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

Proceeding	92057757
Party	Defendant Jewcy Media, LLC
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Signature	/Phillip A. Rosenberg/
Date	04/16/2014
Attachments	Jewcy Media v Avalanche - Response to Order to Show Cause.pdf(29346 bytes ) Jewcy Media v Avalanche - Declaration of Jesse Oxfeld.pdf(18307 bytes )

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

AVALANCHE, LLC,	)	
	)	
Petitioner,	)	
	)	
v.	)	Cancellation No. 92057757
	)	
JEWICY MEDIA, LLC,	)	
	)	
Registrant.	)	

**REGISTRANT’S RESPONSE TO ORDER TO SHOW CAUSE**

Registrant, Jewcy Media, LLC (“Jewcy”) through counsel and pursuant to 37 C.F.R. § 2.134 and T.B.M.P. § 535, hereby responds to the Board’s March 27, 2014 Order to Show Cause (the “Order”). For the reasons that follow, Jewcy respectfully submits that good cause exists for not entering judgment against Jewcy, but instead dismissing the instant cancellation proceeding as moot.

**BACKGROUND**

Jewcy’s registration for JEWICY at issue in the present matter issued on April 10, 2007 under No. 3,228,371 (the “’371 Registration”) covering “dating and matchmaking services” (the “Registered Services”).<sup>1</sup> According to § 8 of the Trademark Act, a Declaration of Use is due to be filed with the U.S. Patent and Trademark Office (“PTO”) by the sixth anniversary of the registration date, or, in the case of the ’371 Registration by April 10, 2013. *See* 15 U.S.C. § 1058. However, no § 8 Declaration was filed by the April 10, 2013 deadline, so the ’371 Registration was allowed to proceed into the grace period. On August 26, 2013, Petitioner filed

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<sup>1</sup> Notwithstanding cancellation of the ’371 Registration under Section 8, Jewcy owns other registrations comprising the mark JEWICY in standard character and design formats including U.S. Reg. Nos. 4293528, 4432665, 2843648, which remain in full force and effect covering a broad range of services, and JEWICY has made and continues to make extensive use of such marks for many of such registered services through to the present date.

its Petition for Cancellation (the “Petition”), seeking the cancellation of the JEWCY Registration on abandonment grounds under 15 U.S.C. § 1064(3) and T.B.M.P. § 307.01. Jewcy subsequently filed and served its Answer on October 7, 2013. The grace period for Jewcy to file a § 8 Declaration in support of the ‘371 Registration subsequently expired on October 10, 2013, without Jewcy filing a § 8 Declaration. On March 27, 2014, the Board issued its Order, stating that because Jewcy has permitted the ‘371 Registration to be cancelled under § 8, Jewcy has twenty (20) days, or until April 16, 2014, to show cause why such cancellation should not result in an entry of judgment against Jewcy. *See* Order, Dkt. 6, at \*1.

### **ARGUMENT**

The Board should discharge the Order and dismiss the Petition as moot because Jewcy’s non-filing of its § 8 Declaration does not constitute legal abandonment of its JEWCY mark for the Registered Services. The only plausible inference from Jewcy’s non-filing of its § 8 Declaration is that Jewcy could not then demonstrate present use of the JEWCY mark in connection with the Registered Services.

Under the Trademark Act, “[a] mark shall be deemed to be ‘abandoned’...[w]hen its use has been discontinued with intent not to resume such use.” 15 U.S.C. § 1127. While Jewcy has allowed the ‘371 Registration to expire, this is not tantamount to legal abandonment. Jewcy made a business decision not to file a § 8 Declaration against the ‘371 Registration because it was not at the time making commercial use of the JEWCY trademark in connection with the Registered Services. *See* Declaration of Jesse Oxfeld (“Oxfeld Decl.”) ¶ 3. Petitioner’s allegations that Jewcy “has discontinued such use of [its JEWCY] trademark in the United States with the intention not to resume the use thereof” are unsubstantiated. *See* Petition, Dkt. 1, at \*3. Beyond mere allegations, Petitioner has adduced no evidence proving Jewcy’s intent not to

resume use of its JEWCY mark for dating and matchmaking services, nor has there been any opportunity for adjudication of such matter. Moreover, in the Answer, Jewcy specifically denied that it had discontinued use with an intention not to resume such use. *See* Answer to Petition for Cancellation, Dkt. 5, at \*3. By entering judgment against Jewcy, the Board would be reaching a legal conclusion unsupported by the limited record before it.

Furthermore, Petitioner filed its Petition for Cancellation (the “Petition”) less than two months prior to the end of the statutory grace period for the purpose of obtaining a judgment. *See* Petition, Dkt. 1, at \*1. *See Scott Smith v. Entrepreneur Media, Inc.*, Cancellation No. 92053982, at \*3-\*4 (T.T.A.B. Sept. 22, 2011) (rejecting petitioner’s argument that the respondent had deliberately failed to renew its registration in order to avoid judgment and dismissing the cancellation proceeding as moot due to petitioner’s filing of cancellation action after respondent’s statutory deadline for filing a renewal but before the expiration of respondent’s grace period) (non-precedential). The Board admonished the *Scott Smith* petitioner for such a tactic, stating the following:

Petitioner’s motivation in filing the petition to cancel just three weeks before the expiration of the grace period is perplexing. The Board can only conclude that petitioner, recognizing that respondent was unlikely to submit a ten-year Section 8 declaration and Section 9 renewal was attempting to obtain a judgment simply to have one, particularly in light of the extensive litigation between the parties, referenced by both parties...Had petitioner waited the three weeks until [the] grace period expired, he would have conserved economic and judicial resources.

*Id.* at n.4.

Similarly, here, Petitioner had been in discussions with Jewcy about potential licensing of Jewcy’s JEWCY mark for the Registered Services. Petitioner rejected Jewcy’s licensing proposal and counteroffered a coexistence arrangement. *See* Oxfeld Decl. ¶ 5. Similar to the petitioner in

*Scott Smith*, Petitioner filed its unnecessary Petition only weeks before the expiration of the grace period instead of waiting a short time for the mark to naturally expire. *See* Petition, Dkt. 1, at \*3. Accordingly, such action seems to have been motivated by nothing other than a desire to obtain a judgment simply to have one. Consequently, the Petition should be dismissed as moot.

Moreover, the Board issued its Order under Trademark Rule 2.134(b). However, Rule 2.134(b) is inapplicable in this instance. The purpose of Rule 2.134(b) is to prevent a respondent in a cancellation proceeding from avoiding judgment by deliberately failing to file its § 8 affidavit of use. T.B.M.P. § 535. Jewcy's actions do not fall within the ambit of conduct that Rule 2.143(b) is meant to deter because Jewcy's motivation for not filing a Declaration by the final deadline of October 10, 2013 was simply that it did not at the time have use in commerce of the mark for the Registered Services, not to avoid judgment. *See* Oxfeld Decl. ¶ 4.

For the reasons set forth above, Jewcy respectfully requests that the Board discharge its Order and dismiss the cancellation proceeding as moot. Jewcy's '371 Registration has been cancelled under Section 8. Such cancellation is not tantamount to abandonment, nor is there any basis to establish that Jewcy deliberately chose not to file its Section 8 Declaration to avoid judgment. Consequently, there is no basis or justification for judgment on the merits as to abandonment.

Dated: New York, New York

April 16, 2014

Respectfully submitted,

**KILPATRICK TOWNSEND &  
STOCKTON LLP**

By:           /Phillip A. Rosenberg/          

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*Attorneys for Registrant*

**CERTIFICATE OF TRANSMITTAL**

I hereby certify that a true copy of the foregoing Registrant's Response to Order to Show Cause is being filed electronically with the TTAB via ESTTA on this day, April 16, 2014.

/s/Phillip A. Rosenberg  
Phillip A. Rosenberg  
Attorney for Registrant

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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AVALANCHE, LLC	)	
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Petitioner,	)	
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v.	)	Cancellation No. 92057757
	)	
JEWCY MEDIA, LLC,	)	
	)	
Registrant.	)	
	)	

**CERTIFICATE OF SERVICE**

A true and correct copy of the attached document has been served on counsel for  
Petitioner via first class mail addressed as follows:

Ury Fischer  
Stephen D. Lott  
P.O. Drawer 141098  
Coral Gables, FL 33114-1098

Dated: April 16, 2014

/s/ Phillip A. Rosenberg  
Phillip A. Rosenberg

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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**DECLARATION OF JESSE OXFELD IN SUPPORT OF  
REGISTRANT’S RESPONSE TO ORDER TO SHOW CAUSE**

I, JESSE OXFELD, declare as follows:

1. I am currently the Publisher of JEWCY MEDIA, LLC (“Respondent”) and I submit this declaration in support of Respondent’s Response to the Board’s Order to Show Cause. I make these statements based upon my own personal knowledge and my review of Respondent’s relevant business records.
2. Respondent did not file a sixth-year Declaration of Use (“Declaration”) in support of its Reg. No. 3,228,371 (the “371 Registration”) for JEWCY, the subject of Cancellation Proceeding No. 92057757, currently pending before the Trademark Trial & Appeal Board (the “Board”).
3. Respondent’s non-filing of a Declaration by the required deadline was a result of the mere fact that Respondent was not at the time making commercial use of the JEWCY trademark in connection with “dating and matchmaking services,” the services identified in the ‘371 Registration.

4. Respondent's motivation for not filing a Declaration by the final deadline of October 10, 2013 was not to avoid a judgment from the Board in the present cancellation proceeding.

5. Prior to Petitioner's filing of its Petition for Cancellation, Respondent had proposed to Petitioner a potential licensing arrangement of Respondent's JEWCY mark for "dating and matchmaking services," the services identified in the '371 Registration. Petitioner rejected this proposal and counteroffered a coexistence arrangement, for which negotiations have continued.

6. The undersigned, being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or any registration resulting therefrom, declares that all statements made herein of her own knowledge are true and that all statements made on information and belief are believed to be true.

Dated: New York, New York

April 16, 2014

/s/Jesse Oxfeld  
Jesse Oxfeld

**CERTIFICATE OF TRANSMITTAL**

I hereby certify that a true copy of the foregoing Declaration of Jesse Oxfeld in Support of Registrant's Response to Order to Show Cause is being filed electronically with the TTAB via ESTTA on this day, April 16, 2014.

/s/Phillip A. Rosenberg  
Phillip A. Rosenberg  
Attorney for Registrant

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Dated: April 16, 2014

/s/ Phillip A. Rosenberg  
Phillip A. Rosenberg