

ESTTA Tracking number: **ESTTA494547**Filing date: **09/14/2012**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	HarperCollins Publishers, LLC		
Entity	limited liability company	Citizenship	Delaware
Address	10 East 53rd Street New York, NY 10022 UNITED STATES		

Attorney information	Rollin A. Ransom Sidley Austin LLP 555 W. Fifth St. Suite 4000 Los Angeles, CA 90013 UNITED STATES rransom@sidley.com Phone:213-896-6047
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Registration Subject to Cancellation

Registration No	3921658	Registration date	02/22/2011
Registrant	Barnes, Jason P. 13418 Moorpark St. Sherman Oaks, CA 91423 UNITED STATES		

Goods/Services Subject to Cancellation

Class 016. First Use: 2004/10/31 First Use In Commerce: 2005/06/22 All goods and services in the class are cancelled, namely: Comic books; Graphic novels; Novels
Class 041. First Use: 2004/10/31 First Use In Commerce: 2005/06/22 All goods and services in the class are cancelled, namely: Multimedia publishing of books, magazines, journals, software, games, and electronic publications

Grounds for Cancellation

Genericness	Trademark Act section 23
The mark is merely descriptive	Trademark Act section 2(e)(1)
Other	Registration of an incomplete mark (37 C.F.R. Â§ 2.51(a); T.M.E.P. Â§ 807.12(d)); No use in commerce prior to application date (37 C.F.R. Â§2.34(a)(1)(i); T.M.E.P. Â§ 806.01(a)); No use of mark as service mark (T.M.E.P. Â§ 1301.02(a))

Related Proceedings	Wild v. HarperCollins Publishers, LLC, et al., Case No. 8:12-cv-01191-JST-ANx (C.D. Cal.)
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Attachments	STATEMENT IN SUPPORT OF CANCELLATION - 3921658.pdf (4 pages) (28249 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	/rollin a. ransom/
Name	Rollin A. Ransom
Date	09/14/2012

STATEMENT OF GROUNDS FOR CANCELLATION OF
U.S. TRADEMARK REG. NO. 3,921,658

I. THE PARTIES

1. Petitioner HarperCollins Publishers, LLC (“HarperCollins”) is a limited liability company organized under the laws of the State of Delaware, with a principal place of business at 10 East 53rd Street, New York, New York.

2. HarperCollins is informed and believes that registrant and respondent Jason Barnes a/k/a Jazan Wild (“Barnes”) is an individual residing in California. Barnes is the listed owner of United States Trademark Registration No. 3,921,658 (the “Registration”), which Registration is the subject of this cancellation petition.

II. PROSECUTION HISTORY OF THE ALLEGED MARK

3. The Registration is for the alleged mark CARNIVAL OF SOULS (the “Alleged Mark”), in International Class 16 for “Comic books; Graphic novels; Novels,” and in International Class 41 for the “Multimedia publishing of books, magazines, journals, software, games, and electronic publications.”

4. The Examining Attorney originally refused registration of the Alleged Mark with respect to the International Class 16 goods, stating that the specimen submitted with Barnes’ application showed use of the Alleged Mark “only as the title of a single creative work,” and that it therefore “[did] not function as a trademark to identify and distinguish applicant’s goods from those of others and to indicate the source of applicant’s goods.” *See* Office Action dated Dec. 4, 2009.

5. Barnes responded to the Office Action, submitting various specimens that he claimed showed use of the Alleged Mark in “an on-going series.” *See* Response to Office Action dated Dec. 10, 2009.

6. On the basis of Barnes’ representations, the Examining Attorney ultimately allowed registration of the Alleged Mark.

III. BASES FOR CANCELLATION OF THE REGISTRATION

A. The Specimens Submitted In Connection With The Application Do Not Support Use Of The Alleged Mark.

7. Although the Registration is for CARNIVAL OF SOULS, the specimens submitted by Barnes do not reflect use of the Alleged Mark that is depicted in the drawing submitted with the underlying application, and reflected in the Registration.

8. Instead, the phrase identified in every specimen that Barnes submitted to the Trademark Office in connection with the application was “Jazan Wild’s Carnival of Souls.” *See* Specimen submitted August 19, 2009; Evidence submitted with Response to Office Action dated December 10, 2009.

9. “[T]he drawing of the mark [submitted with the application] must be a substantially exact representation of the mark as used on or in connection with the goods and/or services.” 37 C.F.R. § 2.51(a); *see also* T.M.E.P. § 807.12(a).

10. “In an application under §1 of the Trademark Act, the mark on the drawing must be a complete mark, as evidenced by the specimen. When the representation on a drawing does not constitute a complete mark, it is sometimes referred to as a “mutilation” of the mark. This term indicates that essential and integral subject matter is missing from the drawing. An incomplete mark may not be registered.” T.M.E.P. § 807.12(d).

11. Barnes’ failure to include the phrase “Jazan Wild’s” as part of the drawing of the Alleged Mark renders the Alleged Mark an incomplete mark. Accordingly, registration of the Alleged Mark should have been refused pursuant to 37 C.F.R. § 2.51(a) and T.M.E.P. § 807.12. The Registration should therefore be cancelled on this basis.

B. Barnes Has Not Used The Alleged Mark On A Series Of Literary Works.

12. Although Barnes claims to have used the Alleged Mark in connection with an ongoing series, HarperCollins is informed and believes that he has used the Alleged Mark only in connection with single works, none of which can support registration of the Alleged Mark in connection with the goods identified in Class 16.

13. With respect to “Novels,” HarperCollins is informed and believes that Barnes has used the phrase “Carnival of Souls” in connection with only one “novel,” namely, “Carnival of Souls (A Novel by Jazan Wild).” The Trademark Manual of Examining Procedure (“TMEP”) provides that “[t]he title of a single creative work is not registrable on either the Principal or Supplemental Register.” TMEP § 1202.08.

14. HarperCollins is further informed and believes that the above-referenced novel was not published until July 4, 2012, when it was made available “exclusively” on amazon.com. Accordingly, this use cannot in any event support the Registration, which issued over sixteen months earlier.

15. Similarly, with respect to “Graphic novels,” HarperCollins is informed and believes that Barnes has used the phrase “Carnival of Souls” in connection with only one “graphic novel,” namely, “Jazan Wild’s Carnival of Souls.”

16. For the reasons discussed above, the title of this graphic novel does not support registration of the Alleged Mark, because the inclusion of “Jazan Wild’s” in the title of the graphic novel renders the Alleged Mark an incomplete mark with respect to these goods. Separate and apart from that failing, because Barnes has used the title “Jazan Wild’s Carnival of Souls” only in connection with a single graphic novel, such use cannot support registration of the title in any event. TMEP § 1202.08.

17. Finally, with “Comic books,” HarperCollins is informed and believes that Barnes has used the title “Jazan Wild’s Carnival of Souls” in connection with three so-called comic books; however, these three “comic books” are nothing more than serialized chapters of the single graphic novel described above.

18. In fact, a judge in the United States District Court has already acknowledged that these so-called comic books are merely serialized subparts of Barnes' graphic novel. *See Wild v. NBC Universal, Inc.*, 788 F. Supp. 2d 1083, 1089-90 (C.D. Cal. 2011) (describing *Carnival of Souls* as "a three-part 'graphic novel'" and "a graphic novel consisting of three comic books").

19. For the reasons discussed above, the title of these "comic books" does not support registration of the Alleged Mark, because the inclusion of "Jazan Wild's" in the title of each of them renders the Alleged Mark an incomplete mark with respect to these goods. Separate and apart from that failing, it is well-established that "[c]reative works that are serialized, *i.e.*, the mark identifies the entire work but the work is issued in sections or chapters, are still considered single creative works." TMEP § 1202.08(a). Accordingly, Barnes' so-called "comic books" cannot support the Registration either.

20. Barnes' failure to use the Alleged Mark in connection with a series of literary works renders the mark unregistrable. TMEP § 1202.08. The Registration should therefore be cancelled as to International Class 16 on this basis as well.

C. Barnes Has Not Used The Alleged Mark As A Service Mark.

21. The Registration also covers the following services in International Class 41: "Multimedia publishing of books, magazines, journals, software, games, and electronic publications.

22. HarperCollins is informed and believes that Barnes has never used the Alleged Mark as a service mark in connection with the services identified above. Instead, HarperCollins is informed and believes that Barnes has merely offered the novel and graphic novel *products* identified above through various media.

23. In fact, the information submitted by Barnes in responding to an Office Action confirms that his sole use of the Alleged Mark in connection with the identified services was to offer literary publications bearing the phrase "Carnival of Souls" through various media, including "a comic book website," as an "ebook/electronic publication," and on "mobile phones." *See* Response to Office Action dated Dec. 10, 2009. In these publications, the phrase "Carnival of Souls" was not used to identify a publisher or provider of media; rather, it was used to identify the underlying work. Indeed, this evidence further establishes that "Carnival Comics" is actually the publisher of the referenced materials, and that "Carnival of Souls" was merely one of two books that were "being offered" through the media services. *See id.*, "Evidence 4."

24. It is well-established that "[a] term that is used only to identify a product, device, or instrument sold or used in the performance of a service rather than to identify the service itself does not function as a service mark." T.M.E.P. § 1301.02(a).

25. Here, because Barnes has not used the Alleged Mark to identify the service itself (as distinct from the product sold through various media," Barnes has not used the Alleged Mark as a service mark. The Registration should therefore be cancelled as to International Class 41 on this basis as well.

D. HarperCollins Will Be Damaged By The Registration.

26. HarperCollins is the publisher of a novel by best-selling author Melissa Marr (“Marr”) that is entitled “Carnival of Souls.” This novel was made available in bookstores on September 4, 2012.

27. Barnes has accused HarperCollins and Marr of infringing the Registration. In addition, in reliance on the Registration, Barnes has engaged in a public relations campaign against HarperCollins and Marr, accusing them of willful infringement; he has also sent cease and desist notices to reviewers of HarperCollins’ novel, likewise asserting “willful and malicious” infringement of the Registration.

28. HarperCollins believes it will be damaged by the Registration, both as a result of the public relations campaign described above (which is based largely on the existence of the Registration), and to the extent that Barnes is permitted to enforce such Registration in any judicial proceeding.