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

Proceeding	92060029
Party	Plaintiff Jahn & Associates, LLC
Correspondence Address	KIRSTIN M JAHN JAHN & ASSOCIATES LLC 1942 BROADWAY , SUITE 314 BOULDER, CO 80304 UNITED STATES Kirstin@jahnlaw.com
Submission	Reply in Support of Motion
Filer's Name	Kirstin M. Jahn
Filer's e-mail	Kirstin@jahnlaw.com
Signature	/kmj/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of the Cancellation for Registration of: BIG FIRM EXPERIENCE... SMALL FIRM SERVICE; Registration Number: 4015965; Filing Date: February 1, 2011.

Jahn & Associates, LLC
Petitioner

v.

Melvin N.A. Avanzado
Respondent.

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) CANCELLATION NO. 92060029
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Petitioner Jahn & Associates, LLC hereby replies to Respondent, Melvin N.A. Avanzado's Response to Petitioner's Motion for Summary Judgment as follows:

SUMMARY

None of the probative facts are disputed. Petitioner is the senior user of the mark SMALL FIRM, BIG EXPERIENCE which was first used in October of 2001 and has been registered on the principal register since June 23, 2009. *Statement of Material Facts (SMF) at 1 and 3; Undisputed by Respondent.* Respondent is the owner of BIG FIRM EXPERIENCE, SMALL FIRM SERVICE which has been registered for less than 5 years, since August 23, 2011. *SMF at 8, Undisputed by Respondent.* Petitioner and Respondent both practice law, including litigation services specifically intellectual property and entertainment law and litigation. *SMF at 11; Resp. to Motion for Summary Judgment (Resp. MSJ) at p.3.* Petitioner and Respondent market in and to the same trade channels. *Id. and Resp. MSJ Exhibits 2 and 10.* Respondent had constructive notice of Petitioner's mark prior to filing its application for federal registration. *SMF at 1 and 3; Undisputed by Respondent and Resp. to MSJ Exhibit 1 at MMAA-TM-000039-44 and Ex. 7, Rog. No. 11.*

Petitioner will respond to the following arguments and/or evidence submitted by Respondent: Lack of actual confusion in the marketplace, third party use of similar terms, Diligence to police mark by Petitioner, Respondent's bad faith intent in selecting its mark.

POINTS AND AUTHORITIES

Actual Confusion

Respondent argues that since it has no knowledge of confusion in the marketplace between Petitioner and Respondent that there has been no confusion and there will not be any confusion in the future. This argument misses the point. Simply because there is no known confusion in the past does mean there has been no confusion nor does it bear any weight in determining likelihood of future confusion. No known instances of actual confusion are of little evidentiary value in determining likelihood of confusion. *See In re Bissett-Berman Corp.*, 476 F.2d 640, 642, 177 U.S.P.Q. 528, 529 (CCPA 1973) (self-serving testimony of lack of confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion). A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight, *J.C. Hall Co. v. Hallmark Cards, Inc.*, 52 C.C.P.A. 981, 340 F.2d 960, 964, 144 USPQ 435, 438 (CCPA 1965); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 1317, 65 U.S.P.Q.2d 1201 (Fed. Cir. 2003). As such, Respondent's arguments of lack of actual confusion should be given very little, if any, weight.

"[F]inally, the overriding concern is not only to prevent buyer confusion as to the

source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer.” *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

Trade Channels/ Same Legal Practice Area

Respondent makes a disingenuous argument that the services and trade channels between Petitioner and Respondent do not overlap. Plain and simple, Petitioner and Respondent practice law, specifically, intellectual property law - which encompasses litigation and entertainment law.

Both parties advertise their services on the Internet, which is omnipresent. Because intellectual property is federal in nature, stemming from Article 1 of the constitution (Patents and Copyrights) and Article 15 of the United States Code (Trademarks), Petitioner practices litigation of intellectual property all over the United States, including California because attorneys are allowed to be admitted *pro hac vice* in any federal jurisdiction for a particular matter.

In light of the above, the services and trade channels for Petitioner and Respondent overlap significantly.

Third Party Use

Respondent did not provide any federal registrations showing third party use of similar marks. Respondent’s sole attempt to show third party use is through the

submission of screen captures of seven websites. *See, Resp to MSJ at Exhibit 9.*

None of this evidence is probative of third party use because it does not show: 1) whether the marks were and are actually used by the third parties, 2) whether trademark use is made, 3) how long the websites have used the alleged similar terms, 4) whether the use is sufficient to be “use in commerce”, 4) whether the alleged third party use is recognized by consumers, or 5) the authenticity of each website. Overall, the record does not contain any evidence to support the claim that plaintiff’s trademark was weakened by uses of similar marks by third parties. *Scarves by Vera, Inc. v. Todo Imports Ltd.*, 544 F.2d 1167, 1173-74 (2d Cir. 1976)

“The probative value of third-party trademarks depends entirely upon their usage.” *Scarves by Vera, Inc. v. Todo Imports, Ltd.*, 544 F.2d 1167, 1173 (2d Cir.1976) (“Defendant introduced no evidence that these trademarks were actually used by third parties, that they were well promoted or that they were recognized by consumers.”)

Lilly Pulitzer, Inc. v. Lilli Ann Corp., 376 F.2d 324, 325, 54 C.C.P.A. 1295 (1967); *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée*, 396 F.3d 1369, 1373-74 (Fed. Cir. 2005). Mere website captures of potential use of a mark is not enough to evidence the consuming public’s awareness of the third party uses. *Id.* “[W]here the ‘record includes no evidence about the extent of third-party uses ... the probative value of this evidence is thus minimal.’” *Id.*, citing *Han Beauty, Inc. v. Alberto–Culver Co.*, 236 F.3d 1333, 1338 (Fed. Cir.2001).

In sum, Respondent failed to provide sufficient evidence to support a claim that plaintiff’s trademark is weakened by uses of similar marks by third parties.

Diligence in Policing Mark

Respondent alleges Petitioner's mark is weak or has fallen abandoned because of third party use. Yet, Petitioner is not required to act immediately against every possibly infringing use to avoid losing rights to its mark. *United States Jaycees v. Philadelphia Jaycees*, 639 F.2d 134, 209 USPQ 457 (CA 3 1981).

Such a requirement would unnecessarily clutter the courts. Some infringements are short-lived and will disappear without action by the trademark owner. In the case of a mark temporarily not in use or only used to a limited extent, a company may be hard pressed to extend its financial resources to fight an infringer when it has little or no current market under its mark.

Wallpaper Mfrs., Ltd. v. Crown Wallcovering Corp., 680 F.2d 755, 766 (C.C.P.A. 1982).

Throughout its federal registration, Petitioner has policed its mark and continues to do so. See, *MSJ, Exhibits D and E which show various cease and desist letters and compliance with ceasing to use similar marks.*

On the other hand, Respondent has provided no evidence showing any diligence in protecting its mark. Respondent's lack of diligence has allowed its mark to become weak and unprotectable.

Respondent's Bad Faith in Selecting Its Mark

Respondent submitted ample evidence showing Respondent selected its mark after Petitioner's mark was already filed (11/13/2008) and Respondent did not use its mark until after Petitioner's registration (6 23/2009). *SMF at 1 and 2*. The evidence provided by Respondent shows that Respondent did not use the mark at the time it averred to in its declaration of use - March 1, 2008. See, *Resp. to MSJ Exhibit 7, Respondent's Interrogatory Response No. 11*. Likely Respondent did not use its mark until after it was selected sometime after June of 2009. See emails between

Respondent and website designer. *Resp. MSJ at Exhibit 1 at MNAA-TM-000039-44.*

Respondent had at least constructive knowledge of Petitioner's mark which is an indication of bad faith in adopting a similar mark. In determining a defendant's intent, "actual or constructive knowledge" of the prior user's mark or dress may indicate bad faith. *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254, 259 (2d Cir.1987). Where such prior knowledge is accompanied by similarities so strong that it seems plain that deliberate copying has occurred, we have upheld findings of bad faith. *Id.* at 258–*59; *Charles of the Ritz*, 832 F.2d at 1318-20, 1322; *Paddington Corp. v. Attiki Importers & Distributors, Inc.*, 996 F.2d 577, 587 (2d Cir. 1993). Moreover, presumably, since Respondent practices Intellectual Property law, he understands the need to conduct a trademark search prior to adopting his own mark. Yet, when requested, Respondent provided no evidence that a search on its mark was ever conducted. See, *Resp. MSJ at Exhibit 7, Response to Interrogatory Nos. 12-13.*

In sum, Respondent's mark should be cancelled because of Respondent's bad faith in adopting his confusingly similar mark.

CONCLUSION

Petitioner's motion for summary judgment should be granted because Petitioner mark, SMALL FIRM, BIG EXPERIENCE and Respondent's mark BIG FIRM EXPERIENCE, SMALL FIRM SERVICE are confusingly similar; the marks a) are similar in sight, sound and meaning, b) are used for the exact same services and c) market in the exact same trade channels. Further, Petitioner has a strong mark which it is diligent in defending and Respondent is charged with bad faith in adopting his mark.

Date: November 5, 2015

Respectfully submitted,
JAHN & ASSOCIATES, LLC

s/Kirstin M. Jahn

CERTIFICATE OF SERVICE

I hereby certify that Petitioner's Reply to Respondent's Response to Petitioner's Motion for Summary Judgment is being deposited on November 5, 2015 by United States Post Office with sufficient postage as first-class mail in an envelope addressed to:

Melvin N.A. Avanzado
1880 Century Park East
Suite 1100
Los Angeles, CA 90067

and via email to:
elaine@avanzadolaw.com

s/Kirstin M. Jahn