

ESTTA Tracking number: **ESTTA662751**

Filing date: **03/24/2015**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	451 Marketing, LLC		
Entity	Limited Liability Company	Citizenship	Massachusetts
Address	100 North Washington Street Boston, MA 02114 UNITED STATES		

Attorney information	Scott I. Wolf Schlossberg, LLC 35 Braintree Hill Office Park Suite 204 Braintree, MA 02184 UNITED STATES swolf@sabusinesslaw.com, bdobush@sabusinesslaw.com Phone:781-848-5028		
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Registration Subject to Cancellation

Registration No	4465019	Registration date	01/14/2014
Registrant	Spark451 Inc. 55 Maple Avenue Suite 508 Rockville Centre, NY 11570 UNITED STATES		

Goods/Services Subject to Cancellation

Class 035. First Use: 2011/12/01 First Use In Commerce: 2011/12/01 All goods and services in the class are cancelled, namely: Advertising and marketing services provided by means of indirect methods of marketing communications, namely, social media, search engine marketing, inquiry marketing, internet marketing, mobile marketing, blogging and other forms of passive, sharable or viral communications channels to assist institutions of higher education in brand management and enrollment management
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Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Petitioner as Basis for Cancellation

U.S. Application No.	86311557	Application Date	06/17/2014
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	451 MARKETING		

Design Mark	<h1>451 MARKETING</h1>
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 2005/02/06 First Use In Commerce: 2005/02/06 Advertising services, public relations and marketing services, namely, promoting and marketing the goods and services of others through all public communication means; Development of marketing strategies, concepts and tactics, namely, audience development, brand awareness, online community building and digital word ofmouth communications; Brand creation and strategy

Attachments	86311557#TMSN.png(bytes) Petition to Cancel - Spark451.pdf(175493 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Scott I. Wolf/
Name	Scott I. Wolf
Date	03/24/2015

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

451 Marketing, LLC }
 Petitioner, } }
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v. } }
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Spark451 Inc. } }
 Registrant. } }
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PETITION TO CANCEL

Registration No. 4465019
Mark: Spark451
Filing Date: February 8, 2013
Registration Date: January 14, 2014

Cancellation No. _____

PETITION TO CANCEL

Petitioner, 451 Marketing, LLC, a Massachusetts limited liability company with a principal business address of 100 North Washington Street, Boston, MA 02114, believes that it is, or will be, damaged by Registration No. 4465019 for the mark Spark451 granted to Registrant, Spark451 Inc., and therefore files this petition to cancel said registration in its entirety. As grounds for the Petition to Cancel, Petitioner alleges as follows:

1. Petitioner, 451 Marketing, LLC, is a Massachusetts limited liability company with a principal business address of 100 North Washington Street, Boston, MA 02114.
2. Upon information and belief, the Registrant, Spark451 Inc., is a New York corporation with a principal business address of 55 Maple Avenue, Suite 508, Rockville Centre, NY 11570.
3. Registrant filed an application on February 2, 2013 for the mark “Spark451” for “advertising and marketing services provided by means of indirect methods of marketing communications, namely, social media, search engine marketing, inquiry marketing, internet

marketing, mobile marketing, blogging and other forms of passive, shareable or viral communications channels to assist institutions of higher education in brand management and enrollment management” in International Class 35. The application alleged a first use in commerce of December 1, 2011, and U.S. Trademark Reg. No. 4,465,019 was granted on January 14, 2014.

PETITIONER’S PRIORITY OF USE/LIKELIHOOD OF CONFUSION

4. Petitioner is a nationally known marketing and communications agency engaged in, among other things, advertising services, public relations and marketing services, and brand creation and strategy.

5. Since at least as early as February 6, 2005, long before Registrant’s alleged date of first use in commerce of December 1, 2011 and Registrant’s constructive use date of February 2, 2013, Petitioner has used the mark “451 MARKETING” in interstate commerce in connection with its marketing and communications services.

6. Petitioner has developed common law trademark rights to the “451 MARKETING” mark by its use of said mark in interstate commerce since at least as early as February 6, 2005.

7. The mark “451 MARKETING” is a distinctive mark. The key element of Petitioner’s mark is “451”, which is an inherently distinctive, arbitrary and fanciful term when used in the context of marketing and communication services, as it does not describe the services.

8. Petitioner has spent substantial sums in creating its marketing and communications agency under the 451 MARKETING mark, and has consistently and extensively used the 451 MARKETING mark in interstate commerce for the past ten years in connection with advertising

services, public relations and marketing services, and brand creation and strategy, encouraging the public and the trade to recognize its services under the 451 MARKETING mark and name.

9. The 451 MARKETING mark is recognized throughout the country in the marketing and communications world, and Petitioner has been named in and received awards in several regional and national award competitions.

10. On June 17, 2014, Petitioner filed an application with the United States Patent and Trademark Office (“USPTO”), assigned Application Serial No. 86311557, seeking to register Petitioner’s 451 MARKETING mark for Petitioner’s services in International Class 35, specifically, “advertising services, public relations and marketing services, namely, promoting and marketing the goods and services of others through all public communication means; development of marketing strategies, concepts and tactics, namely, audience development, brand awareness, online community building and digital word of mouth communications; brand creation and strategy.”

11. In a September 25, 2014 Office Action, the USPTO Trademark Examining Attorney assigned to Application Serial No. 86311557 refused registration of Petitioner’s mark under Section 2(d) of the Trademark Act, among other reasons, in view of Registrant’s registration for Spark451 (as well as Registration No. 4111850), finding that Registrant’s mark was similar to Petitioner’s mark, creating similar commercial impressions, and the respective services closely related, leading to consumer confusion as to the source of the services.

12. Upon information and belief, Registrant has made no use of its alleged mark “Spark451” in the United States prior to its alleged first use in commerce date of December 1, 2011, nearly

seven years after Petitioner had begun to use its “451 MARKETING” mark in commerce.

13. Registrant’s mark is substantially similar to Petitioner’s 451 MARKETING mark, as they both use the main element of Petitioner’s mark, i.e., 451.

14. The services set forth in Registrant’s registration are similar or related to the services for which Petitioner uses its mark, as both Registrant and Petitioner provide marketing and communications services.

15. The parties have the same or similar class of prospective purchasers, such as product-based companies and higher education institutions.

16. In view of the similarity of the respective marks and the related nature of the services of the respective parties, it is alleged that Registrant’s registered mark so resembles Petitioner’s mark, as to be likely to cause confusion, or to cause mistake or to deceive.

17. The Registrant’s registration enables Registrant to reap the benefits of the goodwill and reputation attached to Petitioner’s mark, all to Petitioner’s irreparable damage and injury as a result of the confusion which is likely to arise.

NOW WHEREFORE, the Petitioner respectfully requests that this Petition to Cancel be granted by the Trademark Trial and Appeal Board and that Registration No. 4,465,019 issued on January 14, 2014 be cancelled.

Respectfully submitted,
451 Marketing, LLC
By its attorneys

/Scott I. Wolf/
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Phone: 781.848.5028
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Date: March 24, 2015

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that, on March 24, 2015, I caused a true and correct copy of the foregoing Petition to Cancel to be sent via First Class Mail, postage prepaid, to Registrant at the address below:

Spark451 Inc.
55 Maple Avenue, Suite 508
Rockville Centre, NY 11570

/Scott I. Wolf/
Scott I. Wolf