

ESTTA Tracking number: **ESTTA557627**

Filing date: **09/04/2013**

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	American Pro International Corp.		
Entity	Corporation	Citizenship	Florida
Address	13550 NW 107 Ave., Suite D-2 Hialeah Gardens, FL 33018 UNITED STATES		

Attorney information	David K. Friedland Friedland Vining, P.A. 1500 San Remo Ave., Suite 200 Coral Gables, FL 33146 UNITED STATES trademarks@friedlandvining.com, dkf@friedlandvining.com, jrv@friedlandvining.com Phone:(305) 777-1720
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Registration Subject to Cancellation

Registration No	2652876	Registration date	11/19/2002
Registrant	AMERICAN DJ SUPPLY, INC. 6122 S. Eastern Avenue LOS ANGELES, CA 90040 UNITED STATES		

Goods/Services Subject to Cancellation

Class 009. First Use: 2001/03/00 First Use In Commerce: 2001/03/00 All goods and services in the class are cancelled, namely: Series of musical sound recordings

Grounds for Cancellation

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Abandonment	Trademark Act section 14

Attachments	PET - Petition to Cancel 2,652,876 for AMERICANDJ - AS FILED.pdf(116963 bytes) 2,652,876-Exhibit A.pdf(1851390 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	/David K. Friedland/
Name	David K. Friedland
Date	09/04/2013

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

American Pro International Corp.,
Petitioner,

v.

American DJ Supply, Inc.,
Registrant.

Cancellation No.:
Registration No.: 2,652,876
Mark: **AMERICANDJ**
Registration Date: November 19, 2002

PETITION TO CANCEL

Pursuant to the provisions of 15 U.S.C. § 1064 and TBMP § 307, Petitioner American Pro International Corp. (“Petitioner”), a Florida corporation located and doing business at 13550 NW 107 Ave., Suite D-2, Hialeah Gardens, FL 33018, believes that it is and will continue to be damaged by Registration No. 2,652,876, and hereby petitions to cancel the same.

As grounds for this Petition, Petitioner alleges as follows:

1. According to the electronic records of the United States Patent and Trademark Office (“PTO”), Registrant American DJ Supply, Inc. (“Registrant”), a California corporation located and doing business at 6122 South Eastern Ave., Los Angeles, California 90040, is the record owner of U.S. Trademark Registration No. 2,652,876 for the mark **AMERICANDJ** (the ‘876 Registration), which registration issued on the Supplemental Register on November 19, 2002.

2. The ‘876 Registration includes “series of musical sound recordings,” in International Class 9.

3. Upon information and belief, Registrant has abandoned the **AMERICANDJ** mark.

4. Moreover, because Registrant knowingly and falsely represented that it was using the **AMERICANDJ** mark, with the intent to deceive the PTO when it maintained and renewed the registration, the '876 Registration is invalid and unenforceable.

5. Petitioner believes that it is and is likely to continue to be damaged by the continued existence of the '876 Registration in that Petitioner is engaged in the sale of the same or related products and has an interest in using the term "American" descriptively in its business. Petitioner's continued and legal use of the term "American" will be impaired by the continued registration of the '876 Registration.

Abandonment of the '876 Registration Through Non-Use

6. According to Section 308 of the TBMP, 15 U.S.C. 1064, a Petition to Cancel a registration may be filed at any time if the registered mark has been abandoned.

7. Upon information and belief, Registrant has not used the **AMERICANDJ** mark in commerce in connection with a "series of musical sound recordings" since Registrant acquired the '876 Registration in February 2004.

8. Upon information and belief, Registrant submitted its Combined Declaration of Use and/or Excusable Nonuse and Application for Renewal of Registration of a Mark Under Sections 8 & 9 (the "Renewal Application") on November 19, 2012. A copy of the Renewal Application is attached as Exhibit A.

9. Upon information and belief, the mark on the specimens submitted to the PTO in connection with Registrant's Renewal Application disagrees with the mark on the drawing. Specifically, the specimens display the mark as **AMERICAN DJ** (two words);

and the drawing shows the mark as **AMERICANDJ** (one word). The mark on the drawing must be a substantially exact representation of the mark on the specimen under 37 C.F.R. §§ 2.51(a) and 2.72(a)(1) and TMEP §807.12(a).

10. Upon information and belief, the specimens submitted to the PTO by Registrant show streaming services of music files by other artists other than **AMERICANDJ**, as opposed to hard disc musical sound recordings.

11. Upon information and belief, Registrant has abandoned the mark **AMERICANDJ**, as applied to the “series of musical sound recordings” set forth in the ‘876 Registration, and has discontinued use of said trademark with the intention not to resume the use thereof.

12. Upon information and belief, Registrant’s **AMERICANDJ** mark is abandoned, and its registration should be cancelled based on its loss of its priority date.

Fraudulent Maintenance and Renewal of the ‘876 Registration

13. Registrant committed fraud in maintaining and renewing the ‘876 Registration for the mark **AMERICANDJ** based on nonuse in commerce, thus making Registrant’s registration for **AMERICANDJ** *void ab initio*.

14. Registrant’s Renewal Application alleged that Registrant was using the **AMERICANDJ** mark “in commerce on or in connection with **all** goods or services listed in the existing registration.” (emphasis in original). *See Exhibit A*. Registrant’s statement was fraudulent and intentionally misrepresented use to the PTO.

15. Registrant falsely alleged trademark use of the mark **AMERICANDJ** in connection with a “series of musical sound recordings,” notwithstanding that Registrant had never used the mark in the drawing in connection with such goods.

16. Upon information and belief, Registrant admittedly knew that its representations to the PTO were false.

17. Upon information and belief, Registrant made these statements under penalty of “fine or imprisonment, or both, ...and [knowing] that such willful false statements may jeopardize the validity of the application or any resulting registration...”

18. Upon information and belief, Registrant knowingly made material misrepresentations to the PTO to maintain and renew the ‘876 Registration, and the PTO relied on the representations in renewing said registration. The PTO would not have renewed the ‘876 Registration but for Registrant’s false representations.

19. As a result of Registrant’s fraudulent conduct, Registrant’s ‘876 Registration is invalid and unenforceable.

20. Registrant’s fraudulent conduct, undertaken willfully and knowingly, invalidates the ‘876 Registration.

PRAYER FOR RELIEF

WHEREFORE, Petitioner prays that this Petition to Cancel be sustained and granted in favor of Petitioner and that Registration No. 2,652,876 be cancelled and removed from the Principal Register.

Date: September 4, 2013

Respectfully submitted,

FRIEDLAND VINING

/s/ David K. Friedland

By: **David K. Friedland**
Florida Bar No. 833479
Jaime Vining
Florida Bar No. 30932
1500 San Remo Avenue, Suite 200
Coral Gables, Florida 33146
(305) 777-1720 telephone
e-mail: DKF@friedlandvining.com
e-mail: JRV@friedlandvining.com

Counsel for Petitioner

CERTIFICATE OF SERVICE

WE HEREBY CERTIFY that the foregoing **PETITION TO CANCEL** was served upon the Registrant by delivering true and correct copies of same to Registrant's counsel via U.S. mail on September 4, 2013 as follows:

Kenneth L. Sherman
Sherman & Zarrabian LLP
1411 5th Street, Suite 306
Santa Monica, California 90401

/s/ David K. Friedland

David K. Friedland

Combined Declaration of Use and/or Excusable Nonuse/Application for Renewal of Registration of a Mark under Sections 8 & 9

The table below presents the data as entered.

Input Field	Entered
REGISTRATION NUMBER	2652876
REGISTRATION DATE	11/19/2002
SERIAL NUMBER	76240100
MARK SECTION	
MARK	AMERICANDJ
ATTORNEY SECTION (current)	
NAME	Kenneth L. Sherman
FIRM NAME	MYERS ANDRAS SHERMAN LLP
STREET	19900 MACARTHUR BLVD., 11TH FLOOR
CITY	IRVINE
STATE	California
POSTAL CODE	92612
COUNTRY	United States
PHONE	9492239600
FAX	9492239610
EMAIL	sherman@masiplaw.com
ATTORNEY SECTION (proposed)	
NAME	Kenneth L. Sherman
FIRM NAME	Sherman & Zarrabian LLP
INTERNAL ADDRESS	Suite 306

STREET	1411 5th Street
CITY	Santa Monica
STATE	California
POSTAL CODE	90401
COUNTRY	United States
PHONE	424-229-6800
FAX	424-229-6815
EMAIL	trademark@sziplaw.com
AUTHORIZED TO COMMUNICATE VIA E-MAIL	Yes

CORRESPONDENCE SECTION (current)

NAME	KENNETH L. SHERMAN
FIRM NAME	MYERS ANDRAS SHERMAN LLP
STREET	19900 MACARTHUR BLVD., 11TH FLOOR
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CORRESPONDENCE SECTION (proposed)

NAME	KENNETH L. SHERMAN
FIRM NAME	Sherman & Zarrabian LLP
INTERNAL ADDRESS	Suite 306
STREET	1411 5th Street
CITY	Santa Monica
STATE	California
POSTAL CODE	90401
COUNTRY	United States

PHONE	424-229-6800
FAX	424-229-6815
EMAIL	trademark@sziplaw.com
AUTHORIZED TO COMMUNICATE VIA E-MAIL	Yes
GOODS AND/OR SERVICES SECTION	
INTERNATIONAL CLASS	009
GOODS OR SERVICES	Series of musical sound recordings
SPECIMEN FILE NAME(S)	
ORIGINAL PDF FILE	SPN0-9818911180-122926500_.ADJ1-T.01_Specimens.pdf
CONVERTED PDF FILE(S) (2 pages)	\\TICRS\EXPORT16\IMAGEOUT16\762\401\76240100\xml1\S890002.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\762\401\76240100\xml1\S890003.JPG
SPECIMEN DESCRIPTION	images of the www.americandj.com web page using the registered mark in connection with sound recordings.
OWNER SECTION (current)	
NAME	AMERICAN DJ SUPPLY, INC.
STREET	6122 S. Eastern Avenue
CITY	LOS ANGELES
STATE	California
ZIP/POSTAL CODE	90040
COUNTRY	United States
OWNER SECTION (proposed)	
NAME	AMERICAN DJ SUPPLY, INC.
STREET	6122 S. Eastern Avenue
CITY	LOS ANGELES
STATE	California
ZIP/POSTAL CODE	90040
COUNTRY	United States
PHONE	323-582-2650

FAX	323-725-6100
LEGAL ENTITY SECTION (current)	
TYPE	corporation
STATE/COUNTRY OF INCORPORATION	California
PAYMENT SECTION	
NUMBER OF CLASSES	1
NUMBER OF CLASSES PAID	1
SUBTOTAL AMOUNT	500
TOTAL FEE PAID	500
SIGNATURE SECTION	
SIGNATURE	/jas/
SIGNATORY'S NAME	Joshua A. Schaul
SIGNATORY'S POSITION	Attorney of record, CA bar member
DATE SIGNED	11/19/2012
SIGNATORY'S PHONE NUMBER	424-229-6800
PAYMENT METHOD	CC
FILING INFORMATION	
SUBMIT DATE	Mon Nov 19 12:40:32 EST 2012
TEAS STAMP	USPTO/S08N09-98.189.11.18 0-20121119124032185391-26 52876-49076be1cdf77e05e6d 25dc741765cfe11-CC-12000- 20121119122926500335

**Combined Declaration of Use and/or Excusable Nonuse/Application for Renewal of
Registration of a Mark under Sections 8 & 9
To the Commissioner for Trademarks:**

REGISTRATION NUMBER: 2652876

REGISTRATION DATE: 11/19/2002

MARK: AMERICANDJ

The owner, AMERICAN DJ SUPPLY, INC., a corporation of California, having an address of
6122 S. Eastern Avenue
LOS ANGELES, California 90040
United States

is filing a Combined Declaration of Use and/or Excusable Nonuse/Application for Renewal of
Registration of a Mark under Sections 8 & 9.

For International Class 009, the mark is in use in commerce on or in connection with **all** goods or services
listed in the existing registration for this specific class: Series of musical sound recordings ; or, the owner
is making the listed excusable nonuse claim.

The owner is submitting one(or more) specimen(s) showing the mark as used in commerce on or in
connection with any item in this class, consisting of a(n) images of the www.americandj.com web page
using the registered mark in connection with sound recordings..

Original PDF file:

[SPN0-9818911180-122926500 . ADJ1-T.01_Specimens.pdf](#)

Converted PDF file(s) (2 pages)

[Specimen File1](#)

[Specimen File2](#)

The registrant's current Attorney Information: Kenneth L. Sherman of MYERS ANDRAS SHERMAN
LLP

19900 MACARTHUR BLVD., 11TH FLOOR
IRVINE, California (CA) 92612
United States

The registrant's proposed Attorney Information: Kenneth L. Sherman of Sherman & Zarrabian LLP
Suite 306
1411 5th Street
Santa Monica, California (CA) 90401
United States

The phone number is 424-229-6800.

The fax number is 424-229-6815.

The email address is trademark@sziplaw.com.

The registrant's current Correspondence Information: KENNETH L. SHERMAN of MYERS ANDRAS SHERMAN LLP

19900 MACARTHUR BLVD., 11TH FLOOR
IRVINE, California (CA) 92612
United States

The registrant's proposed Correspondence Information: KENNETH L. SHERMAN of Sherman & Zarrabian LLP

Suite 306
1411 5th Street
Santa Monica, California (CA) 90401
United States

The phone number is 424-229-6800.

The fax number is 424-229-6815.

The email address is trademark@sziplaw.com.

A fee payment in the amount of \$500 will be submitted with the form, representing payment for 1 class(es), plus any additional grace period fee, if necessary.

Declaration

Section 8: Declaration of Use in Commerce

Unless the owner has specifically claimed excusable nonuse, the mark is in use in commerce on or in connection with the goods and/or services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce.

Section 9: Application for Renewal

The registrant requests that the registration be renewed for the goods and/or services identified above.

The undersigned being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the Owner; and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.

Signature: /jas/ Date: 11/19/2012

Signatory's Name: Joshua A. Schaul

Signatory's Position: Attorney of record, CA bar member
Signatory's Phone Number: 424-229-6800

Mailing Address (current):

MYERS ANDRAS SHERMAN LLP
19900 MACARTHUR BLVD., 11TH FLOOR
IRVINE, California 92612

Mailing Address (proposed):

Sherman & Zarrabian LLP
1411 5th Street
Santa Monica, California 90401

Serial Number: 76240100

Internet Transmission Date: Mon Nov 19 12:40:32 EST 2012
TEAS Stamp: USPTO/S08N09-98.189.11.180-2012111912403
2185391-2652876-49076be1cdf77e05e6d25dc7
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Behind The Sun By Kemi Helwa Club



Much Too Much By Nobody Pacific Dance



Oh Joy By DAD...Club



Richard Mercado American DJ Tracks #1



Scott Davies "The World of Teresa" Dance Music

American DJ Products Include Disco Lights, Club Lighting, DJ Lights, Special Effects, Professional Lighting, & DJ Audio Gear. Quality, Affordable, & Reliable Special Effects Lighting & Audio Products. From A Company You Can Trust!

Specifications, descriptions and pricing subject to change without notice. All pricing is in US\$ and is for reference only and not totally representative of what the "going or street price" may be in any particular geographic area or part of any country. For company and product information contact info@americandj.com

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American DJ

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American DJ played a song



▶ Indian Summer
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American D.



American A.



DJ MISS D.



William Bon

Music

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ROUTING SHEET TO POST REGISTRATION (PRU)

Registration Number: 2652876



Serial Number: 76240100



RAM Sale Number: 12000

RAM Accounting Date: 20121119

Total Fees: \$500

Note: Process in accordance with Post Registration Standard Operating Procedure (SOP)

<u>Transaction</u>	<u>Fee Code</u>	<u>Transaction Date</u>	<u>Fee per Class</u>	<u>Number of Classes</u>	<u>Number of Classes Paid</u>	<u>Total Fee</u>
§8 affidavit	7205	20121119	\$100	1	1	\$100
Application for Renewal (§9)	7201	20121119	\$400	1	1	\$400

Physical Location: 900 - FILE REPOSITORY (FRANCONIA)

Lost Case Flag: False

In TICRS (AM-FLG-IN-TICRS): True

Transaction Date: 20121119

