

ESTTA Tracking number: **ESTTA530870**

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	Tresona Multimedia, LLC		
Entity	LLC	Citizenship	Arizona
Address	6336 N. 48th Place, Bldg. B Paradise Valley, AZ 85253 UNITED STATES		

Attorney information	KENNETH C. BOOTH Booth Udall Fuller, PLC 1255 W. Rio Salado Parkway, Ste. 215 Tempe, AZ 85281 UNITED STATES trademark@boothudall.com Phone:4808302700		
----------------------	--	--	--

Registration Subject to Cancellation

Registration No	3653506	Registration date	07/14/2009
Registrant	Soundset, LLC 2411 Hennepin Avenue Minneapolis, MN 55405 UNITED STATES		

Goods/Services Subject to Cancellation

Class 041. First Use: 2008/05/25 First Use In Commerce: 2008/05/25 All goods and services in the class are cancelled, namely: entertainment services, namely, arranging and conducting musical concerts
--

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
--------------------------------------	----------------------------

Mark Cited by Petitioner as Basis for Cancellation

U.S. Application No.	85399521	Application Date	08/16/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	SOUNDSET		

Design Mark	SOUNDSET
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 1995/09/01 First Use In Commerce: 1995/09/01 Audio and video recordings featuring music and artistic performances; Compact discs featuring music; Digital music downloadable from the Internet; Downloadable musical sound recordings; Musical sound recordings; Musical video recordings

Attachments	petitiontocancel.pdf(97059 bytes) 85399521#TMSN.jpeg(bytes)
-------------	---

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	/Kenneth C. Booth/
Name	Kenneth C. Booth
Date	04/05/2013

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

In the matter of Trademark Registration No.: **3,653,506**

For the Mark: **SOUNDSET**

Date Registered: **July 14, 2009**

Tresona Multimedia, LLC)	
)	
)	Cancellation Proceeding No.
Petitioner,)	
)	
v.)	_____
)	
Soundset, LLC)	
)	
Registrant.)	
_____)	

PETITION TO CANCEL

TRESONA MULTIMEDIA, LLC (“Tresona”), an Arizona limited liability company having its primary place of business at 6336 N. 48th Place, Paradise Valley, AZ 85253, has been and believes it will continue to be damaged by the continued registration of the mark shown in United States Trademark Registration No. 3,653,506 and hereby petitions to cancel this registration.

To the best of Tresona’s knowledge, the name and address of the current owner of the registration is SOUNDSET LLC (“Soundset”), a Minnesota limited liability company having a place of business at 2411 Hennepin Avenue, Minneapolis, MN 55405.

As grounds for cancellation, Tresona alleges:

A. STATEMENT OF FACTS

1. Soundset is the listed owner of United States Trademark Registration 3,653,506 for “SOUNDSET,” filed on June 19, 2008 and registered on July 14, 2009, for the following goods and services:

“Printed materials, namely, posters” in IC 016, claiming a date of first use and first use in commerce of May 25, 2008.

“Clothing, namely, t-shirts” in IC 025, claiming a date of first use and first use in commerce of May 25, 2008.

“Entertainment services, namely, arranging and conducting musical concerts” in IC 041, claiming a date of first use and first use in commerce of May 25, 2008.

2. Soundset arranges and operates an annual music festival held approximately each May in Minnesota.
3. Soundset’s music festival features Hip-Hop music performers.
4. To market its music festival, Soundset prints and distributes posters.
5. At its music festival, Soundset sells festival t-shirts displaying its logo and name.
6. Under a separate trademark from its music festival, Soundset sells Hip-Hop CDs and music under the trademark Fifth Element.
7. Soundset does not sell CDs, audio or video recordings, music or artistic recordings, or any digital music downloads using the Soundset trademark.
8. At least as early as September 1, 1995 and through December 11, 2011, Soundset Recordings, LLC, an Arizona limited liability company (“Soundset Recordings”) used the trademark SOUNDSET for creating and selling music recordings of artists, signing musical artists to its record label, and distributing recordings of the music.
9. Soundset has established extensive rights in this trademark throughout the United States and the World and its goodwill and reputation is very valuable in this trademark.
10. Soundset has recorded and has artists among its catalog of recordings originating from the United States and countries around the World including, without limitation, United States, Korea, Russia, Mexico, Brazil,

Canada, Chile, Newfoundland and Argentina.

11. Soundset Recordings specifically used and continues to use the “Soundset” trademark in Registrant’s home state since prior to Registrant’s application filing through Minnesota through Soundset Recordings’ dealings with well known cellist Gregory Hamilton who released a CD through Soundset Recordings called “The Hollywood Cello,” which was funded through a grant from Concordia College.
12. On August 16, 2011, Soundset Recordings, the original owner of US trademark application serial no. 85399521, filed a US trademark application for the trademark SOUNDSET for the goods:
“Audio and video recordings featuring music and artistic performances; Compact discs featuring music; Digital music downloadable from the Internet; Downloadable musical sound recordings; Musical sound recordings; Musical video recordings” in IC 009, claiming a date of first use and a first use in commerce of September 1, 1995.
13. On December 12, 2011, Tresona Multimedia, LLC, an Arizona limited liability company, purchased all of Soundset Recordings’ rights and title in the trademark SOUNDSET and its pending trademark application.
14. On December 13, 2011, the Trademark Office issued a rejection of the application asserting a likelihood of confusion under 15 USC 1052(d) based upon Registrant’s registration no. 3,653,506 for the trademark Soundset.
15. On June 13, 2012, a response was filed to the December 13, 2011 rejection of the trademark arguing that Soundset runs an annual music festival in Minnesota, and that even despite music being sold at the festival there would be no likelihood of consumer confusion.
16. On July 12, 2012, the Trademark Office issued a final rejection to trademark application serial no. 85399521, maintaining the rejection and rejecting the arguments that there would be no likelihood of consumer confusion.

B. LIKELIHOOD OF CONFUSION WITH PETITIONER'S SUPERIOR MARK

17. Petitioner incorporates by reference all paragraphs above as though fully set forth herein.
18. Petitioner owns the goodwill and all trademark rights associated with the Soundset Trademark for use with at least audio and video recordings featuring music and artistic performances, CDs featuring music and downloadable music recordings.
19. Petitioner's rights are superior to Registrant's by more than twelve years.
20. Petitioner's use of the Soundset trademark extends throughout the United States and many countries of the World including Registrant's home state where Registrant provides its music festival.
21. The continued registration of US Trademark Registration 3,653,506 to Registrant is causing irreparable injury to the business reputation and property of Petitioner and jeopardizes Petitioner's ability to protect its goodwill and other trademark rights in the Soundset trademark.
22. The Trademark Office's refusal to register Petitioner's trademark application based on the asserted likelihood of confusion with Registrant's continued US Trademark Registration 3,653,506 is irreparably harming Petitioner and will continue to harm Petitioner so long as the Registration exists and the Trademark Office refuses its registration.
23. The continued registration of US Trademark Registration 3,653,506 will continue to cause a likelihood of consumer confusion with Petitioner's trademark Soundset if Registrant is permitted to continue using the trademark in the confusingly similar industry of "entertainment services, namely, arranging and conducting musical concerts."
24. Petitioner's inability to fully protect its trademark rights with a federal trademark registration presently harms Petitioner and threatens to significantly harm Petitioner in the future from other third party infringers.

WHEREFORE, Petitioner, Tresona Multimedia, LLC, prays that this cancellation petition will be sustained and that United States Trademark Registration 3,653,506 will be cancelled.

Respectfully submitted,

Date: ___4/5/13_____

By: ___/Kenneth C. Booth/_____

Kenneth C. Booth
Reg. No. 42,342

BOOTH UDALL FULLER, PLC
1255 W. Rio Salado Parkway, Ste. 215
Tempe, AZ 85281
480.830.2700
480.830.2717 fax
kbooth@BoothUdall.com

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing:

PETITION TO CANCEL

has been mailed, first-class postage prepaid, on April 5, 2013, to Registrant:

Soundset, LLC
2411 Hennepin Avenue
Minneapolis, MN 55405

Luke W. DeMarte
Michael Best & Friedrich LLP
Two Prudential Plaza
180 North Stetson Avenue, Suite 2000
Chicago, IL 60601

April 5, 2013
Date

/Kenneth C. Booth/
Kenneth C. Booth