

ESTTA Tracking number: **ESTTA586752**

Filing date: **02/11/2014**

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	DM Luxury, LLC		
Entity	limited liability company	Citizenship	Delaware
Address	3280 Peachtree Street, Ste. 2300 Atlanta, GA 30305 UNITED STATES		

Attorney information	Robert B. Burlingame Pillsbury Winthrop Shaw Pittman LLP P.O. Box 2824 San Francisco, CA 94126 UNITED STATES rburlingame@pillsburylaw.com, sftrademarks@pillsburylaw.com Phone:415-983-1274
----------------------	---

Registration Subject to Cancellation

Registration No	4456510	Registration date	12/24/2013
Registrant	SagaCity Media, Inc. 921 SW Washington Street, Suite 750 Portland, OR 97205 OR		

Goods/Services Subject to Cancellation

Class 016. First Use: 2013/03/25 First Use In Commerce: 2013/03/25 All goods and services in the class are cancelled, namely: Print publications, namely, magazines and newsletters featuring topics of interest to residents of and visitors to the Houston, Texas metropolitan area
Class 041. First Use: 2013/03/24 First Use In Commerce: 2013/03/24 All goods and services in the class are cancelled, namely: Providing online publications, namely, magazines and newsletters featuring topics of interest to residents of and visitors to the Houston, Texas metropolitan area

Grounds for Cancellation

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	3428194	Application Date	06/16/2005
-----------------------	---------	------------------	------------

Registration Date	05/13/2008	Foreign Priority Date	NONE
Word Mark	HOUSTON MODERN LUXURY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 2004/03/01 First Use In Commerce: 2004/03/01 Magazine in the field of fashion, accessories, jewelry, home design, travel, fine food and wine, culture, art, real estate, society, celebrity, and general luxury lifestyle		

U.S. Registration No.	3328115	Application Date	06/25/2004
Registration Date	10/30/2007	Foreign Priority Date	NONE
Word Mark	HOUSTON MONTHLY MAGAZINE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2004/06/25 First Use In Commerce: 2004/06/25 Electronic publications, namely, a downloadable magazine in the field of fashion, accessories, jewelry, home design, travel, fine food and wine, culture, art, real estate, society, celebrity, and general luxury lifestyle Class 041. First use: First Use: 2004/06/25 First Use In Commerce: 2004/06/25 Providing an on-line magazine, namely, a non-downloadable magazine in the field of fashion, accessories, jewelry, home design, travel, fine food and wine, culture, art, real estate, society, celebrity, and general luxury lifestyle		

U.S. Registration No.	3226063	Application Date	06/03/2004
Registration Date	04/03/2007	Foreign Priority Date	NONE

Word Mark	HOUSTON MONTHLY MAGAZINE
Design Mark	
Description of Mark	NONE
Goods/Services	Class 016. First use: First Use: 2004/07/13 First Use In Commerce: 2004/07/13 Magazine in the field of fashion, accessories, jewelry, home design, travel, fine food and wine, culture, art, real estate, society, celebrity, and general luxury lifestyle

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	HOUSTON MAGAZINE		
Goods/Services	Magazines (hard-copy and electronic)		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	HOUSTON		
Goods/Services	Magazines (hard-copy and electronic)		

Attachments	78652479#TMSN.jpeg(bytes) 78441688#TMSN.jpeg(bytes) 78429239#TMSN.jpeg(bytes) US_SE_404354906_1.PDF(284472 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	/Robert B. Burlingame/
Name	Robert B. Burlingame
Date	02/11/2014

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

_____)	
DM Luxury, LLC,)	Cancellation No. _____
)	
Petitioner,)	
)	<u>PETITION TO CANCEL</u>
v.)	
)	
SagaCity Media, Inc.,)	Mark: HOUSTONIA
)	Registration No.: 4456510
Respondent)	Registration Date: December 24, 2013
)	
_____)	

Petitioner DM Luxury, LLC, a Delaware limited liability company having a business address at 3280 Peachtree Street, Ste. 2300, Atlanta, Georgia 30305 (hereinafter “Petitioner”), believes it is or will be damaged by U.S. Trademark Registration No. 4456510, issued December 24, 2013, in the name of SagaCity Media, Inc. (hereinafter “Respondent”), an Oregon corporation with an address at 921 SW Washington Street, Suite 750, Portland, Oregon 97205, and Petitioner hereby petitions to cancel said registration.

The grounds for this petition to cancel are as follows:

1. Petitioner is the preeminent lifestyle publisher in the United States, with more than 40 titles across 15 markets, reaching more than 6 million active readers.
2. Petitioner provides hard-copy and online publications to U.S. consumers, including print and online magazines featuring topics of interest to residents of and visitors to the Houston, Texas metropolitan area.

3. Petitioner owns and uses the mark HOUSTON in U.S. commerce in connection with magazines in the fields of fashion, accessories, jewelry, home design, travel, fine food and wine, culture, art, real estate, society, celebrity, and general luxury lifestyle.

4. Petitioner owns and uses the mark HOUSTON MAGAZINE in U.S. commerce in connection with magazines in the fields of fashion, accessories, jewelry, home design, travel, fine food and wine, culture, art, real estate, society, celebrity, and general luxury lifestyle.

5. Petitioner owns and uses the mark HOUSTON MODERN LUXURY in U.S. commerce in connection with magazines in the field of fashion, accessories, jewelry, home design, travel, fine food and wine, culture, art, real estate, society, celebrity, and general luxury lifestyle.

6. Petitioner owns and uses the mark HOUSTON MONTHLY MAGAZINE in U.S. commerce in connection with: magazines in the field of fashion, accessories, jewelry, home design, travel, fine food and wine, culture, art, real estate, society, celebrity, and general luxury lifestyle; electronic publications, namely, downloadable magazines in the field of fashion, accessories, jewelry, home design, travel, fine food and wine, culture, art, real estate, society, celebrity, and general luxury lifestyle; and providing an on-line magazine, namely, non-downloadable magazines in the field of fashion, accessories, jewelry, home design, travel, fine food and wine, culture, art, real estate, society, celebrity, and general luxury lifestyle.

7. Petitioner owns the following marks and the U.S. trademark registrations therefor:

Mark	Registration No. & Registration Date	Goods & Services
HOUSTON MODERN LUXURY	Reg. No. 3428194 Reg. Date: 5/13/2008	Magazine in the field of fashion, accessories, jewelry, home design, travel, fine food and wine, culture, art, real estate, society, celebrity, and general luxury lifestyle.
HOUSTON MONTHLY MAGAZINE	Reg. No. 3328115 Reg. Date: 10/30/2007	Electronic publications, namely, a downloadable magazine in the field of fashion, accessories, jewelry, home design, travel, fine food and wine, culture, art, real estate, society, celebrity, and general luxury lifestyle; Providing an on-line magazine, namely, a non-downloadable magazine in the field of fashion, accessories, jewelry, home design, travel, fine food and wine, culture, art, real estate, society, celebrity, and general luxury lifestyle.
HOUSTON MONTHLY MAGAZINE	Reg. No. 3226063 Reg. Date: 4/3/2007	Magazine in the field of fashion, accessories, jewelry, home design, travel, fine food and wine, culture, art, real estate, society, celebrity, and general luxury lifestyle.

8. Petitioner's above-identified marks HOUSTON, HOUSTON MAGAZINE, HOUSTON MODERN LUXURY and HOUSTON MONTHLY MAGAZINE (hereinafter collectively "Petitioner's Marks") are distinctive.

9. Petitioner's marks HOUSTON, HOUSTON MAGAZINE and HOUSTON MODERN LUXURY for magazines are famous in Houston, Texas and throughout the United States.

10. On January 10, 2013, Respondent filed U.S. Trademark Application Serial No. 85820188, based on intent to use, to seek registration of the mark HOUSTONIA in

standard characters for “print publications, including magazines, featuring topics of interest to residents of and visitors to the Houston, Texas metropolitan area” in Class 16 and “on-line publications, including magazines, featuring topics of interest to residents of and visitors to the Houston, Texas metropolitan area” in Class 41.

11. On October 15, 2013, Respondent, through its attorney, filed a Statement of Use for U.S. Trademark Application Serial No. 85820188, which Statement of Use claimed: March 25, 2013, as the date of first use in U.S. commerce, and the date of first use anywhere, for that application’s goods in Class 16; and March 24, 2013, as the date of first use in U.S. commerce, and the date of first use anywhere, for that application’s services in Class 41.

12. On December 24, 2013, U.S. Trademark Registration No. 4456510 was issued in the name of Respondent for the mark HOUSTONIA in standard characters for “print publications, namely, magazines and newsletters featuring topics of interest to residents of and visitors to the Houston, Texas metropolitan area” in Class 16 and “providing online publications, namely, magazines and newsletters featuring topics of interest to residents of and visitors to the Houston, Texas metropolitan area” in Class 41 (hereinafter Respondent’s Mark).

13. Petitioner first used each of Petitioner’s Marks in U.S. commerce in connection with magazines long prior to the first actual or constructive use of Respondent’s Mark.

14. Petitioner first used each of Petitioner’s Marks in U.S. commerce in connection with magazines long prior to the filing date of, registration date of, and dates

of first use in commerce and first use anywhere claimed in, U.S. Trademark Registration No. 4456510.

15. On information and belief, there was no actual or constructive use of Respondent's Mark in U.S. commerce prior to March 2013.

16. To the extent that any of Petitioner's Marks were merely descriptive of the goods and/or services for which they are used, such marks have acquired distinctiveness under Section 2(f) of the Lanham Act and acquired such distinctiveness prior to January 10, 2013 and any other actual or constructive use of Respondent's Mark.

17. Petitioner's marks HOUSTON, HOUSTON MAGAZINE and HOUSTON MODERN LUXURY for magazines became famous prior to January 10, 2013 and any other actual or constructive use of Respondent's Mark.

18. Respondent knew, prior to and on January 10, 2013, that Petitioner was then using one or more of Petitioner's Marks for magazines featuring topics of interest to residents of and visitors to the Houston, Texas metropolitan area.

19. On information and belief, in August 2012, Respondent hired Mr. Louis DeLone, who had served as president and publisher of Petitioner's HOUSTON magazine from approximately 2005 to 2011, to serve as publisher for Respondent's HOUSTONIA magazine.

20. Respondent's Mark so resembles each of Petitioner's Marks as to be likely to cause confusion and/or mistake, and/or to deceive, in violation of Section 2(d) of the Lanham Act.

21. Respondent's Mark is likely to dilute Petitioner's mark HOUSTON, HOUSTON MAGAZINE and/or HOUSTON MODERN LUXURY in violation of Section 43(c) of the Lanham Act.

22. The presence of Respondent's Mark on the Principal Register damages or will damage Petitioner.

WHEREFORE, the Board should sustain this Petition to Cancel and cancel U.S. Trademark Registration No. 4456510.

Date: February 11, 2014

Respectfully submitted,

Attorneys for DM Luxury, LLC

By: 
ROBERT B. BURLINGAME
PILLSBURY WINTHROP SHAW PITTMAN LLP
Calendar/Docketing Department
P.O. Box 2824
San Francisco, CA 94126-2824
Tel: (415) 983-1274
Fax: (415) 983-1200
rburlingame@pillsburylaw.com

Cancellation No. _____

PROOF OF SERVICE BY FIRST-CLASS MAIL

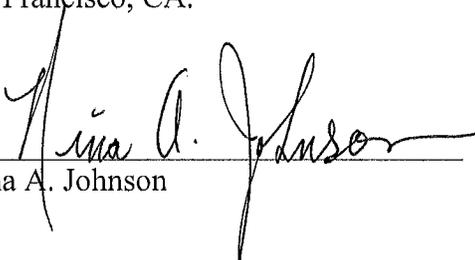
I, Nina A. Johnson, the undersigned, hereby certify and declare under penalty of perjury that the following statements are true and correct:

1. I am over the age of 18 years and am not a party to the within cause. I am employed by Pillsbury Winthrop Shaw Pittman LLP in San Francisco, CA.
2. My business address is Four Embarcadero Center, 22nd Floor, San Francisco, CA 94111. My mailing address is P.O. Box 2824, San Francisco, CA 94126-2824.
3. On February 11, 2014, I served a true copy of the attached document titled exactly "Petition to Cancel" by placing it in a sealed envelope with postage thereon fully prepaid and transmitting it by First-Class Mail, to the following address:

**James L. Vana
Perkins Coie LLP
1201 3rd Ave. Ste 4900
Seattle, Washington 98101**

I declare under penalty of perjury that the foregoing is true and correct.

Executed this 11th day of February, 2014, at San Francisco, CA.



Nina A. Johnson