

ESTTA Tracking number: **ESTTA602744**

Filing date: **05/06/2014**

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	D.O.C. Restaurant Group, LLC DBA A16 Restaurant and Wine Bar		
Entity	Limited liability company	Citizenship	California
Address	2355 Chestnut Street San Francisco, CA 94123 UNITED STATES		

Attorney information	Beth M. Goldman Orrick, Herrington & Sutcliffe LLP 405 Howard Street San Francisco, CA 94105 UNITED STATES ipprosecutionsf@orrick.com, beth.goldman@orrick.com, blee@orrick.com Phone:415-773-5700
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Registration Subject to Cancellation

Registration No	4462551	Registration date	01/07/2014
Registrant	HP53 Manager LLC 824 West Superior, Suite 210 Chicago, IL 60642 UNITED STATES		

Goods/Services Subject to Cancellation

Class 043. First Use: 2012/09/01 First Use In Commerce: 2012/09/01 All goods and services in the class are cancelled, namely: Restaurant and cafe services

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	3182394	Application Date	01/11/2006
Registration Date	12/12/2006	Foreign Priority Date	NONE
Word Mark	A 16		
Design Mark	A 16		

Description of Mark	NONE
Goods/Services	Class 043. First use: First Use: 2004/02/14 First Use In Commerce: 2004/02/14 restaurant services

U.S. Registration No.	3182393	Application Date	01/11/2006
Registration Date	12/12/2006	Foreign Priority Date	NONE

Word Mark	A 16
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Design Mark	
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Description of Mark	NONE
Goods/Services	Class 043. First use: First Use: 2004/02/14 First Use In Commerce: 2004/02/14 restaurant services

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	A16		
Goods/Services	Books in the field of cooking		

Attachments	76653357#TMSN.gif(bytes) 76653356#TMSN.gif(bytes) Petition to Cancel A10.pdf(176286 bytes) Exhibit A - A16 Consent Decree.pdf(111165 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	/Betsy Wang Lee/
Name	Betsy Wang Lee
Date	05/06/2014

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

In the Matter of Registration No. 4,462,551
Trademark: **A10**

<p>D.O.C. Restaurant Group, LLC DBA A16 Restaurant and Wine Bar,</p>	
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Petitioner,

v.

HP53 Manager LLC,

Respondent.

PETITION TO CANCEL

D.O.C. Restaurant Group, LLC DBA A16 Restaurant and Wine Bar (“Petitioner”), a California limited liability company having a principal place of business at 2355 Chestnut Street, San Francisco, California 94123, believes that it is and will continue to be damaged by Registration No. 4,462,551 for the mark A10 in International Class 43 and hereby petitions to cancel the same.

As grounds for cancellation, Petitioner alleges:

1. HP53 Manager LLC (“Respondent”) appears as the Registrant of Registration No. 4,462,551 for the mark A10 for “restaurant and cafe services” in International Class 43.
2. Respondent is, upon information and belief, an Illinois limited liability company having a place of business at 824 West Superior Street, Suite 210, Chicago, Illinois 60642.
3. Petitioner has used the marks A 16 and A 16 & Design (collectively, the “A 16 Mark”) since at least as early as February 14, 2004 in connection with restaurant services and

since at least as early as August 2008 in connection with books in the field of cooking. In addition, Petitioner is the owner of two incontestable registrations for the A 16 Mark (United States Registration Nos. 3,182,394 and 3,182,393, both registered December 12, 2006) for “restaurant services” in International Class 43.

4. Petitioner’s Registration Nos. 3,182,394 and 3,182,393 are valid, subsisting and incontestable pursuant to Section 15 of the Lanham Act, 15 U.S.C. §1065, and are conclusive evidence of the validity of each registered mark set forth therein and of Petitioner’s exclusive right to use each registered mark in connection with the services listed in those registrations, as provided by Section 33(b) of the Lanham Act, 15 U.S.C. § 1115(b).

5. There is no issue as to priority. Respondent’s filing date and alleged first use date for the A10 mark are May 28, 2013 and September 1, 2012 respectively. The date of issuance of Petitioner’s registrations for the A 16 Mark is December 12, 2006, which is well before Respondent’s filing date or alleged first use date of the A10 mark.

6. Petitioner has used the A 16 Mark in United States commerce in connection with restaurant services since February 2004 and with cookbooks since August 2008, and has developed exceedingly valuable goodwill with respect to the A 16 Mark.

7. By virtue of its efforts and the expenditure of considerable sums for promotional and advertising activities and by virtue of the excellence of its goods and services, Petitioner has gained for its A 16 Mark a most valuable reputation and has created, in the minds of the buying public, an exclusive association between A 16 and its goods and services.

8. The trademark registered by Respondent, namely, A10, is likely to be confused with Petitioner’s A 16 Mark because the marks are similar in appearance and overall commercial impression.

9. Respondent has registered A10 as a mark in connection with services in International Class 43 that are highly related to the goods and services of Petitioner and such use so nearly resembles Petitioner's use as to be likely to cause confusion, to cause mistake or to deceive within the meaning of 15 U.S.C. § 1052(d).

10. If Respondent is permitted to use A10 for its services as specified in the challenged registration, confusion in trade resulting in damage and injury to Petitioner would be caused and would result by reason of the fact that Respondent's mark is confusingly similar to Petitioner's mark. Persons familiar with Petitioner's A 16 Mark would be likely to purchase Respondent's A10 services in International 43 as services offered and sold by Petitioner. Furthermore, any defect, objection, or fault found with Respondent's services marketed under the A10 mark in International Class 43 would be likely to reflect upon and seriously injure the reputation that Petitioner has established for its goods and services offered under the A 16 Mark.

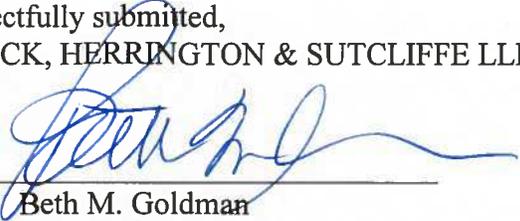
11. Moreover, the United States District Court for the Northern District of California has in the past recognized that a likelihood of confusion exists between Petitioner's A 16 Mark and an A5 mark also for use with restaurant services. A true and correct copy of the court order prohibiting defendant from using the combination of an initial letter "A" with any number for restaurant, bar or lounge services is attached hereto as Exhibit A.

12. If Respondent is permitted to maintain the registration herein opposed, it will continue to hold at least a prima facie exclusive right to use of A10. Such a registration would continue to be a source of damage and injury to Petitioner.

WHEREFORE, Petitioner prays that the cancellation be sustained and that Registration No. 4,462,551 be cancelled.

Respectfully submitted,
ORRICK, HERRINGTON & SUTCLIFFE LLP

Dated: May 6, 2014

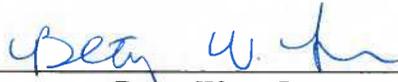
By: 
Beth M. Goldman
Betsy Wang Lee
Attorneys for Petitioner
405 Howard Street
San Francisco, CA 94105
415-773-5700

CERTIFICATE OF SERVICE

I certify that a copy of the foregoing PETITION TO CANCEL was served by First Class Mail, on May 6, 2014, on Respondent at its address of record:

HP53 Manager LLC
824 West Superior Street, Suite 210
Chicago, Illinois 60642

Dated: May 6, 2014

By: 
Bejsy Wang Lee

Attorneys for Petitioner
ORRICK, HERRINGTON & SUTCLIFFE LLP
405 Howard Street
San Francisco, CA 94105

EXHIBIT A

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7 Attorneys for Plaintiff
 8 D.O.C. RESTAURANT GROUP, LLC dba A16
 RESTAURANT AND WINE BAR
 9

10 UNITED STATES DISTRICT COURT
 11 NORTHERN DISTRICT OF CALIFORNIA

12 D.O.C. RESTAURANT GROUP, LLC dba
 13 A16 RESTAURANT AND WINE BAR, a
 California limited liability company,

14 Plaintiff,

15 v.
 16

17 SCOTT ALLEY ASSOCIATES, LLC dba
 18 A5 STEAK LOUNGE, a California limited
 liability company; and ALBERT CHEN, an
 19 individual,

20
 21 Defendants.
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Case No. C 09-00949 CRB

~~PROPOSED~~ JUDGMENT AND
 PERMANENT INJUNCTION

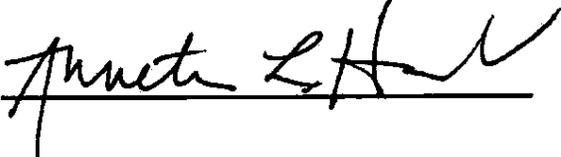
1 Pursuant to the stipulation of the parties, IT IS HEREBY ORDERED,
2 ADJUDGED AND DECREED that judgment shall be and hereby is entered for
3 Plaintiff in this action, and that effective March 24, 2009, *nunc pro tunc*, Defendants
4 and the other persons identified herein were, are and shall be permanently enjoined as
5 follows.

6 1. Scott Alley Associates LLC, Albert Chen, Stephen Chen, Marc Vogel,
7 Donovan Friedman, and all other members, employees, officers, and agents of each
8 of them, and all persons acting in concert with each of the foregoing who have actual
9 notice of this permanent injunction by personal service or otherwise, shall be and
10 hereby are permanently enjoined, restrained and prohibited from using as a service
11 mark the mark A5, or any other mark confusingly similar to Plaintiff's mark A16
12 including without limitation any letter "A" plus number mark. Use as a service mark
13 includes, without limitation, the use of the mark as the name of any restaurant, bar or
14 lounge or use in a uniform resource locator (URL) as a domain name for a web site.

15 2. Defendants shall adopt a new mark consistent with the foregoing
16 requirements, hereafter known as the "Replacement Mark." Any Replacement Mark
17 shall not be confusingly similar to Plaintiff's A16 mark. In particular, though without
18 limitation, any Replacement Mark that is a composite mark including a letter-"A"-
19 plus-number as a part thereof must comply with the following requirements: (a) each
20 part of the letter-"A"-plus-number portion shall be contiguous to the other portions of
21 the composite mark such that there shall be no spaces between; and (b) each part of
22 the letter-"A"-plus-number portion of the composite mark shall be of the same size,
23 font and color as each of the other portions of the composite mark; and (c) each part
24 of the letter-"A"-plus-number portion shall not be emphasized by the use of italics,
25 underlining or other standard means of emphasis unless the remainder of the
26 composite mark also uses such means of emphasis. Provided that Defendants
27 comply with the foregoing requirements, use of 5A5 as a Replacement Mark shall not
28 be a contempt of this injunction.

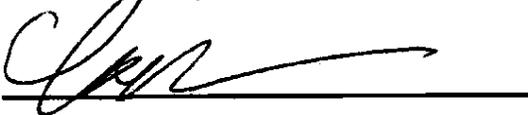
1 Submitted by:

2 Annette L. Hurst, Esq.
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4 405 Howard Street
5 San Francisco, CA 94105

6 
7

8 So stipulated:

9 Ivo Labar, Esq.
10 Kerr & Wagstaffe
11 100 Spear Street, Suite 1800
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