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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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Date	04/22/2016
Attachments	Statement of Undisputed Facts (FINAL).pdf(219129 bytes)

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

*[Avanzado Motion for Summary Judgment,
Request for Judicial Notice, Declaration of
Melvin N.A. Avanzado, and Declaration of
Kelly D. Talcott filed concurrently herewith]*

RESPONDENT AVANZADO’S STATEMENT OF UNDISPUTED FACTS IN SUPPORT
OF RESPONDENT AVANZADO’S MOTION FOR SUMMARY JUDGMENT

Pursuant to Federal Rule 56, Respondent and Defendant Melvin N.A. Avanzado (“Avanzado”) moves for summary judgment and submits this “Statement of Undisputed Facts” in support of his motion for summary judgment against Claimant Kirstin Jahn and Jahn & Associates, LLC’s petition for cancellation as set forth below.

Avanzado’s Undisputed Fact	Avanzado’s Evidence
1. Avanzado founded The Avanzado Law Firm in or about July 2008.	1. Avanzado Declaration ¶ 1.
2. Avanzado is licensed to practice law in	2. Avanzado Declaration ¶ 1.

Avanzado's Undisputed Fact	Avanzado's Evidence
California.	
3. Avanzado is not licensed to practice law in any other state besides California.	3. Avanzado Declaration ¶ 1.
4. Avanzado's associate is licensed to practice law in California.	4. Avanzado Declaration ¶ 7.
5. Avanzado's associate is not licensed to practice law in any other state besides California.	5. Avanzado Declaration ¶ 7.
6. Prior to founding The Avanzado Law Firm, Avanzado practiced law at several "big" firms.	6. Avanzado Declaration ¶¶ 1-6.
7. In or about June 2009, Avanzado came up with the tag line for The Avanzado Law Firm, "Big Experience, Small Firm Service."	7. Avanzado Declaration ¶ 9.
8. Since coming up with the tag line for The Avanzado Law Firm, "Big Experience, Small Firm Service" in or about June 2009, Avanzado has used this slogan on his business cards and on the website for The Avanzado Law	8. Avanzado Declaration ¶ 9.

Avanzado's Undisputed Fact	Avanzado's Evidence
Firm.	
<p>9. Avanzado filed for trademark registration of his mark, "Big Firm Experience . . . Small Firm Service" (the "Avanzado Mark") with the United States Patent and Trademark Office on February 1, 2011.</p>	<p>9. Avanzado Declaration ¶ 10, Exhibit 2.</p>
<p>10. Jahn failed to oppose the United States Patent and Trademark Office's publication of "BIG FIRM EXPERIENCE . . . SMALL FIRM SERVICE" (the "Avanzado Mark") when the United States Patent and Trademark Office published the Avanzado Mark in the <i>Trademark Official Gazette</i> on June 7, 2011.</p>	<p>10. Avanzado Declaration ¶¶ 11-14, Exhs. 3 & 4.</p>
<p>11. On August 23, 2011, Avanzado obtained a registration for the Avanzado Mark for use in connection with litigation services in International Class 45 under Registration Number 4015965.</p>	<p>11. Avanzado Decl. ¶ 12, Exh. 4.</p>

Avanzado's Undisputed Fact	Avanzado's Evidence
12. Jahn failed to challenge the registration of the Avanzado Mark for over three years.	12. Avanzado Declaration ¶¶ 11-14, Exhs. 4-5.
13. Since the inception of The Avanzado Law Firm, Avanzado attended and continues to attend networking functions on a monthly basis which involve interacting with attorneys, business people and other professionals.	13. Avanzado Declaration ¶¶ 1, 9
14. At such networking functions, Avanzado hands out his business card which contains the website of The Avanzado Law Firm.	14. Avanzado Declaration ¶¶ 1, 9
15. Over 25 law firms located across the United States currently use a variation of the Avanzado Mark of the "SMALL FIRM, BIG EXPERIENCE" phrase on their websites.	15. Avanzado Declaration ¶ 22 & Exhibit 12; Talcott Declaration ¶¶ 1-3.
16. Jahn is only licensed to practice law in New York, Colorado and Nevada states.	16. Avanzado Decl. ¶¶ 16-21 & Exhibits 6-11.

Avanzado's Undisputed Fact	Avanzado's Evidence
17. Jahn appears in other states on a pro hac vice basis.	17. Avanzado Decl. ¶¶ 16-21 & Exhibits 6-11.
18. Jahn has no evidence of actual confusion.	18. Jahn Summary Judgment Motion at 12-13; Avanzado Declaration ¶ 18 & Exhibit 8.
19. Avanzado has never had an actual or potential client mistake him or his firm for Jahn or her firm.	19. Avanzado Declaration ¶ 8.
20. Jahn's website fails to mention whether Jahn practiced in a "big" law firm.	20. Avanzado Declaration ¶ 21, Exhibit 11.
21. The law firm of Kelly Talcott based in New York employs the tagline "Big Firm Skills. Small Firm Service." on his website since at least 2010.	21. Talcott Declaration ¶¶ 1-3; Avanzado Declaration ¶ 21 & Exhibit 11.
22. Talcott has never been contact by any client or potential client who confused Talcott's firm for The Avanzado law Firm or Jahn & Associates.	22. Talcott Declaration ¶¶ 1-3; Avanzado Declaration ¶ 21 & Exhibit 11.

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

STATEMENT OF UNDISPUTED FACTS IN SUPPORT OF 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