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

Proceeding	92060029
Party	Defendant Melvin N.A. Avanzado DBA The Avanzado Law Firm
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

JAHN & ASSOCIATES, LLC

Petitioner,

v.

MELVIN N.A. AVANZADO,

Registrant/Respondent.

**CANCELLATION NO.: 92060029**

MARK: BIG FIRM EXPERIENCE,  
SMALL FIRM SERVICE  
(Registration Number: 4015965)

Filing Date: February 1, 2011

*[Request for Judicial Notice, Statement of Undisputed Facts, Declaration of Melvin N.A. Avanzado, and Declaration of Kelly D. Talcott filed concurrently herewith]*

**RESPONDENT AND DEFENDANT MELVIN N.A. AVANZADO'S MOTION FOR**  
**SUMMARY JUDGMENT**

**I.**

**INTRODUCTION**

Respondent Melvin N.A. Avanzado ("Avanzado") seeks summary judgment against of Claimant Kirstin Jahn and Jahn & Associates, LLC (collectively "Jahn") on Jahn's cancellation petition of Avanzado's registered service mark "Big Firm Experience ... Small Firm Service" (the "Avanzado Mark"). Avanzado seeks summary judgment on grounds that (a) there is no genuine issue of material fact that the doctrine of laches applies to preclude Jahn from petitioning to cancel the Avanzado Mark; and (b) there is no genuine issue of material fact that

the Avanzado Mark will cause a likelihood of source confusion with Jahn's registered service mark, "Small Firm, Big Experience" (the "Jahn Mark").

Beyond Jahn's conclusory allegations and speculative contentions, Jahn has no proof that there is any possibility, let alone likelihood, of confusion between the two marks. Jahn cannot submit – because it does not have -- admissible evidence of actual confusion or admissible evidence to support its claim that the two marks will lead to a "likelihood of confusion."

Avanzado is licensed to practice law in California; Jahn is only licensed to practice law in Colorado, Nevada and New York. Avanzado has never had a potential client mistake him or his firm for Jahn or Jahn's firm. Avanzado and Jahn market to different segments of the public that are not likely to intersect. Potential and actual consumers of legal services are sophisticated individuals who are not likely to be confused by the two marks or the two firms; people who seek legal and litigation services do not rely solely on a tagline or service mark in choosing legal representation and Jahn has no admissible evidence to prove otherwise. None of these considerations permits a reasonable inference that confusion is likely to occur between Avanzado and Jahn due to their service marks.

As detailed below, the uncontroverted facts establish that Jahn cannot meet its burden to prove its claims as a matter of law.

**A. THE PARTIES**

1. Respondent Avanzado owns and operates The Avanzado Law Firm, a professional law corporation in Los Angeles, California. (Avanzado Decl. ¶ 1.) Avanzado spent many years practicing law at "big" law firms. (Avanzado Decl. ¶¶ 1-6.) Avanzado started practicing law at Latham & Watkins, a firm with thousands of lawyers. (Avanzado Decl. ¶ 3.) In 1993, Avanzado joined another large firm by the name of Christensen, White, Miller, Fink &

Jacobs (later known as Christensen, White, Miller, Fink, Glaser & Shapiro LLP) where his practice shifted focus to entertainment, media and intellectual property disputes. (Avanzado Decl. ¶ 4.) In 1996, Avanzado left Christensen, White, Miller, Fink & Jacobs and co-founded White O'Connor Curry & Avanzado LLP – a boutique law firm which focused on entertainment, media, labor and intellectual property disputes. (Avanzado Decl. ¶ 5.) In 2005, Avanzado became a partner in the Entertainment Practice Group of another large firm, Jeffer Mangels, Butler & Marmaro LLP. (Avanzado Decl. ¶ 6.) Jeffer Mangels has over one hundred attorneys in its employ. (Avanzado Decl. ¶ 6.) At Jeffer Mangels, Avanzado continued civil litigation practice focusing on entertainment, intellectual property, employment and other business disputes. (Avanzado Decl. ¶ 6.)

Avanzado founded The Avanzado Law Firm in July 2008. (Avanzado Decl. ¶1.) The Avanzado Law Firm specializes in entertainment and sports litigation, intellectual property litigation, media and First Amendment litigation, complex civil litigation and employment litigation. (*Id.*) Avanzado and his associate are licensed to practice law in California; they are not licensed to practice law in any other state. (Avanzado Decl. ¶¶ 1, 7.)

Avanzado is the registered owner of the service mark “Big Firm Experience ... Small Firm Service,” registration number 4,015,965. (Avanzado Decl. ¶¶ 9-12, Exh. 4.) The Avanzado Mark is registered under international class number “045” for legal services and is identified for use in connection with “litigation services.” (Avanzado Decl. ¶ 10, Exh. 2.) Avanzado applied for trademark registration of the Avanzado Mark on February 1, 2011. (Avanzado Decl. ¶ 10, Exh. 2.) Three months later, the Avanzado Mark was approved for publication by the USPTO in its Trademark Official Gazette, stating

The mark identified above has been published in the *Trademark Official Gazette* (OG) on June 07, 2011. Any party who believes it will be damaged by the registration of the mark may file a notice of opposition (or extension of time therefor) with the Trademark Trial and Appeal Board. If no party files an opposition or extension request within thirty (30) days after the publication date, then within twelve (12) weeks of the publication date a certificate of registration should issue.

(Avanzado Decl. ¶ 11, Exh. 3.)

The Avanzado Mark was published in the Trademark Official Gazette on June 7, 2011 for 30 days. (Avanzado Decl. ¶ 11, Exh. 3.) The Avanzado Mark did not encounter any challenge or opposition during this period and became officially registered with the USPTO on August 23, 2011. (Avanzado Decl. ¶¶ 11-13, Exhs. 4, 6 & 7.)

Jahn owns and operates the law firm of Jahn & Associates, LLC. (Avanzado Decl. ¶ 21, Exh. 11.) Jahn's practice operates out of two offices: a Colorado office and a Nevada office. (Avanzado Decl. ¶ 21, Exhs. 6 & 11.) Jahn is not licensed to practice law in the state of California. (Avanzado Decl. ¶ 16, Exhs. 6 & 11.) Jahn is the owner of the service mark "Small Firm, Big Experience" (the "Jahn Mark") registration number 3,642,830. (Exh. 8 to Avanzado Decl.) The Jahn Mark was registered on June 23, 2009. (Exh. 8 to Avanzado Decl.) Jahn filed a petition to cancel the Avanzado Mark on September 23, 2014. (Avanzado Decl. ¶ 14; Docket No. 1 (Petition for Cancellation).)

## **B. FACTUAL & PROCEDURAL BACKGROUND**

Several months after The Avanzado Law Firm's inception, Avanzado came up with the phrase "Big Firm Experience, Small Firm Service" to convey his litigation experience: a big firm

lawyer turned small firm practitioner with the corresponding level of attention and service.

(Avanzado Decl. ¶ 9, Exh. 1.) In February 2011, Avanzado applied for registration of the service mark “Big Firm Experience ... Small Firm Service” (the “Avanzado Mark”) with the United States Patent and Trademark Office (“USPTO”). (Avanzado Decl. ¶ 10, Exh. 2.)

As part of the Avanzado Mark’s application process, the Avanzado Mark was published in the Official Trademark Gazette on June 7, 2011. (Avanzado Decl. ¶ 11, Exh. 3.) No individual or entity opposed the Avanzado Mark. (Avanzado Decl. ¶¶ 11-13.) Since the Avanzado Mark did not encounter any opposition, the USPTO registered the Avanzado Mark on August 23, 2011. (Avanzado Decl. ¶¶ 11-13, Exh. 4.)

On September 23, 2014 – three years and one month since the Avanzado Mark became a registered trademark, Jahn filed a petition for cancellation of the Avanzado Mark on the grounds of “priority” and “likelihood of confusion.” (Avanzado Decl. ¶¶ 13-14, Exh. 5; Petition for Cancellation at 1.)

On September 5, 2015, Jahn filed a motion for summary judgment on the basis that the Avanzado Mark was “confusingly similar” to the Jahn Mark due to the alleged similarity in “sight, sound and meaning” and use of the Marks for the “same services and market in the same trade channels.” (Docket No. 7, Jahn Mot. for Summ. Jmt. (the “Jahn MSJ”) at 2.)

Avanzado filed his opposition to Jahn’s summary judgment motion on October 12, 2015. (Docket No. 14.) Jahn filed its reply brief on November 5, 2015. (Docket No. 16.)

The Trademark Trial and Appeal Board (the “TTAB”) denied Jahn’s summary judgment motion on January 26, 2016 on the grounds that there were genuine issues of material fact as to the “similarity” of the marks, and the “commercial impressions” created by the marks, the strength of Jahn’s mark and third-party use of similar marks. (Docket No. 18.)

## II.

### **AVANZADO'S SUMMARY JUDGMENT MOTION SHOULD BE GRANTED**

As further discussed below, the Board should grant Avanzado's summary judgment and deny Jahn's petition for cancellation on the ground that laches applies to Jahn's unreasonable delay in asserting its rights and also on the ground that the Avanzado Mark does not create a likelihood of confusion such that consumers assume that the Avanzado Mark and the Jahn Mark belong to the same source. As presented below, Jahn has no admissible evidence to defeat Avanzado's summary judgment motion.

#### **A. SUMMARY JUDGMENT STANDARDS**

The Federal Rules of Civil Procedure generally apply to proceedings before the TTAB. *Opryland USA, Inc. v. Great American Music Show, Inc.*, 23 U.S.P.Q. 2D (BNA) 1471, 1472 (Fed. Cir. 1992) (citing 37 C.F.R. § 2.116(a)). Summary judgment is appropriate after adequate discovery when the evidence demonstrates that there is no genuine issue as to any material fact and the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56; *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247-48, 91 L. Ed. 2d 202, 106 S. Ct. 2505 (1986). Summary judgment is proper on issues such as likelihood of confusion when there fails to be a genuine issue as to any material fact. *Blanchard Importing & Distributing Co. v. Societe E. Blanchard Et Fils*, 56 C.C.P.A. 716, 721, 159 U.S.P.Q. (BNA) 520 (C.C.P.A. 1968).

On a motion for summary judgment, the TTAB must first ascertain whether there is a genuine issue as to any material fact. Fed. R. Civ. P. 56(c). A material fact is one that may affect the decision, whereby the finding of that fact is relevant and necessary to the proceedings. *Anderson*, 477 U.S. at 248. A genuine dispute is shown to exist if sufficient evidence is presented such that a reasonable fact finder could decide the question in favor of the non-moving

party. *Id.* The mere existence of a factual dispute, by itself, is not sufficient to bar summary judgment. *Id.* “To be material, the factual assertion must be capable of affecting the substantive outcome of the litigation; to be genuine, the issue must be supported by sufficient admissible evidence that a reasonable trier-of-fact could find for the nonmoving party.” *Id.* at 251. “If the evidence is merely colorable, or is not sufficiently probative, summary judgment may be granted.” *Id.* at 249-50.

The moving party bears the initial burden of establishing the absence of a genuine issue of material fact and satisfies that burden by showing “that there is an absence of evidence to support the non-moving party’s case.” *Celotex Corp. v. Catrett*, 477 U.S. 317, 323-25, 106 S. Ct. 2548, 91 L. Ed. 2d 265 (1986).

As detailed below, the uncontroverted facts establish that laches precludes Jahn from bringing forth the cancellation proceedings due to its inexcusable delay. The uncontroverted facts further establish that Jahn cannot prevail on its likelihood of confusion claim as a matter of law.

**B. LACHES PRECLUDES JAHN’S CANCELLATION PROCEEDINGS  
BECAUSE JAHN UNREASONABLY WAITED OVER THREE YEARS  
FROM THE AVANZADO MARK’S REGISTRATION TO ASSERT ITS  
RIGHTS**

The Lanham Act expressly provides for defensive use of equitable principles, including laches. *See* 15 U.S.C. § 1069 (“In all inter partes proceedings equitable principles of laches, estoppel, and acquiescence, where applicable may be considered and applied.”) To prevail on this affirmative defense, the respondent must demonstrate the claimant’s undue or unreasonable delay and prejudice to respondent resulting from the delay. *Bridgestone/Firestone Research, Inc. v. Automobile Club de l’Ouest de la France*, 58 U.S.P.Q.2D (BNA) 1460, 1462 (Fed.Cir.

2001). In addition, the respondent must establish that confusion between the parties' marks is not inevitable. *Ultra-White Co., Inc. v. Johnson Chemical Industries, Inc.*, 465 F.2d 891, 175 U.S.P.Q. 166 (C.C.P.A. 1972).

As detailed below, Jahn's unexplained and unreasonable delay in taking action against the Avanzado Mark and resulting prejudice to Avanzado from this delay compel the TTAB to dismiss Jahn's cancellation proceeding.

**1. Jahn Inexcusably Delayed Challenging The Avanzado Mark**

In determining whether a party has "too long 'slept on its rights,'" it is necessary to show that the party "knew or should have known that it had a right of action, yet did not act to assert or protect its rights." *Bridgestone/Firestone*, 245 F.3d at 1361-62.

A petitioner in a cancellation proceeding must be shown to have had actual knowledge or constructive notice of a registrant's trademark use to establish a date of notice from which a delay of laches can be measured. *Teledyne Technologies, Inc. v. Western Skyways, Inc.*, Cancellation No. 92041265 at \*21 (TTAB February 2, 2006) (citing *Loma Linda Food Co. v. Thomson & Taylor Spice Co.*, 279 F.2d 522, 126 U.S.P.Q. 261 (C.C.P.A. 1960)); *Teledyne Technologies, Inc. v. Western Skyways, Inc.*, 208 Fed. Appx. 886, 890 (Fed. Cir. Ct. App. 2006). Laches begins to run once a mark becomes registered on the principal register. *See* 15 U.S.C. § 1072 ("Registration of a mark on the principal register . . . shall be constructive notice of the registrant's claim of ownership thereof.").

*Teledyne* is instructive regarding when laches bars a party from petitioning to cancel a registrant's mark. In *Teledyne*, the petitioner waited approximately three years and eight months from when respondent's trademark registered on the principal register before initiating cancellation proceedings. *Teledyne*, Cancellation No. 92041265 at \*22-24 (TTAB February 2,

2006). The *Teledyne* petitioner failed to provide any reason for this delay, leading TTAB to conclude that the petitioner unduly delayed prior to filing the petition for cancellation and ultimately dismissing the petitioner's petition for cancellation on the basis of laches. *Teledyne*, Cancellation No. 92041265 at \*28 (TTAB February 2, 2006) (citing *Procter & Gamble Co. v. J.L. Prescott Co.*, 102 F.2d 773, 40 U.S.P.Q. 434, 442 (3d Cir. 1939) (affirming estoppel of counterclaims by laches because unexplained delay "must weigh heavily in the balance against it")); *Teledyne Technologies*, 208 Fed. Appx. At 890 (affirming dismissal on grounds of laches due to petitioner's failure to explain three-year delay in asserting its rights).

Like the *Teledyne* petitioner, Jahn failed to assert its rights in a timely manner. The Avanzado Mark's principal register registration issued on August 23, 2011, thereby putting Jahn on constructive notice of Avanzado's claim of ownership on the same date. (Avanzado Decl. ¶¶ 11-13, Exh. 4.) Jahn first learned of the Avanzado Mark in 2013, yet Jahn waited until September 23, 2014 to file the petition for cancellation. (Avanzado Decl. ¶¶ 13 & 17, Exhs. 5 & 7 (Jahn's Response to Interrogatory No. 5).) Thus, Jahn delayed filing the petition for cancellation by three years and one month.<sup>1/</sup> Jahn failed to proffer any reason or excuse for her delay. (Avanzado Decl. ¶¶ 16-20, Exhs. 6-10.)

Accordingly, Jahn's inexcusable and undue delay compels a finding of laches.

**2. Jahn's Inexcusable Delay In Challenging The Avanzado Mark Prejudices Avanzado and The Avanzado Law Firm**

Mere delay in asserting trademark rights is not enough to support the defense of laches; there "must also have been some detriment due to the delay." *Bridgestone/Firestone*, 58

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1. Further undermining Jahn's purported "diligence" in "policing" the Jahn Mark is the fact that Jahn failed to oppose the Avanzado Mark during its 30-day publication in the USPTO's Trademark Official Gazette in June 2011. (Avanzado Decl. ¶¶ 11-13, Exhs. 5 & 6.)

U.S.P.Q. at 1463. Economic prejudice to the respondent may ensue when there has been an unreasonable period of delay by a petitioner. *Bridgestone/Firestone*, 58 U.S.P.Q. at 1464 (citing *A.C. Aukerman Co. v. R.L. Chaides Construction Co.*, 22 U.S.P.Q.2D (BNA) 1321, 1336 (Fed. Cir. 1992) (“reliance is not a requirement of laches but is essential to equitable estoppel”). In addition, economic prejudice “arises from investment in and development of the trademark, and the continued commercial use and economic promotion of a mark over a prolonged period adds weight to the evidence of prejudice.” *Bridgestone/Firestone*, 58 U.S.P.Q. at 1464 (citing *Hot Wax, Inc. v. Turtle Wax, Inc.*, 52 U.S.P.Q.2D (BNA) 1065, 1072 (7th Cir. 1999) (the longer the use and the lengthier the period of delay, the lighter the burden of showing economic prejudice in support of the defense of laches)).)

In *Teledyne*, TTAB held that the petitioner’s unreasonable delay of over three years caused economic prejudice to the respondent. *Teledyne*, Cancellation No. 92041265, at \* 25-28. TTAB found that the respondent had “invested in and promoted” its trademark “during the period during which petitioner was silent,” including using the mark in advertising. *Id.* at 26-27.

Avanzado has utilized the Avanzado Mark for over three years since the Avanzado Mark’s August 23, 2011 registration on the principal register. The Avanzado Mark has built goodwill from its consistent and continued use on Avanzado’s website. (Avanzado Decl. ¶¶ 1, 9-13; Exh. 2.) Since the Avanzado Mark’s registration, Avanzado has performed litigation services for various clients, attended multiple networking events each month with attorneys and businesspeople, and distributed his business bearing Avanzado’s website address. (Avanzado Decl. ¶¶ 1, 9.) Avanzado’s professional services and offerings of such services utilize the goodwill of the Avanzado Mark to generate business and have done so for over four years since

the Avanzado Mark was registered. During this lengthy period, Jahn remained silent and failed to initiate any cancellation proceedings. (Avanzado Decl. ¶¶ 12-14, Exh. 5.)

Avanzado's investment in and promotion of the Avanzado Mark establishes increased his economic position during the lengthy period of Jahn's undue delay. Accordingly, cancellation of the Avanzado Mark would deprive Avanzado of the goodwill established by four years of continuous, uninterrupted and unchallenged use of the Avanzado Mark.

### **3. Confusion Of The Marks Is Not Inevitable**

Jahn has not – because it cannot – demonstrate that confusion between the Avanzado Mark and the Jahn Mark is inevitable. When goods and services are not identical, confusion between contested marks is not inevitable. *Teledyne*, Cancellation No. 92041265, at \*29. Moreover, increased sophistication of consumers and an absence of actual confusion weigh against a finding that confusion is inevitable. *Id.*

Here, the marks are not identical. The Avanzado Mark (“Big Firm Experience . . . Small Firm Service”) conveys experience gained from working at a big firm, yet the provision of attorney services similar to that provided of a small firm. The Jahn Mark connotes a small firm that gained experience despite its small size. The substantive differences in the marks -- as well as the sophistication of customers seeking legal services (discussed further below) – suffice to avoid inevitable confusion.

In addition, the professional services offered by Avanzado differ from those offered by Jahn. Avanzado's website features five specific practice areas: entertainment and sports litigation; intellectual property litigation; media and First Amendment; complex civil litigation; and employment litigation. (Avanzado Decl. ¶ 1.) Avanzado's firm is based in Los Angeles, California and is admitted to practice in California. (Avanzado Decl. ¶¶ 1 & 7.) Jahn's website

shows that it specializes in intellectual property law and that it has experience in “general practice and civil litigation.” (Avanzado Decl. ¶ 21, Exh. 11.) Jahn’s website shows that it is admitted to practice in Colorado and Nevada – not California. (*Id.*) The fact that Avanzado’s services are broader and more specific than Jahn’s – and the fact that Avanzado’s provides his services in California while Jahn provides services in Colorado – weigh against inevitable confusion.

Jahn concedes that she has no evidence of actual confusion between the two marks. (Exh. 9 to Avanzado Decl. (Jahn’s Response to Interrogatory No. 22).) Avanzado has never received a phone call from an actual or potential client who confused Avanzado’s law firm with Jahn’s law firm, or confused Avanzado for Jahn’s principal. (Avanzado Decl. ¶ 8.) Third party law firms that use phrasing similar to the Avanzado Mark and the Jahn Mark have not been contacted by any client or potential clients mistaking the third party law firms for Avanzado or Jahn. (Talcott Decl. ¶¶ 1-3.)

For the foregoing reasons, as well as those discussed below, confusion is not inevitable and Avanzado’s laches defense applies to bar Jahn’s petition for cancellation. Jahn’s petition must be dismissed.

C. **THERE IS NO LIKELIHOOD OF SOURCE CONFUSION BETWEEN THE AVANZADO MARK AND THE JAHN MARK**

The Lanham Act governs trademarks and precludes the registration of a mark “which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive . . . .” 15 U.S.C. § 1052(d).

Trademarks “identify the source of the goods and services offered. A key objective of the law of trademarks is protection of the consumer against being misled or confused as to the source of the goods or services he acquires.” *Visa, U.S.A., Inc. v. Birmingham Trust National Bank*, 696 F.2d 1371, 1375 (Fed. Cir. 1982); *In re Tam*, 117 U.S.P.Q. 2D (BNA) 1001, 1016 (Fed. Cir. 2015) (“A mark’s purpose [is] to identify the source of goods” and services). A service mark is a type of trademark used in connection with services and is a designation used by a person to identify his services and distinguish them from the services of another. 15 U.S.C. § 1127.

A mark is “distinctive and capable of being protected if it *either* (1) is inherently distinctive *or* (2) has acquired distinctiveness through secondary meaning.” *In re MBNA America Bank, N.A.*, 67 U.S.P.Q.2D (BNA) 1778, 1780 (Fed. Cir. 2003) (citing *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768, 120 L. Ed. 2d 615, 112 S. Ct. 2753 (1992) (citing U.S.C. § 1052)). Marks are often classified, according to their increasing degree of inherent distinctiveness, as: (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful. *Two Pesos*, 505 U.S. at 768. Suggestive and arbitrary and fanciful marks are inherently distinctive whereas descriptive and generic marks are not. *Id.*

The “degree of similarity which is permissible between trademarks consisting of ordinary words, especially when such words are descriptive or geographical, is greater than that permissible between arbitrary or fanciful marks.” *Armour & Co. v. Organon, Inc.*, 114 U.S.P.Q. (BNA) 334, 336 (C.C.P.A. 1957). Descriptive words receive protection when they have developed “secondary meaning” when “in the minds of the public, the primary significance of a product [or service] feature . . . is to identify the source of the product [or service] rather than the product [or service] itself.” *Qualitex*, 514 U.S. at 163.

The test for likelihood of confusion considers 13 factors - referred to as the *Du Pont* factors - which “must be considered”:

(1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression; (2) the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use; (3) the similarity or dissimilarity of established, likely-to-continue trade channels; (4) the conditions under which and buyers to whom sales are made, *i.e.*, "impulse" vs. careful, sophisticated purchasing; (5) the fame of the prior mark (sales, advertising, length of use); (6) the number and nature of similar marks in use on similar goods; (7) the nature and extent of any actual confusion; (8) the length of time during and conditions under which there has been concurrent use without evidence of actual confusion; (9) the variety of goods on which a mark is or is not used (house mark, "family" mark, product mark); (10) the market interface between applicant and the owner of a prior mark; (11) the extent to which applicant has a right to exclude others from use of its mark on its goods; (12) the extent of potential confusion, *i.e.*, whether *de minimis* or substantial; and (13) any other established fact probative of the effect of use.

*Du Pont*, 177 U.S.P.Q. at 567. The *Du Pont* factors are not listed in the order of merit, and the dominance of each factor varies by case. *Id.*

In determining the likelihood of confusion, “marks must be considered in the way they are perceived by the relevant public.” *Opryland USA*, 23 U.S.P.Q. 2D at 1473-74. Thus, the marks must not be analyzed by separating them into their component words. *Id.* A trademark cancellation proceeding “must fail if it is not likely that confusion will result from the concurrent use of two marks” on goods or services of the same descriptive properties. *J.P. Heilbronn Co. v. Hammermill Paper Co.*, 18 C.C.P.A. 1307, 1310 (C.C.P.A. 1931).

Jahn does not have admissible evidence to demonstrate source confusion or to show that the *Du Pont* factors support her likelihood of confusion claim between the Avanzado Mark and the Jahn Mark. Thus the *Du Pont* factors weigh in favor of Avanzado's summary judgment.

1. **Jahn Fails to Establish Likelihood Of Source Confusion**

a. **Jahn Has No Evidence Of Confusion Since The Avanzado Mark Became Registered Over Four Years Ago**

Jahn has no evidence of actual confusion. The seventh and eighth *Du Pont* factor requires consideration of “the nature and extent of any actual confusion” as well as the “length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” *Du Pont*, 177 U.S.P.Q. at 567. The absence of any evidence of actual confusion does not warrant an inference that confusion is likely. *Lloyd's Food Products*, 25 U.S.P.Q. at 2030 (stating that the TTAB should not have inferred that confusion was likely from plaintiff's witness affidavit “wondering” whether the parties' products were “connected in some way”); *Nautilus Group, Inc. v. Icon Health & Fitness*, 71 U.S.P.Q.2D (BNA) 1173, 1179 (Fed. Cir. 2004) (As a general proposition, ‘a showing of actual confusion among significant numbers of consumers provides strong support for likelihood of confusion.’”) (citing *Playboy Enterprises, Inc. v. Netscape Communications Corp.*, 69 U.S.P.Q.2D (BNA) 1417, 1421 (9th Cir. 2004)).

Here, Jahn's discovery responses establish that “there is no evidence of actual confusion...” during the four years since the Avanzado Mark's registration on the principal register. (Avanzado Decl. ¶ 19, Exh. 9 (Jahn's Response to Interrogatory No. 22); Jahn Motion for Summary Judgment (“Jahn MSJ” at 12-13.). Moreover, Avanzado's evidence establishes that there is no genuine issue concerning actual confusion or a likelihood of confusion.

Avanzado has never been contacted by a client or potential client mistaking Avanzado for Jahn.

(Avanzado Decl. ¶ 8.) Third party law firms that use phrasing similar to the Avanzado Mark and

the Jahn Mark have not been contacted by any client or potential clients mistaking the third party law firms for Avanzado or Jahn. (Talcott Decl. ¶¶ 1-3.)

Avanzado’s evidence establishes that law firms throughout the country – such as in Florida (“A Small Law Firm With Big Experience”), Illinois (“Big Firm Experience Small Firm Attention”) and Missouri (“Big Firm Experience. Small Firm Accountability.”)– employ similar language to convey the concept of attorneys trained in big firms who practice in a small firm. (Avanzado Decl. ¶ 22; Exh. 12.)

Avanzado has never received a phone call from an actual or potential client who confused Avanzado’s law firm with Jahn’s law firm, or confused Avanzado for Jahn’s principal. (Avanzado Decl. ¶ 8.) Likewise, Kelly Talcott, an attorney practicing in New York State, utilizes the phrase New York “Big Firm Skills. Small Firm Service.” on his website since at least 2010. (Talcott Decl. ¶¶ 1-2.) Talcott has never been contacted by any client or potential client who confused Talcott’s firm for The Avanzado Law Firm or Jahn & Associates. (Talcott Decl. ¶ 3.)

The lack of evidence of actual confusion due to the purported similarity between the Avanzado Mark and the Jahn Mark weighs against the likelihood of confusion.

**b. The Jahn Mark Is Weak Because Numerous Law Firms Across The United States Use Variations Of The Jahn Mark**

The sixth *Du Pont* factor requires consideration of “the number and nature of similar marks in use on similar goods” and services and is a “relevant” factor in the likelihood of confusion examination. *Du Pont*, 177 U.S.P.Q. at 567; *Lloyds Food Products*, 25 U.S.P.Q. at 2029. A service mark “entails use in conjunction with the offering and providing of a service” and “makes all the more important the use of the [mark] in ‘sales’ or ‘advertising’ materials of different descriptions.” *Lloyds Food Products*, 25 U.S.P.Q. at 2029. A showing that the service

mark at issue appears in listings and advertising “carries the presumption that the service mark is being used by third parties in connection with the offering of the advertised services” and “raise[s] a potentially dispositive issue of fact about the extent and character of the third-party use of the mark . . . to preclude summary judgment on the likelihood of confusion.” *Lloyds Food Products*, 25 U.S.P.Q. at 2029.

The four words that make up the Jahn Mark – “Small,” “Firm,” “Big” and “Experience” – are used by third-party law firms and other professional firms across the country and demonstrate that the Jahn Mark is not exclusive to Jahn; nor is her mark “distinctive.” (*See Avanzado Decl.* ¶ 22, Exh. 12.) Even Jahn’s sealed evidence in support of the Jahn MSJ demonstrates that at least nine other law and non-law firms– one of which was a title insurance company –used some combination of the words “small,” “big,” “firm” and “experience” to advertise their services. (*See Exhibit F to Jahn MSJ.*)

The fact that over 25 law firms across the nation employ various of the Jahn Mark and the Avanzado Mark establish that the Jahn Mark is weak. Thus, this *Du Pont* factor weighs against the likelihood of confusion and in favor of summary judgment.

**c. Consumers Of Legal Or Litigation Services Are Sophisticated And Not Likely To Confuse The Avanzado Law Firm With Jahn’s Practice**

The fourth *Du Pont* factor requires consideration of the “conditions under which and buyers to whom sales are made, *i.e.* ‘impulse’ versus careful, sophisticated purchasing.” *Du Pont*, 177 U.S.P.Q. at 567. When goods are sold to consumers that exercise care there is less chance that confusion will occur. *PC Club v. Primex Technologies, Inc.*, 32 Fed. Appx. 576, 579 2002 U.S. App. LEXIS 4982 (Fed. Cir. 2002). Confusion is “less likely” where goods and services are “expensive and are purchased after careful consideration than where they are

inexpensive and are purchased casually.” *Magnaflux Corp. v. Sonoflux Corp.*, 109 U.S.P.Q. (BNA) 313, 315 (C.C.P.A. 1956).

The provision of legal services is an expensive, protracted foray. Clients and potential clients exercise a high degree of careful consideration as to who they want to represent them, the attorney’s skill, experience and cost. *See In re Massey-Ferguson, Inc.*, 222 U.S.P.Q. (BNA) 367, 368 (Trademark Trial & App. Bd. 1983 ) (“We are not concerned with mere theoretical possibilities of confusion, deception or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.”); *Ransom v. Ransom*, 147 A.D. 835, 848 (N.Y. App. Div. 1911) (“The selection of an attorney is a matter of personal choice . . . .”)

Jahn has no admissible evidence of actual confusion. (Exh. 9 to Avanzado Decl. (Jahn’s Response to Interrogatory No. 22).) Avanzado has never received a phone call from an actual or potential client who confused Avanzado’s law firm with Jahn’s law firm, or confused Avanzado for Jahn’s principal. (Avanzado Decl. ¶ 8.) Talcott has never been contacted by any client or potential client who confused Talcott’s firm for The Avanzado Law Firm or Jahn & Associates. (Talcott Decl. ¶¶ 1-3; Avanzado Decl. ¶ 20 & Exh. 9.) That three different law firms who market their legal services on the internet using similar taglines have not been contacted by anyone confusing one for the other demonstrates how unfounded Jahn’s speculative contentions are.

Jahn has no evidence that a prospective consumer of legal services will confuse the source – *i.e.* the law firm or practitioner – because of the purported similarity of the two service marks. Nor does Jahn have any evidence that the service mark factors into the consumer’s decision of which law firm to hire. Thus, this factor weighs against likelihood of confusion.

**d. The Avanzado Mark And The Jahn Marks Are Not Similar And Not Likely To Confuse The Public**

Jahn has no evidence that the Avanzado Mark and the Jahn Mark are similar and are likely to confuse the public. When analyzing this *Du Pont* factor, the marks “must be considered in the way they are perceived by the relevant public and not broken down into their component words.” *Opryland USA*, 23 U.S.P.Q. 2D at 1473-74. The “proper” test is “not a side-by-side comparison of the marks” but instead whether the marks are “sufficiently similar in terms of their commercial impression” such that persons who encounter the marks would be likely to assume a connection between the parties. *Coach Services v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 U.S.P.Q. 2D (BNA) (Ct. App. Fed. Cir. 2012). Where the marks are “identical” or “nearly identical,” TTAB has found that “differences in connotation can outweigh visual and phonetic similarity.” *Coach*, 668 F.3d at 1368 (citing *Blue Man Products Inc. v. Tarmann*, 75 U.S.P.Q. 2d 1811, 1820-21 (T.T.A.B. 2005)). In comparing the marks, “the focus of concern is not on similarity per se, but rather whether a similarity exists which is like to cause confusion” as to the source of the product or service. *Sears, Roebuck & Co. v. Sears Financial Network, Inc.*, 221 U.S.P.Q. (BNA) 581, 585 (D.D.C. 1983).

Here, the dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression weighs against the likelihood of confusion. Although the Avanzado Mark and the Jahn Mark have four words in common – “big,” “firm,” “small” and “experience” – the marks are not similar and convey difference meanings to the public. First, the order of the words is different. The Avanzado Mark states “Big Firm Experience...Small Firm Service,” whereas the Jahn Mark reverses the order with “Small Firm, Big Experience.” Second, the Avanzado mark contains ellipses whereas the Jahn Mark does not.

Finally, the marks convey different meanings. The Avanzado Mark conveys the straightforward message that the attorneys in The Avanzado Law Firm have experience from working at a big firm and are now providing that experience with the personalized attention associated with a small firm. This concept of going from a big firm and bringing big firm experience to a small firm is not foreign, not novel and not protectable.

The meaning of the Jahn Mark is ambiguous. Jahn's website does not indicate whether Jahn has any big law firm experience. (Avanzado Decl. ¶ 21, Exh. 11.) Thus, "Small Firm, Big Experience" could be interpreted by the consuming public to mean Jahn operates a small firm but has handled a enough cases to give it "big experience." The relevant public could also interpret the Jahn Mark to mean that Jahn has worked in a big law firm prior to opening her small law firm notwithstanding the lack of any indication that Jahn has worked in a big law firm.

Despite the four words in common, the two marks are not so similar as to cause a likelihood of confusion. Thus, this factor mandates against likelihood of confusion.

**e. Avanzado And Jahn Provide Different Services Such That Consumers Cannot Confuse The Two Law Firms**

Though the Avanzado Law Firm and Jahn provide legal services, there is no likelihood of confusion on this basis. The second *Du Pont* factor considers the "similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use." *Du Pont*, 177 U.S.P.Q. at 567; see *In re St. Helena Hospital*, 774 F.3d 747, 752, 113 U.S.P.Q. 2D (BNA) (Fed. Cir. 2014) (this factor considers whether "the consuming public may perceive [the respective goods and services of the parties] as related enough to cause confusion about the source or origin of the goods and services.").

Here, Avanzado provides discrete legal services that differ from those Jahn purportedly provides. The Avanzado Law Firm focuses exclusively on litigation with an emphasis on

entertainment and sports litigation, intellectual property litigation, media and First Amendment litigation, complex civil litigation and employment litigation. (Avanzado Decl. ¶¶ 1, 10 & Exh. 2.) These five discrete practice areas are prominent on Avanzado’s website. (Avanzado Decl. ¶ 1.) The principal of The Avanzado Law Firm is male. (Avanzado Decl. ¶ 1 & Exh. 2.) Of import is the fact that The Avanzado Law Firm is based in California and its attorneys are admitted to practice in California. (Avanzado Decl. ¶¶ 1, 7 & Exh. 2.)

In contrast, Jahn’s website claims specialization in “intellectual property law” and experience in “general practice and civil litigation. ” (Avanzado Decl. ¶ 21 & Exh. 11.) Jahn’s legal practitioners are admitted to practice in Colorado and Nevada – not in California. (*Id.*) The principal of Jahn & Associates is female. (*Id.*) Jahn’s website fails to mention any big firm experience. (*Id.*) The extent of Jahn’s entertainment experience is limited to “negotiating” and “preparing” specific agreements such as endorsement, licensing, merchandising, “film studio,” publishing, radio, music, artist and model. (*Id.*) Jahn produced no admissible evidence of experience in entertainment litigation. (*Id.*)

Jahn has no admissible evidence to support her claim that the provision of legal services are so similar that the relevant public would confuse one firm based in California with a male principal and specializing only in litigation for another firm based in Colorado and Nevada with a female principal that does both litigation and transactional work. Jahn cannot produce any admissible evidence that any client or potential client contacted Avanzado mistaking it for Jahn. Likewise, Jahn has no evidence that actual or potential clients mistook Avanzado for Jahn (or vice versa) based on the purported “similarity” of the marks. (Exh. 9 to Avanzado Decl. (Jahn’s Interrogatory Response No. 22).) Avanzado has never worked for or with Jahn, and Jahn has never worked for or with Avanzado. (Avanzado Decl. ¶¶ 1-8 & 21, Exhs. 2 & 8.) Thus, there is

no evidence to show that the consuming public would confuse Avanzado's firm and services with Jahn's or believe them to be related.

This *Du Pont* factor weighs against likelihood of confusion.

**f. The Avanzado Mark And The Jahn Mark Market In Different And Distinct Trade Channels**

Although The Avanzado Law Firm and Jahn both use the internet to market their law firms, the trade channels in which the respective marks appear are distinct and do not cause a likelihood of confusion. Thus, the third *Du Pont* factor analyzing the “similarity or dissimilarity of established, likely-to-continue trade channels” weighs in favor of Avanzado. *Du Pont*, 177 U.S.P.Q. at 567. Advertising on the internet is “ubiquitous” and “proves little, if anything, about the likelihood that consumers will confuse similar marks used on such goods or services.” *In re St. Helena Hospital*, 774 F.3d 747, 754, (Fed. Cir. Ct. App. 2014) (citing *Kinbook, LLC v. Microsoft Corp.*, 866 F. Supp. 2d 453, 470-71 n. 14 (E.D. Pa. 2012); *see also Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1151 (9th Cir. 2002) (“Some use of the Internet for marketing, however, does not alone and as a matter of law constitute overlapping marketing channels.”))

Avanzado and The Avanzado Law Firm are based in Los Angeles, California and are licensed to practice only in California. (Avanzado Decl. ¶¶ 1,7, Exh. 2.) Nobody in The Avanzado Law Firm is licensed to practice in any non-California state. (Avanzado Decl. ¶¶ 1,7.) Moreover, The Avanzado Law Firm specializes in litigation and seeks potential clients who need litigation services. (*Id.* ¶ 1 & Exh. 2.) Thus, The Avanzado Law Firm targets clients and potential clients who seek representation in California courts. (*Id.*)

In contrast, Jahn has offices in Colorado and Nevada and licensed to practice in those two states. (Avanzado Decl. ¶¶ 16, 21 & Exhs. 6 & 11.) Jahn is not licensed to practice in

California. (*Id.*)<sup>2/</sup> Jahn has no admissible evidence that its relevant market comprises of clients and potential clients who also seek representation in California courts. Jahn has no evidence of actual confusion. (Exh. 9 to Avanzado Decl. (Jahn’s Response to Interrogatory No. 22).)

Numerous law firms throughout the country that use a variation of the Avanzado and Jahn Marks advertise their services on the internet. (Avanzado Decl. ¶ 22 & Exh. 12.) However, Avanzado has never received any phone call from a client or potential client who confused The Avanzado Law Firm with Jahn or any other firm. (Avanzado Decl. ¶ 8.) Talcott, an attorney practicing in New York State who utilizes the phrase “Big Firm Skills. Small Firm Service.” on his website for at least five years, has never been contacted by any client or potential client who confused Talcott’s firm for The Avanzado Law Firm or Jahn & Associates. (Talcott Decl. ¶¶ 1-3; Avanzado Decl. ¶ 8.) That three different law firms using similar taglines and marketing their legal services on the internet have not been contacted by anyone confusing one for the other demonstrates how unfounded Jahn’s claim of “likelihood of confusion” is. Thus, this factor weighs against likelihood of confusion and in favor of summary judgment.

**g. The Jahn Mark Is Not Famous And Does Not Enjoy Wide Protection**

The fifth *Du Pont* factor examines the fame of the petitioner’s mark. *Du Pont*, 177 U.S.P.Q. at 567. Famous or strong marks enjoy a “wide latitude of legal protection.” *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 352, 22 U.S.P.Q. 2D (BNA) 1453 (Fed. Cir. Ct. App. 1992). A famous mark is one where consumers have been “so exposed to the

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2. Jahn misrepresents the evidence when she claims that she has represented clients in California – the evidence shows that Jahn was permitted to practice in the three California cases listed in her discovery responses because she was admitted pro hac vice. (Avanzado Decl. ¶ 18 & Exh. 8.) Jahn’s pro hac vice admittance underscores the fact that she is not licensed in California and that representation of clients in California courts is not her primary or target market.

mark” or “so aware of it” that it has achieved “extensive public recognition and renown” and “deserves” more legal protection than a weak mark. *Kenner*, 963 F.2d at 353; *Blue Man Productions, Inc. v. Tarmann*, 75 U.S.P.Q. 2D (BNA) 1811, 1819 (T.T.A.B. 2005). However, fame in and of itself is not sufficient to establish likelihood of confusion. *Id.* at 1819-20. A party that chooses an “inherently weak” trademark will not have a wide latitude of protection and its competitors “may come closer to his mark than would be the case with a strong mark without violating his rights.” *Id.* at 353.

The Jahn Mark is weak. As trademark authorities have established, only suggestive and fanciful and arbitrary marks are inherently distinctive. *Two Pesos*, 505 U.S. at 768. The Jahn Mark is a descriptive service mark that receives less protection than arbitrary or suggestive marks. *Armour*, 114 U.S.P.Q. at 336. As explained in Section II.C.1.d, the Jahn Mark describes the size of Jahn’s law firm (“Small Firm”) and Jahn’s purported experience (“Big Experience”).<sup>3</sup> operates a small firm but has handled a enough cases to give it “big experience.” The relevant public could also interpret the Jahn Mark to mean that Jahn has worked in a big law firm prior to opening her small law firm notwithstanding the lack of any indication that Jahn has worked in a big law firm.

Jahn claims that she has a “strong” mark because it is “distinctive,” has “goodwill” and because she “police[s]” her mark but has no admissible evidence to support this contention. (Jahn MSJ at 12.) To the contrary, Avanzado submits evidence of over 25 law firms of varying sizes and practice areas throughout the country that use a combination of the words “Big,”

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3. As stated earlier, the meaning of the Jahn Mark is ambiguous and could also be interpreted to mean that Jahn worked in a big law firm prior to operating her small law firm. However, unlike Avanzado’s firm website, Jahn’s firm website lacks any indication that Jahn has experience working in a big law firm. (*Compare* Avanzado Exh. 2 *with* Avanzado Exh. 11.)

“Firm,” “Experience,” and “Small” to convey the meaning that the law firm has at least one attorney with experience at a big law firm who now practices in a small law firm which can provide better “service” to a client. (Avanzado Decl. ¶ 22 & Exh. 12; Talcott Decl. ¶¶ 1-3.)

Jahn has no admissible evidence that the Jahn Mark has achieved a secondary meaning – *i.e.*, that the representative public identifies the Jahn Mark with Jahn. Moreover, the wide usage of the phrase “Small Firm, Big Experience” and its variants establish that the Jahn Mark is weak and therefore any association between the Jahn Mark and Jahn is tenuous at best. Thus, the Jahn Mark has little to no trademark protection. Thus, this factor weighs against likelihood of confusion.

**h. The Remaining *Du Pont* Factors Are Not Probative**

The ninth through twelfth *Du Pont* factors are not probative of the facts here and thus are not discussed.

**III.**

**CONCLUSION**

For the foregoing reasons, Respondent Melvin N.A. Avanzado respectfully requests that the Trademark Trial and Appeal Board grant Mr. Avanzado’s motion for summary judgment.

DATED: April 22, 2016

THE AVANZADO LAW FIRM

By: \_\_\_\_\_

  
Elaine W. Yu

Attorney for Respondent  
Melvin N.A. Avanzado

**PROOF OF SERVICE**

I am employed in the County of Los Angeles, State of California. I am over the age of 18 years and am not a party to the within action. My business address is 1880 Century Park East, Suite 1100, Los Angeles, California 90067. On the date set forth below, I caused the foregoing document(s) described as

RESPONDENT AND DEFENDANT MELVIN N.A. AVANZADO'S MOTION  
FOR SUMMARY JUDGMENT

to be served on the interested parties in this action as follows by placing

the original  a true copy thereof enclosed in sealed envelopes addressed as stated below:

Kirstin M. Jahn  
Jahn & Associates, LLC  
1942 Broadway, Suite 314  
Boulder, Colorado 80304  
<kirstin@jahnlaw.com>

- BY MAIL:** I sealed and placed such envelope for collection and mailing to be deposited in the mail on the same day in the ordinary course of business at Los Angeles, California. The envelope was mailed with postage thereon fully prepaid. I am readily familiar with this firm's practice of collecting and processing correspondence for mailing. It is deposited with the U.S. Postal Service on that same day in the ordinary course of business.
- BY OVERNIGHT COURIER:** I caused such envelope to be placed for collection and delivery on this date in accordance with standard \_\_\_\_\_ delivery procedures.
- BY FAX:** In addition to service by mail, I transmitted a copy of the foregoing document(s) this date via telecopier to the facsimile numbers shown above.
- BY ELECTRONIC MAIL:** I personally delivered such envelope by electronic mail to the addressee(s) shown above.
- BY PERSONAL SERVICE:** I personally delivered such envelope by hand to the addressee(s) shown above.
- [State] I declare under penalty of perjury under the laws of the State of California that the above is true and correct.
- [Federal] I declare that I am employed in the office of a member of the Bar of this Court at whose direction the service was made. I declare under penalty of perjury that the foregoing is true and correct.

Executed on April 22, 2016 at Los Angeles, California.

  
\_\_\_\_\_  
Elaine W. Yu

