register the stylized mark:



LEGENDARY

33. Application Serial No. 85/331,782 covers the following goods and services:

Pre-recorded audio cassettes, audio books and compact discs featuring music and stories in the fields of fantasy, fiction, science fiction, horror, humor, adventure, and nonfiction in the fields of historical drama, biography, memoir, autobiography, and travelogue; Pre-recorded digital video discs, video cassettes and digital versatile discs featuring TV shows and motion pictures in the fields of fantasy, fiction, science fiction, horror, humor, adventure, and nonfiction in the fields of historical drama, biography, memoir, autobiography, and travelogue. (International Class 9)

Entertainment services, namely, development of concepts for and production and distribution of motion pictures, television programs, Internet programs, video games, multimedia entertainment content and live stage productions; publication of books, magazines and other printed matter. (International Class 41)

34. Petitioner has also filed an application with the U.S. Patent and Trademark Office, Serial No. 85/331,756, to register the stylized mark:



35. Application Serial No. 85/331,756 covers the following goods and services:

Pre-recorded audio cassettes, audio books and compact discs featuring music and stories in the fields of fantasy, fiction, science fiction, horror, humor, adventure, and nonfiction in the fields of historical drama, biography, memoir, autobiography, and travelogue; Pre-recorded digital video discs, video cassettes and digital versatile discs featuring TV shows and motion pictures in the fields of fantasy, fiction, science fiction, horror, humor, adventure, and nonfiction in the fields of historical drama, biography, memoir, autobiography, and travelogue. (International Class 9)

Entertainment services, namely, development of concepts for and production and distribution of motion pictures, television programs, Internet programs, videogames, multimedia entertainment content and live stage productions; publication of books, magazines and other printed matter. (International Class 41)

36. The Examining Attorney has suspended application Serial Nos. 85/331,756 and 85/331,782, citing a possible finding of likelihood of confusion with the Registration.

37. The Registration asserts use for the following services in International Class 41:

Entertainment in the nature of a live musical performances; Entertainment in the nature of live performances by a musical artist; Entertainment, namely, live music concerts; Live performances featuring prerecorded vocal and instrumental performances viewed on a big screen; Record production; Music production; Audio recording and production; Videotape production; Motion picture song production; Production of video discs for others; Recording studios; Entertainment services, namely, production and distribution of musical audio and video programs; Production and distribution of musical audio and video recordings for broadcast; Music composition and transcription for others; Song writing services; Music publishing services; Entertainment, namely, personal appearances by a musician or entertainer; Entertainment services, namely, live, televised and movie appearances by a professional entertainer; Entertainment services, namely, providing a web site featuring non-downloadable musical performances, musical videos, and photographs; Entertainment services, namely, providing non-downloadable prerecorded music, and providing information, commentary and articles about music, all online via a global computer network; Entertainment in the nature of live traveling tour performances by a professional entertainer featuring music.

38. Upon information and belief, Registrant does not use in commerce the mark LEGENDARY in connection with all of the services listed in the Statement of Use, including, *inter alia*, “Videotape production”; “Motion picture song production”; “Production of video discs for others”; and “Entertainment services, namely, production and distribution of musical audio and video programs.”

39. Accordingly, pursuant to 15 U.S.C. § 1068, the Registration should be partially cancelled and the description of services should be restricted or otherwise modified to remove the services for which there has been no use in commerce including, without limitation, “Videotape production”; “Motion picture song production”; “Production of video discs for

others”; and “Entertainment services, namely, production and distribution of musical audio and video programs.”

40. The above-described restriction of the services in the Registration will avoid a finding of likelihood of confusion with Petitioner’s pending trademark applications, Serial Nos. 85/331,756 and 85/331,782.

41. For the reasons set forth in this Petition, Registrant is not entitled to the Registration or to the legal protections that the Registration affords.

42. Because the Examining Attorney has refused to register Petitioner’s Applications, Serial Nos. 85/331,756 and 85/331,782, citing a potential for likelihood of confusion with the Registration, the continued existence of the Registration is causing injury and damage to Petitioner.

WHEREFORE Petitioner prays that U.S. Registration No. 4,106,459 be canceled.

Dated: September 13, 2012

Respectfully submitted,

/ Jordan P. Raphael/
Jordan P. Raphael, Attorney for Petitioner
Legend Pictures LLC

O’Melveny & Myers LLP
400 South Hope Street, 18th Floor
Los Angeles, California 90071

Telephone: (213) 430-7734

PETITION TO CANCEL
U.S. REGISTRATION NO. 4,106,459

PROOF OF SERVICE

I, Debbie Bumgardner, declare:

I am a resident of the State of California and over the age of eighteen years, and not a party to the within action; my business address is 400 South Hope Street, Los Angeles, California 90071-2899. On September 13, 2012, I served the following document(s):

PETITION TO CANCEL

by putting a true and correct copy thereof in a sealed envelope, with delivery fees paid or provided for, for delivery the next business day to:

QUENTIN DAVIS
P.O. BOX 47893
TAMPA, FLORIDA 33646

and by placing the envelope for collection today by Express Mail in accordance with the firm's ordinary business practices. I am readily familiar with this firm's practice for collection and processing of overnight courier correspondence. In the ordinary course of business, such correspondence collected from me would be processed on the same day, with fees thereon fully prepaid, and deposited that day in a box or other facility regularly maintained by Express Mail, which is an overnight carrier.

I declare under penalty of perjury under the laws of the State of California that the above is true and correct.

Executed on September 13, 2012, at Los Angeles, California.


Debbie Bumgardner