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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
Correspondence Address	MELVIN N A AVANZADO 1880 CENTURY PARK EAST SUITE 1404 LOS ANGELES, CA 90067 UNITED STATES
Submission	Answer
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Date	11/03/2014
Attachments	USPTO Answer (Final).pdf(152564 bytes)

1 **THE AVANZADO LAW FIRM**

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10 Avanzado

11 UNITED STATES PATENT AND TRADEMARK OFFICE
12 TRIAL AND APPEAL BOARD

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15 JAHN & ASSOCIATES, a Limited Liability
16 Corporation,

17 Plaintiff,

18 v.

19 MELVIN N.A. AVANZADO, an
20 individual,

21 Defendant.
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CANCELLATION NO. 92060029
REGISTRATION NO. 4015965

ANSWER AND AFFIRMATIVE
DEFENSES OF RESPONDENT AND
DEFENDANT MELVIN N.A.
AVANZADO TO PETITION FOR
CANCELLATION

Petition filed: September 23, 2014

1 **ANSWER**

2 Respondent and Defendant Melvin N.A. Avanzado (“Avanzado” or
3 “Defendant”) hereby answers the petition for cancellation of Petitioner and Plaintiff
4 Jahn & Associates (“Jahn” or “Plaintiff”). Defendant’s numbered paragraphs below
5 correspond to the numbered paragraphs in the section of the petition for cancellation
6 entitled “Statement of Claim.”

7 **STATEMENT OF CLAIM**

8 1. Defendant admits that Plaintiff is the owner of Trademark
9 Registration No. 3,642,830 for “Small Firm, Big Experience” which was registered
10 with the United States Patent and Trademark Office on June 23, 2009. Defendant
11 lacks sufficient information concerning the other allegations in this paragraph and
12 therefore denies the allegations therein. Except as expressly admitted herein,
13 Defendant denies each and every allegation in this paragraph.

14 2. Defendant lacks sufficient information concerning the allegations
15 in this paragraph and therefore denies the allegations therein. Except as expressly
16 admitted herein, Defendant denies each and every allegation in this paragraph.

17 3. Defendant expressly denies the conclusory allegation that “Since at
18 least 2001, Jahn & Associates has continuously, extensively and widely promoted,
19 advertised and/or sold its services under the [m]ark [“Small Firm, Big Experience”] in
20 various states and foreign countries and ha widely used the [m]ark [“Small Firm, Big
21 Experience”] to identify its services and distinguish them from the goods of others and
22 continues to do so.” Defendant lacks sufficient information concerning the allegations
23 in this paragraph and therefore denies the allegations therein. Except as expressly
24 admitted herein, Defendant denies each and every allegation in this paragraph.

25 4. Defendant admits that Defendant applied for and received a federal
26 registration for “Big Firm Experience . . . Small Firm Service” –Registration No.
27 4015965 (“Defendant’s Mark”) – from the United States Patent and Trademark Office
28 on August 23, 2011. Defendant expressly denies the conclusory allegation that

1 B. Plaintiff Jahn & Associates operates a legal services firm based in
2 Nevada and Colorado specializing in intellectual property and copyright, trademark
3 and patent law.

4 C. Defendant’s geographic areas of practice do not intersect or
5 overlap with Plaintiff’s geographic areas of practice. Defendant is not licensed to
6 practice law in Nevada or Colorado and Defendant does not have a practice in Nevada
7 or Colorado; Defendant is only licensed to practice in California. Plaintiff is not
8 licensed to practice law in California.

9 D. Defendant applied for trademark registration on February 1, 2011
10 with the intent to use Defendant’s Mark in commerce. Defendant’s Mark received the
11 serial number 85231879 and the application file was sent to an examining attorney of
12 the United States Patent and Trademark Office (“USPTO”). The USPTO examining
13 attorney did not raise any objections to Defendant’s application to register
14 Defendant’s Mark.

15 E. The USPTO published Defendant’s Mark in the “Trademark
16 Official Gazette” on June 7, 2011. Any party who believed itself to be damaged by
17 Defendant’s Mark was to file a notice of opposition with the Trademark Trial and
18 Appeal Board.

19 F. Plaintiff failed to file an opposition to Defendant’s application to
20 register Defendant’s Mark or a request for an extension of time within thirty (30) days
21 after the June 7, 2011 publication date.

22 G. The USPTO granted registration of Defendant’s Mark on August
23 23, 2011.

24 H. Since March 1, 2008, including up to and after the USPTO’s grant
25 of Defendant’s registration of Defendant’s Mark, Defendant used Defendant’s Mark
26 to promote and market Defendant’s litigation practice.

27 I. Plaintiff filed this petition for cancellation more than three years
28 after Defendants’ Mark was registered with the USPTO.

1 **FIRST AFFIRMATIVE DEFENSE**

2 **(Laches)**

3 J. Defendant incorporates by reference paragraph A through
4 paragraph I, inclusive, as though set forth in full.

5 K. Plaintiff's petition for cancellation is barred by the doctrine of
6 laches.

7 **SECOND AFFIRMATIVE DEFENSE**

8 **(Estoppel/Waiver)**

9 L. Defendant incorporates by reference paragraph A through
10 paragraph K, inclusive, as though set forth in full.

11 M. Plaintiff's petition for cancellation is barred by the doctrines of
12 estoppel or waiver.

13 **THIRD AFFIRMATIVE DEFENSE**

14 **(Failure to State Claims)**

15 N. Defendant incorporates by reference paragraph A through
16 paragraph M, inclusive, as though set forth in full.

17 O. Defendant alleges that he cannot fully anticipate all affirmative
18 defenses that may be applicable to the claims asserted in the petition for cancellation
19 in light of the vague and conclusory allegations therein. Accordingly, Defendant
20 reserves the right to seek leave to add additional affirmative defenses as they are
21 ascertained.

22 **FOURTH AFFIRMATIVE DEFENSE**

23 **(Discovery of Additional Defenses)**

24 P. Defendant incorporates by reference paragraph A through
25 paragraph O, inclusive, as though set forth in full.

26 Q. Defendant alleges that he cannot fully anticipate all affirmative
27 defenses that may be applicable to the claims asserted in the petition for cancellation
28 in light of the vague and conclusory allegations therein. Accordingly, Defendant

1 reserves the right to seek leave to add additional affirmative defenses as they are
2 ascertained.

3 DATED: November 2, 2014

THE AVANZADO LAW FIRM

MELVIN N.A. AVANZADO
ELAINE W. YU

4
5
6 By: _____


Elaine W. Yu

Attorneys for Defendant
Melvin N.A. Avanzado

1 **PROOF OF SERVICE**

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

5 **ANSWER AND AFFIRAMTIVE DEFENSES OF RESPONDENT
6 AND DEFENDANT MELVIN N.A. AVANZADO TO PETITION
7 FOR CANCELLATION**

8 to be served on the interested parties in this action as follows:

9 Kirstin M. Jahn
10 Jahn & Associates, LLC
11 1942 Broadway, Suite 314
12 Boulder, Colorado 80304

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

15 **BY MAIL:** I sealed and placed such envelope for collection and mailing to be deposited in
16 the mail on the same day in the ordinary course of business at Los Angeles, California. The
17 envelope was mailed with postage thereon fully prepaid. I am readily familiar with this firm's
18 practice of collecting and processing correspondence for mailing. It is deposited with the
19 U.S. Postal Service on that same day in the ordinary course of business.

20 **BY OVERNIGHT COURIER:** I caused such envelope to be placed for collection and
21 delivery on this date in accordance with standard _____ delivery procedures.

22 **BY ELECTRONIC MAIL:** I transmitted a copy of the foregoing document(s) this date via
23 electronic mail to the electronic mail addresses of counsel in the attached service list.

24 **BY FAX:** In addition to service by mail, I transmitted a copy of the foregoing document(s)
25 this date via telecopier to the facsimile numbers shown above.

26 **BY PERSONAL SERVICE:** I personally delivered such envelope by hand to the offices of
27 the addressee(s).

28 [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 November 3, 2014, at Los Angeles, California.



Elaine W. Yu