

ESTTA Tracking number: **ESTTA530815**

Filing date: **04/05/2013**

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	Mr. Alexander B. Johns		
Entity	Individual	Citizenship	UNITED STATES
Address	200 South Sixth Street c/o: Fredrikson & Byron, Suite 4000 Minneapolis, MN 55402 UNITED STATES		

Attorney information	Paul E. Thomas Fredrikson & Byron, P.A. 200 South Sixth Street Suite 4000 Minneapolis, MN 55402 UNITED STATES ip@fredlaw.com, pthomas@fredlaw.com Phone:612.492.7365		
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Registration Subject to Cancellation

Registration No	3985041	Registration date	06/28/2011
Registrant	Arete Enterprises, LLC 321 North Oak Avenue Clifton Heights, PA 19018 UNITED STATES		

Goods/Services Subject to Cancellation

Class 035. First Use: 2010/08/23 First Use In Commerce: 2010/08/23 Cancelled goods and services in the class: Business advisory services, consultancy and information
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Grounds for Cancellation

Other	Petition for partial cancellation pursuant to Trademark Act section 18.
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Attachments	Johns-PetitionForPartialCancellation-ARETEASSOCIATES.pdf (6 pages) (266947 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	/Paul E. Thomas/
Name	Paul E. Thomas

Date	04/05/2013
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of

U.S. Reg. No.: 3985041

For the Mark: ARETÉ ASSOCIATES & Design

Registered: June 28, 2011

Alexander B. Johns,

Cancellation No. _____

Petitioner,

v.

Areté Enterprises, LLC,

Registrant.

PETITION FOR PARTIAL CANCELLATION

Petitioner, Alexander B. Johns, believes that he is being damaged by Registration No. 3985041 (“the Registration”) and hereby petitions for partial cancellation of the Registration.

The grounds for partial cancellation are as follows:

1. The mark that is the subject of the Registration is registered for the following services in Class 35: “Business advisory services, consultancy and information.”

2. On May 8, 2012, Petitioner, a United States citizen, filed, on an intent-to-use basis, U.S. Application No. 85619846 to register ARETÉ STRATEGIES BIO-PHARMA ADVISORS & Design in connection with the following services: “Business consulting services and product and service commercialization services for pharmaceutical, biotechnology, diagnostic technology, medical device, vaccine production, and life sciences technology customers in the field of health care products and services” (“the Application”).

3. On September 7, 2012, the Examining Attorney assigned to the Application issued an Office Action in which the Examining Attorney refused registration under §2(d) of the Lanham Act based on a finding of a likelihood of confusion with the Registration. When comparing the services recited in the Application to those in the Registration for purposes of the likelihood of confusion analysis, the Examining Attorney stated that “the [R]egistration uses broad wording to describe the services and this wording is presumed to encompass all services of the type described, including those in Petitioner’s more narrow identification.”

4. In response to the Examining Attorney’s Office Action of September 7, 2012, and in an effort to minimize the Examiner’s grounds for finding a likelihood of confusion between the Application and Registration, Petitioner narrowed the description of services in the Application as follows: “Product and service commercialization services for pharmaceutical, biotechnology, diagnostic technology, medical device, vaccine production, and life sciences technology customers in the field of health care products and services.”

5. On November 1, 2012, the Examining Attorney issued a second Office Action which maintains the refusal to register Petitioner’s mark under §2(d), and, despite Petitioner’s narrowing of the description of services in the Application, the Examining Attorney iterates that the Registration’s “identification remains broadly-worded to encompass that of the [A]pplicant’s more narrow identification,” and the Examining Attorney emphasizes this point by citing a Board statement that “unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described.” *In re Jump Designs*, 80 USPQ2d 1370, 1374 (TTAB 2006).

6. Based on the *Jump Designs* rule, the Examining Attorney appears to be asserting that the USPTO is extending to Registrant the benefit of a presumption that Registrant offers its

“Business advisory services” and its “consultancy” services to every conceivable kind of business in every industry; and, more than this, that Registrant provides “information” on every conceivable subject related to every kind of business in every industry in the United States.

7. Petitioner respectfully questions the appropriateness of such a presumption and the universal scope it grants to Registrant’s services because, on information and belief, Registrant is a Pennsylvania limited liability company having a principal location at 321 North Oak Avenue Clifton Heights, Pennsylvania 19018, and is doing business as Areté Associates in the information technology industry. According to Registrant’s website located at www.arete-associates.com, Registrant provides the following services in regard to information technology: remote assistance, data backup, email hosting, hardware procurement, smartphone integration, data and phone wiring, disaster recovery, spam filtering, web filtering, network design, software application development, information technology performance improvement, co-location, web hosting, anti-virus / spyware, internet / remote access, desktop and server monitoring, voice over ip (voip) phone service. Registrant’s website testimonials page confirms that Registrant’s operations are limited to the field of information technology. See *Exhibit 1*.

8. Given Registrant’s actual services, Petitioner argues that no consumer confusion will arise due to the simultaneous use of Petitioner’s and Registrant’s marks in the marketplace because Registrant provides information technology services, and Petitioner provides product and service commercialization services for pharmaceutical, biotechnology, diagnostic technology, medical device, vaccine production, and life sciences technology customers in the field of health care products and services.

9. For these reasons, Petitioner argues that if Registrant’s Class 35 services are appropriately limited to reflect the services Registrant actually provides in connection with its

mark, the grounds for finding a likelihood of confusion between Petitioner's and Registrant's mark would no longer exist and Petitioner's and Registrant's marks would be able to coexist on the Principal Register.

10. Petitioner therefore petitions the Board to limit the services in the Registration to the following wording, or other similar restrictive wording, in the discretion of the Board: "Business advisory services and consultancy in the field of information technology."

For all of the foregoing reasons, Petitioner requests the partial cancellation of U.S. Reg. No. 3985041 in accordance with Petitioner's arguments above.

_____/s/ Paul E. Thomas_____

Date: April 5, 2013

Paul E. Thomas

Fredrikson & Byron, P.A.

200 South Sixth Street

Suite 4000

Minneapolis, Minnesota 55402

Attorney for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the Petition for Partial Cancellation was served by first class mail on Registrant at the addresses listed below, on this 5th day of April, 2013:

Mr. David Gallagher
Areté Enterprises, LLC
321 North Oak Avenue
Clifton Heights, Pennsylvania 19018

_____/s/ Paul E. Thomas_____

Date: April 5, 2013

Paul E. Thomas

Exhibit 1

From: <http://arete-associates.com/services.html>

email
anti-virus
managed
services
network design
backup
helpdesk
web
hosting
disaster
recovery
spam filtering
vpn
web design
security
remote
access
network design
helpdesk
email
anti-virus
managed
services

Areté
associates

INFORMATION · TECHNOLOGY · CONSULTING

services

Managing our clients' technology so they can focus on expanding their business is our primary goal. We are dedicated to a proactive strategy that prevents and corrects problems before they impact business productivity. Areté Associates implements solutions that create efficiencies and increase your bottom line. Our experienced consultants provide technical services including:

Remote Assistance	Disaster Recovery	Co-location
Data Backups	Spam Filtering	Web Hosting
Email Hosting	Web Filter	Anti-Virus / Spyware
Hardware Procurement	Network Design	Internet / Remote Access
Smartphone Integration	Application Development	Desktop - Server Monitoring
Data and Phone Wiring	Performance Improvement	Voice over IP (VoIP) Phone Service

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From: <http://arete-associates.com/testimonials.html>



The image shows a dark-themed webpage for Areté Associates testimonials. On the left, a vertical list of services is displayed in a light gray font, including: email, anti-virus, managed services, network design, backup, helpdesk, web hosting, disaster recovery, spam filtering, VPN, remote access, network design, helpdesk, email, anti-virus, managed services, network design, backup, helpdesk, web hosting. The main content area features the Areté Associates logo at the top, which consists of the word 'Areté' in a large, white, serif font with a red accent on the 'é', and 'associates' in a smaller, white, sans-serif font below it, all enclosed in a thin red rectangular border. Below the logo, the tagline 'INFORMATION · TECHNOLOGY · CONSULTING' is written in a small, white, sans-serif font. The word 'testimonials' is written vertically in a white, serif font on the left side of the main content area. The main body of the page contains five testimonial quotes, each preceded by a vertical line and enclosed in a light gray box. The quotes are: 1. "We have worked successfully with Areté for over ten years during a period of high growth and expansion. Recently, we underwent a network migration with Areté. The upgrade was flawless and server performance has drastically improved." 2. "Contacting Areté Associates was the smartest IT decision our firm has ever made. I called in search of computer support and ended up with an efficient, comprehensive systems management plan that catered to our long-term business goals." 3. "Areté Associates is the best. We have not had a single, major problem in over two years." 4. "I cannot say enough about the company. I have seen tech guys before, both good and bad. The Areté Associates team is by far the best I have had the pleasure to know and work with." 5. "We trust Areté Associates as our strategic IT partner; a voice of reason as we grow and expand, and someone we can count on when issues arise."