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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	Brief on Merits for Plaintiff
Filer's Name	Kirstin M. Jahn
Filer's e-mail	Kirstin@jahnlaw.com
Signature	/kmj/
Date	09/12/2016
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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

CANCELLATION NO. 92060029

v.
Melvin N.A. Avanzado
Respondent.

PETITIONER'S TRIAL BRIEF

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EVIDENCE RELIED UPON

Petitioner's Trial Brief is based on the supporting memorandum of points and authorities; the evidence of record as set forth in TTAB Docs 19-22, including Petitioner's List of Witnesses, Petitioner's Notice of Reliance (Exhibits 1-6), Petitioner's Notice of Reliance filed under seal (Exhibits 8-9) and evidence provided therewith including the Declaration of Kirstin M. Jahn and such other evidence or argument as may be presented in connection with this matter.

SUMMARY OF ARGUMENT

Petitioner has used its SMALL FIRM, BIG EXPERIENCE Mark at least as early as October 2001 in connection with legal services. Petitioner applied for and received a federal trademark registration for its SMALL FIRM, BIG EXPERIENCE mark under U.S. Registration Number 3642830. Since that time, Petitioner has invested valuable time and resources to develop goodwill associated with its Mark and to protect the distinctiveness and strength of its mark.

Well over *ten years later*¹, Respondent began using its similar BIG FIRM EXPERIENCE ...SMALL FIRM SERVICE Mark for litigation services.

Petitioner will show it is entitled to judgment as a matter of law because Petitioner is the senior user of the mark and the salient factors establishing likelihood of confusion exist, namely, the two marks are similar in sight, sound and meaning, they encompass the same services and market in the same trade channels.

¹ Respondent admits it did not use its mark on or before March 8, 2008 the date sworn to in support of its registration in its declaration of use. *SMF at ¶12*. Moreover, Respondent failed to provide any evidence of use of its mark prior to 2011, the year its trademark application was filed and date of the specimen provided in support of its registration. *SMF at ¶¶ 7 and 13*.

STATEMENT OF FACTS

1. On or before October, 2001, Petitioner began using its SMALL FIRM, BIG EXPERIENCE trademark in connection with legal services. *See, Petitioner's Notice of Reliance ("P's NOR"), Exhibit 1.*
2. On November 13, 2008, Petitioner applied for federal registration of its SMALL FIRM, BIG EXPERIENCE MARK under Serial No. 77/613824. *Id.*
3. On June 23, 2009, Petitioner's mark, SMALL FIRM, BIG EXPERIENCE registered under Registration Number 3642830 for use in connection with legal services in International Class 45. *Id.*
4. Since its registration, Petitioner has made a diligent effort to police its mark to stop third party use of confusingly similar marks. *P's NOR, Exhibit 8 at ¶3 and Exhibit 9.*
5. Petitioner has been successful in obtaining third party agreements to cease using the same or similar marks. *P's NOR, Exhibit 9 at JA 39-40; JA41-41; JA 43-44; 45-47 and JA48-49-51*
6. Petitioner's policing of its mark is an ongoing process. *P's NOR, Exhibit 8 at ¶5, Exhibit 9 at JA 55 and MNAA-TM000020.*
7. On August 23, 2011, Respondent filed for a trademark registration with the USPTO for the mark, BIG FIRM EXPERIENCE... SMALL FIRM SERVICE which was assigned Serial No. 85/231879. *P's NOR, Exhibit 2.*
8. On August 23, 2011, Respondent obtained a registration for its mark BIG FIRM EXPERIENCE... SMALL FIRM SERVICE trademark for use in connection with litigation services in International Class 45 under Registration Number 4015965. *Id.*

9. When the search term “SMALL FIRM BIG EXPERIENCE” is entered in the USPTO TESS database, both Respondent’s and Petitioner’s marks show up in the results with Respondent’s mark showing up first. *P’s NOR, Exhibit 3.*

10. Similarly, the results for the search of the term “BIG FIRM EXPERIENCE, SMALL FIRM” in the USPTO TESS database shows both Respondent’s and Petitioner’s mark, again with Respondent’s mark showing up first. *P’s NOR, Exhibit 4.*

11. Because intellectual property litigation services occur primarily in the United States District Courts, Petitioner provides legal services throughout the United States. Petitioner’s attorneys have represented clients in the federal courts located in California, Illinois, New York, Minnesota, Virginia, Nevada and Colorado. *P’s NOR, Exhibit 8 at ¶5[sic] should be ¶6.*

12. Respondent admits it did not use its mark on the date specified in its declaration which resulted in its registration. *P’s NOR, Exhibit 5 compared to Exhibit 2.*

13. Throughout discovery, Respondent never provided any documents evidencing the date of first use of its mark. *P’S NOR. Exhibit 6.*

POINTS AND AUTHORITIES

Legal Standard

The Lanham Act allows for cancellation of a Principal Register registration by anyone “who believes that he is or will be damaged ... by the registration.” 15 U.S.C.A. § 1064; *Golden Gate Salami Co. v. Gulf States Paper Corp.*, 332 F.2d 184, 188, 141 USPQ 661, 664 (CCPA 1964). The party seeking cancellation must prove two elements: (1) that it has standing; and (2) that there are valid grounds for canceling the registration. *Int’l Order of Job’s Daughters v. Lindeburg & Co.*, 727 F.2d 1087, 1091,

220 USPQ 1017, 1019 (Fed. Cir. 1984); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945 (Fed. Cir. 2000).

Standing is the more liberal of the two elements and requires only that the party seeking cancellation believe that it is likely to be damaged by the registration. *Golden Gate*, 332 F.2d at 188, 141 USPQ at 664. A belief in likely damage can be shown by establishing a direct commercial interest. *International Order*, 727 F.2d at 1092, 220 USPQ at 1020; *Cunningham*, 222 F.3d at 945.

There is no question Petitioner is the senior user of the marks at issue in this case. See, *Statement of Material Facts* (“SMF”) ¶¶1-3,7-8. Petitioner owns a prior registration for its mark SMALL FIRM, BIG EXPERIENCE for use in connection with legal services which registered on June 23, 2009 for use which began in 2001. SMF¶¶1 and 3. Petitioner’s registration and the services sold under its registered mark suffice to establish its direct commercial interest and standing to petition for cancellation of Respondent’s subsequent registration BIG FIRM EXPERIENCE...SMALL FIRM SERVICE mark for use in connection with litigation services, which registered in 2011, despite Respondent’s admission that its date of first use of March 2009 is incorrect and lack of evidence supporting any use prior to 2011. SMF ¶¶7-8 and ¶¶12-13.

Establishing the second element, a valid ground for cancellation, is simplified if the accused registered mark has been on the Principal Register for less than five years. *Int’l Order*, 727 F.2d at 1091, 220 USPQ at 1020; *Cunningham*, 222 F.3d at 946. In the present case, Respondent’s mark BIG FIRM EXPERIENCE...SMALL FIRM SERVICE has a Principal Register registration date of August 23, 2011 and, therefore, has been on the Principal Register for less than five years. SMF ¶8. As such, any

ground that would have prevented registration in the first place, such as likelihood of confusion, qualifies as a valid ground for cancellation in this case. *Cunningham*, 222 F.3d at 945-46.

Petitioner has the burden of proving by a preponderance of the evidence that there is a likelihood of confusion between the two marks. *Id.* at 951. “[T]he 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.” See, *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 should be resolved in favor of the senior user/registrant. TMEP §1207.01(d)(i); see *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).

**RESPONDENT’S MARK
“BIG FIRM EXPERIENCE... SMALL FIRM SERVICE”
IS CONFUSINGLY SIMILAR TO
PETITIONER’S “SMALL FIRM, BIG EXPERIENCE” MARK**

Approximately thirteen factors may be used to determine whether likelihood of confusion between two marks exists: 1) The similarity or dissimilarity of the marks in their entireties and 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 (i.e., agreements between the Applicant and 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 any other established fact probative of the effect of use. *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973).

“Not all of the *DuPont* factors may be relevant or of equal weight in any one case, and any one of the factors may control a particular case.” *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. Du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567. The court “may focus its analysis on dispositive factors, such as similarity of the marks and relatedness of the goods.” *In re Dixie Rests, Inc.*, 105 F.3d 1405, 1406-07 (Fed. Cir.1997). Moreover, “a finding of similarity as to any one factor (sight, sound **or** meaning) alone ‘may be sufficient to support a holding that the marks are confusingly similar’ (*emphasis added*). *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988) *citing*, *Trak, Inc. v. Traq Inc.*, 212 USPQ 846, 850 (TTAB 1981); *General Foods Corp. v. Wisconsin Bottling, Inc.*, 190 USPQ 43, 45 (TTAB 1976); *In re Mack*, 197 USPQ 755, 757 (TTAB 1977); *Krim-Ko Corp. v. Coca-Cola Co.*, 390 F.2d 728, 732, 156 USPQ 523, 526 (CCPA 1968).

Although the weight given to the relevant *du Pont* factors may vary, the following two factors are key considerations in any likelihood of confusion determination:

The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

The relatedness of the goods or services as described in the application and registration(s).

See, e.g., Federated Foods, Inc. v. Ft. Howard Paper Co., 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1244 (TTAB 2010); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009).

TMEP §1207.01.

In this case, Petitioner will demonstrate that likelihood of confusion between Petitioner's mark and Respondent's mark exists as a matter of law because no issue of material fact exists and the salient factors - similarity of marks, similarity of services and similarity of trade channels are met.

A. The Marks Are Virtually Identical In Sight, Sound and Meaning.

Marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in the marks being compared. *Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and COLLEGIENNE); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON and MILLTRONICS); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL and LUTEX).

When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods and/or services offered

under the two marks is likely to result. *Edom Labs., Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); TMEP §1207.01(b).

Respondent's BIG FIRM EXPERIENCE...SMALL FIRM SERVICE mark is essentially identical in sight, sound and meaning to Petitioner's prior registered, SMALL FIRM, BIG EXPERIENCE mark. Respondent's mark contains only one additional word - the word "SERVICE", which is descriptive of Respondent's identification of "litigation services." The Federal Circuit has noted that the "descriptive component of a mark may be given little weight in reaching a conclusion on likelihood of confusion." *Cunningham*, 222 F.3d at 947 citing, *In re National Data*, 753 F.2d at 1056, 1060, 224 USPQ 749, 752 (Fed. Cir. 1985).

As such, when Petitioner's Mark is compared to Respondent's mark (without the descriptive element "SERVICE" in Respondent's mark), the two marks, SMALL FIRM, BIG EXPERIENCE and BIG FIRM EXPERIENCE ... SMALL FIRM are virtually identical in sight and sound. In fact, when a search on the USPTO TESS database for SMALL FIRM, BIG EXPERIENCE is conducted, the result not only brings up both marks, but lists Respondent's Mark first. *SMF* ¶9. Similarly, a search in the USPTO database for BIG FIRM EXPERIENCE...SMALL FIRM (leaving out the descriptive "SERVICE") brings up both marks in the result, again listing Respondent's Mark first. *SMF* ¶10. As such, the marks are confusingly similar because they are virtually the same in sight and sound.

Moreover, the marks convey the same commercial connotation and impression, which is that each firm provides the knowledge and/or expertise of a big firm for the

lower prices, individualized attention and personalized service a small legal office provides.

Overall, BIG FIRM EXPERIENCE...SMALL FIRM SERVICE is similar in sight, sound and meaning to SMALL FIRM, BIG EXPERIENCE because the words in the marks are the same and they both convey the same meaning rendering the marks confusingly similar.

B. The Services Are the Exact Same.

The goods or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975). Rather, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

In this case, the services are exactly the same. *See, SMF ¶¶3 and 8.* Petitioner uses its mark in connection with "legal services" and Respondent uses its mark in connection with "litigation services". *Id.* Since litigation services are encompassed in legal services, the marks are used for the same services. This is the second element of three salient factors which is met establishing likelihood of confusion because the marks are both used in connection with the exact same services.

C. The Trade Channels Are The Same.

Absent restrictions in an application and/or registration, the identified goods and/or services are presumed to travel in the same channels of trade to the same class of purchasers. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d at 1268, 62 USPQ2d at 1005. Unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described. See, *In re Jump Designs*, 80 USPQ2d 1370, 1374 (TTAB 2006); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, the identification of services set forth in the both registrations have no restrictions as to nature, type, channels of trade, or classes of purchasers. The Petitioner's identification of services, "legal services" encompasses Respondent's "litigation services." Therefore, it is presumed that these services travel in all normal channels of trade, and are available to the same class of purchasers. *Citigroup Inc.*, 637 F.3d at 1356, 98 USPQ2d at 1261.

Moreover, Petitioner provides legal services throughout the United States because intellectual property litigation occurs in the United States District Courts throughout the United States. *SMF* ¶11. Petitioner's attorneys have represented clients, in the federal courts located in California, Illinois, New York, Minnesota, Virginia, Nevada and Colorado. *Id.* Since Respondent is located in California and Petitioner has handled cases in the federal courts of California Petitioner and Respondent's trade channels overlap.

In sum, the third salient factor establishing likelihood of confusion- similarity of

trade channels - is met here.

D. *Petitioner Has a Strong Mark*

Petitioner's mark is deemed inherently distinctive because it registered on the Principal Register. 15 U.S.C. § 1052 (1982); TMEP§1207.01(d)(ii); *California Cooler, Inc. v. Loretto Winery, Ltd.*, 774 F.2d 1451, 1454 (9th Cir. 1985). Since Petitioner's mark registered, Petitioner has made a diligent effort to police its mark to stop third party use of confusingly similar marks. *SMF* ¶4. Petitioner has been successful in obtaining third party agreements to cease using the same or similar mark. *SMF* ¶5. Petitioner's policing of its mark is an ongoing process. *SMF* ¶6. In sum, Petitioner's mark is strong because it is distinctive and Petitioner has made continued efforts to protect and maintain the distinctiveness and strength of its mark and the goodwill associated therewith.

E. The Remaining *DuPont* Factors Are Neutral

The remaining *DuPont* Factors are neutral: there is no evidence supporting buyers are either sophisticated or impulsive; although there is some third party use of similar marks for similar services, Petitioner continues to diligently police its mark to protect its distinctiveness, strength and goodwill, so this factor either weighs in Petitioner's favor or, at the very least, is neutral; there is no evidence of actual confusion but the absence of actual confusion should not weigh against a finding of likelihood of confusion²; there are no agreements to co-exist in the marketplace.

As such, the remaining *DuPont* factors either weigh more heavily in favor of

²"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." *In re Majestic Distilling Co.*, 315 F.2d at 1317.

likelihood of confusion or are neutral.

In sum, Petitioner's motion for summary judgment should be granted because Petitioner has shown all three of the salient factors establishing likelihood of confusion (similarity of marks, similarity of services and similarity of trade channels) are met in this case. *TEMP §1207.01; In re E. I. Du Pont*, 476 F.2d at 1361, 177 USPQ at 567.

Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d at 1535; see *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007).

Thus, since only a showing that just one *of the Du Pont* factors is sufficient by itself to establish likelihood of confusion; without considering the remaining *Du Pont* factors and, in this case, Petitioner showed that Respondent's mark was similar in sight, sound **and** meaning, its services using the mark are the same and the trade channels are the same, Petitioner has abundantly shown that Respondent's mark is confusingly similar to Petitioner's mark. This showing, coupled with the undisputed fact that Petitioner is the senior user of SMALL FIRM, BIG EXPERIENCE Mark along with the efforts Petitioner has made to maintain the distinctiveness and strength of its mark demonstrates Petitioner's entitlement to judgment as a matter of law.

CONCLUSION

For the foregoing reasons, Petitioner, Jahn & Associates, LLC requests Respondent's mark be cancelled.

Dated: September 12, 2016

Respectfully submitted,

s/Kirstin M. Jahn