

ESTTA Tracking number: **ESTTA687010**

Filing date: **07/31/2015**

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	DFASS Brands Holdings, LLC		
Entity	LLC	Citizenship	Florida
Address	3001 SW 3rd Ave Miami, FL 33129 UNITED STATES		

Correspondence information	David E. Marko Attorney for Petitioner DFASS Brands Holdings, LLC 3001 SW 3rd Ave Miami, FL 33129 UNITED STATES friedman@mm-pa.com Phone:3052852000
----------------------------	---

Registration Subject to Cancellation

Registration No	4313253	Registration date	04/02/2013
Registrant	Williams, Reginald P.O. Box 202738 Arlington, TX 76006 UNITED STATES		

Goods/Services Subject to Cancellation

Class 035. First Use: 2005/08/01 First Use In Commerce: 2005/08/01 All goods and services in the class are cancelled, namely: Provision of space on websites for advertising goods and services; Promotion, advertising and marketing of on-line web sites; Operating an online shopping site in the field of Movies, books, clothing, interactive videos, time pieces, hand bags, purses, video courses, toys; Producing promotional videotapes, video discs, and audio visual recordings; Providing a website featuring audio and video interviews, transcripts and other educational materials all concerning business topics

Grounds for Cancellation

Genericness	Trademark Act section 23
The mark is merely descriptive	Trademark Act section 2(e)(1)
Other	Mark is not registrable because it is entirely disclaimed.

Attachments	Petition to Cancel (filed copy).pdf(91429 bytes) Exhibit A - office action.pdf(16450 bytes) Exhibit B - response to office action.pdf(5569 bytes)
-------------	--

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	/David E. Marko/
Name	David E. Marko
Date	07/31/2015

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

DFASS Brand Holdings, LLC, a Florida
limited liability company,

Petitioner,

and

Reginald Williams, an individual,

Registrant.

In the matter of Registration No.
4313253

For the mark TIME TRAVEL ACADEMY

Registered on April 2, 2013

Cancellation No. _____

PETITION TO CANCEL

Petitioner, DFASS Brand Holdings, LLC, a Florida limited liability company (hereinafter “Petitioner”), believes that it will be damaged by the continued registration of the mark TIME TRAVEL ACADEMY (hereinafter “Mark”) shown in U.S. Registration No. 4313253 (hereinafter “Registration”), registered on April 2, 2013, by Reginald Williams, an individual (hereinafter “Registrant”). Petitioner hereby petitions to cancel the Registration pursuant to Section 14 of the Lanham Act, 15 U.S.C. § 1064.

The grounds for the cancellation of the Registration are as follows:

I. Introduction

1. Petitioner is a Florida based company, in the business of duty-free retail sales at airports in North America, Latin America, and the Caribbean.
2. Petitioner has expended significant resources to create a subsidiary to sell, among other things, watches, clocks, jewelry, and travel related goods.
3. Registrant maintains a website that sells education through books and videos, as well as promotional items.

II. The Registration

4. Registrant filed a trademark application with the United States Patent and Trademark Office (“USPTO”) to protect the Mark on April 5, 2008, and the Mark was registered on April 2, 2013.

5. The services identified in the Registration are “Provision of space on websites for advertising goods and services; Promotion, advertising and marketing of online web sites; Operating an online shopping site in the field of Movies, books, clothing, interactive videos, time pieces, hand bags, purses, video courses, toys; Producing promotional videotapes, video discs, and audio visual recordings; Providing a website featuring audio and video interviews, transcripts and other educational materials all concerning business topics” in International Class 035 (hereinafter “Registrant’s Services”).

6. Registrant claimed to have used the Mark in connection with Registrant’s Services since August 8, 2005.

III. Standing

7. Petitioner has standing to file this Petition for Cancellation because it has a “real interest” in the cancellation of the Mark, pursuant to Chapter 303.03 of the T.T.A.B. Manual of Procedure. *See also Lipton Inds. Inc. v. Ralston Purina, Co.*, 670 F.2d 1024, 1028 (C.C.P.A. 1982) (discussing the wide variety of interests that can equate to *real interest* and thus, standing in a trademark cancellation proceeding).

8. Petitioner’s application for registration was denied based on the validity of the Mark and the Registration.

9. Petitioner is, and will continue to be, damaged by the Registration of this Mark.

IV. The Term “Academy” is Generic

10. A generic term is one that identifies a class of goods. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (1975).

11. Generic terms cannot become trademarks because they describe a class of product, and not its source. *Park ‘N Fly, Inc. v Dollar Park and Fly, Inc.*, 469 U.S. 189, 193-94 (1984).

12. Academy is defined as “a school that provides training in special subjects or skills.” Academy, Merriam-Webster (Mar. 30, 2015), <http://www.merriam-webster.com/dictionary/academy>.

13. Registrant’s Services indicate that the Registrant provides educational materials.

14. Registrant’s use of the word “Academy” in the Mark is a generic reference to the education provided by the products and videos provided on his website.

15. Therefore, the term “Academy” cannot be afforded trademark protection because it is a generic term being used in a generic manner.

V. The Term “Time Travel” is Descriptive in the Registration

16. A descriptive term is one that “‘conveys an immediate idea of the . . . characteristics’ to which they are attached.” *Boston Duck Tours, LP v. Super Duck Tours, LLC*, 531 F.3d 1, 13 (1st Cir. 2008) (quoting *Equine Tech. Inc. v. Equitechnology, Inc.*, 68 F.3d 542, 544 (1st Cir. 1995)).

17. Descriptive terms cannot become trademarks because they “are not inherently capable of service as source-identifiers.” *Id.* at 13.

18. Unless a descriptive term is inherently distinctive or acquires a secondary meaning, it does not qualify for trademark protection. *See Borinquen Biscuit Corp. v. M.V. Trading Corp.*, 443 F.3d 112, 116-17 (1st Cir. 2006).

19. Registrant's Services include a series of books and videos with an underlying theme of time travel.

20. The "Time Travel" portion of the mark is descriptive of the Registrant's Services.

21. The USPTO requested that Registrant disclaim the term "Time Travel" because "it merely describes the subject matter of the video courses, movies and books the applicant publishes and sells online, as well as the audio/video it produces and features on its website. Also the wording describes the field of courses it provides on-line registration for." Exhibit "A".

22. Registrant accordingly disclaimed "Time Travel" in his October 2, 2009 Response to Office Action, without objection or dispute. Exhibit "B".

23. The term "Time Travel," when used to describe the nature of the Registrant's Services, cannot become a protected trademark because it is descriptive of Registrant's product, does not identify the source, and has been disclaimed by Registrant at the request of the USPTO.

VI. The Mark is Not Properly Registrable

24. Marks that must be entirely disclaimed, or have no otherwise registrable parts, do not qualify as composite marks for which trademark protection can be afforded. *See Dena Corp. v. Belvedere Int'l Inc.*, 950 F.2d 1555, 1558 (Fed. Cir. 1991).

25. A composite mark is a mark containing registrable and nonregistrable matter. *See Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 40 S. Ct. 414, 415 (1920).

26. "[T]he practice of refusing to register composite marks made entirely of nonregistrable sub-parts predates the Lanham Act of 1946 and its more modern successors."

Pilates, Inc. v. Georgetown Bodyworks Deep Muscle Massage Ctrs., Inc., 157 F. Supp. 2d 75, 81 (D.D.C. 2001).

27. “Under traditional disclaimer practice an applicant could not disclaim all elements of a composite mark. Section 1056(a) codified this policy. A mark which must be entirely disclaimed has no ‘unregistrable component,’ *but is instead entirely unregistrable.*” *Id.* at 81 (emphasis added).

28. The Mark consists solely of the descriptive term “Time Travel” and the generic term “Academy.”

29. The USPTO instructed Registrant to disclaim the “Time Travel” portion of the mark because it is descriptive of the subject matter of the Registrant Services. *See* Exhibit “A”.

30. Registrant explicitly stated in the October 2, 2009 Response to Office Action that he made “no claim to the exclusive right to use ‘Time Travel’ apart from the [M]ark. . .” *See* Exhibit “B”.

31. The term “Academy” is generic, must be disclaimed and is effectively disclaimed in the Registration of the Mark.

32. Because “Academy” is generic and disclaimed, and “Time Travel” is descriptive and disclaimed, the Mark “Time Travel Academy” is not a properly registrable composite mark, but is instead *entirely unregistrable*.

33. Continued registration of the term “Time Travel Academy” for Registrant’s Services is a source of injury to Petitioner who is entitled to use the term “Time Travel,” as it confers upon Registrant the presumptions that the Mark is distinctive for Registrant’s Services (for which it is *not* descriptive), and that Registrant enjoys the exclusive right to use the Mark in association with such services.

VII. The Mark “Time Travel Academy” is not Inherently Distinctive

34. An otherwise unprotectable descriptive term may qualify for trademark protection if it is found to be inherently distinctive. *See Wal-Mart Stores, Inc. v. Samara Bros. Inc.*, 529 U.S. 205, 210-11 (2000).

35. A descriptive term is inherently distinctive when “its intrinsic nature serves to identify a particular source.” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992).

36. Where a descriptive word is paired with a product, “inherent distinctiveness will not be found.” *Wal-mart Stores, Inc.*, 529 U.S. at 213 (discussing marks such as “Tasty” bread or “Georgia” peaches, which contain only descriptive terms paired with the underlying goods, and therefore are not inherently distinctive).

37. The Mark contains the words “Time Travel” and “Academy,” which is a descriptive term paired with the generic term for the underlying goods or services.

38. Accordingly, the Mark is not inherently distinctive, and does not qualify for trademark protection under that classification.

VIII. The Mark “Time Travel Academy” Has Not Acquired a Secondary Meaning

39. An otherwise unprotectable descriptive term may qualify for trademark protection if it acquires a secondary meaning in the marketplace. *See Wal-mart Stores, Inc.*, 529 U.S. at 211.

40. A descriptive term has acquired secondary meaning when “the primary significance of the term in the minds of the consuming public is not the product but the producer.” *See Welding Services, Inc. v. Forman*, 509 F.3d 1351, 1358 (11th Cir. 2011).

41. Registrant has the burden of sustaining a high degree of proof in establishing a secondary meaning for a descriptive term.” *Investacorp Inc. v. Arabian Inv. Banking Corp. (Investcorp) E.C.*, 931 F. 2d 1519, 1526 (11th Cir. 1991).

42. In the application for Registration, Registrant made no assertion that the Mark has acquired a secondary meaning.

43. “Time Travel Academy” is a descriptive mark that is not inherently distinctive, and has not acquired secondary meaning, and is therefore precluded from trademark protection.

WHEREFORE, Petitioner respectfully requests that the Registration be canceled, and that this Petition to Cancel be sustained.

A fee of \$300 is submitted herewith.

Respectfully submitted,

DATED: July 31, 2015

MARKO & MAGOLNICK, P.A.

By: 

David Everett Marko, Esq.
3001 S.W. 3rd Avenue
Miami, Florida 33129
Phone: 305-285-2000
Fax: 305-285-5555
Email: marko@mm-pa.com

Attorney for Petitioner

To: Williams, Reginald (dallas10102@aol.com)
Subject: TRADEMARK APPLICATION NO. 77440967 - TIME TRAVEL ACADEMY - N/A
Sent: 4/14/2009 9:44:49 PM
Sent As: ECOM117@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/440967

MARK: TIME TRAVEL ACADEMY

77440967

CORRESPONDENT ADDRESS:
REGINALD WILLIAMS
PO BOX 202738
ARLINGTON, TX 76006-8738

RESPOND TO THIS ACTION:
<http://www.uspto.gov/teas/eTEASpageD.htm>

GENERAL TRADEMARK INFORMATION:
<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: Williams, Reginald

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:
dallas10102@aol.com

OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE: 4/14/2009

TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT FEE: TEAS Plus applicants should submit the following documents using the Trademark Electronic Application System (TEAS) at <http://www.uspto.gov/teas/index.html>: (1) written responses to Office actions; (2) preliminary amendments; (3) changes of correspondence address; (4) changes of owner's address; (5) appointments and revocations of attorney; (6) amendments to allege use; (7) statements of use; (8) requests for extension of time to file a statement of use, and (9) requests to delete a §1(b) basis. If any of these documents are filed on paper, they must be accompanied by a \$50 per class fee. 37 C.F.R. §§2.6(a)(1)(iv) and 2.23(a)(i). Telephone responses will not incur an additional fee. NOTE: In addition

to the above, applicant must also continue to accept correspondence from the Office via e-mail throughout the examination process in order to avoid the additional fee. 37 C.F.R. §2.23(a)(2).

This application was withdrawn from publication for the reasons listed below. Upon further consideration, the additional requirements are issued below. The trademark attorney apologizes for any inconvenience to applicant caused by the Office's failure to raise the issue in the earlier office action.

DISCLAIMER

The applicant should withdraw the disclaimer of ACADEMY and should submit the following disclaimer instead. Applicant must disclaim the descriptive wording "TIME TRAVEL" apart from the mark as shown because it merely describes the subject matter of the video courses, movies and books the applicant publishes and sells online, as well as the audio/video it produces and features on its website. Also the wording describes the field of courses it provides on-line registration for. See 15 U.S.C. §1056(a); TMEP §§1213, 1213.03(a).

The computerized printing format for the Office's *Trademark Official Gazette* requires a standardized format for a disclaimer. TMEP §1213.08(a)(i). The following is the standard format used by the Office:

No claim is made to the exclusive right to use "TIME TRAVEL" apart from the mark as shown.

TMEP §1213.08(a)(i); see *In re Owatonna Tool Co.*, 231 USPQ 493 (Comm'r Pats. 1983).

A disclaimer does not physically remove the disclaimed matter from the mark, but rather is a written statement that applicant does not claim exclusive rights to the disclaimed wording and/or design separate and apart from the mark as shown in the drawing. TMEP §§1213, 1213.10.

The following cases further explain the disclaimer requirement: *Dena Corp. v. Belvedere Int'l Inc.*, 950 F.2d 1555, 21 USPQ2d 1047 (Fed. Cir. 1991); *In re Brown-Forman Corp.*, 81 USPQ2d 1284 (TTAB 2006); *In re Kraft, Inc.*, 218 USPQ 571 (TTAB 1983).

Applicant is encouraged to telephone or e-mail the assigned trademark examining attorney to resolve the issue raised in this Office action.

F BLANDU
/f blandu/
l.o.117
tel 571 272-9128
fax 571 273-9128
e-mail (for informal communications only)
florentina.blandu@uspto.gov

RESPOND TO THIS ACTION: Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For *technical* assistance with the form, please e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned examining

attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

To: Williams, Reginald (dallas10102@aol.com)
Subject: TRADEMARK APPLICATION NO. 77440967 - TIME TRAVEL ACADEMY - N/A
Sent: 4/14/2009 9:44:54 PM
Sent As: ECOM117@USPTO.GOV
Attachments:

IMPORTANT NOTICE
USPTO OFFICE ACTION HAS ISSUED ON 4/14/2009 FOR
APPLICATION SERIAL NO. 77440967

Please follow the instructions below to continue the prosecution of your application:

VIEW OFFICE ACTION: Click on this link http://tportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77440967&doc_type=OOA& (or copy and paste this URL into the address field of your browser), or visit <http://tportal.uspto.gov/external/portal/tow> and enter the application serial number to [access](#) the Office action.

PLEASE NOTE: The Office action may not be immediately available but will be viewable within 24 hours of this notification.

RESPONSE MAY BE REQUIRED: You should carefully review the Office action to determine (1) if a response is required; (2) how to respond; and (3) the applicable [response time period](#). Your response deadline will be calculated from **4/14/2009**.

Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System response form at <http://www.uspto.gov/teas/eTEASpageD.htm>.

HELP: For *technical* assistance in accessing the Office action, please e-mail TDR@uspto.gov. Please contact the assigned examining attorney with questions about the Office action.

WARNING

- 1. The USPTO will NOT send a separate e-mail with the Office action attached.**
- 2. Failure to file any required response by the applicable deadline will result in the [ABANDONMENT](#) of your application.**

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77440967
LAW OFFICE ASSIGNED	LAW OFFICE 117
MARK SECTION (no change)	
ADDITIONAL STATEMENTS SECTION	
DISCLAIMER	No claim is made to the exclusive right to use TIME TRAVEL apart from the mark as shown.
MISCELLANEOUS STATEMENT	I would like to withdraw the disclaimer of ACADEMY and disclaim TIME TRAVEL
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Reginald Williams/
SIGNATORY'S NAME	/Reginald Williams/
SIGNATORY'S POSITION	Owner
DATE SIGNED	10/02/2009
AUTHORIZED SIGNATORY	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Fri Oct 02 10:31:52 EDT 2009
TEAS STAMP	USPTO/ROA-76.183.182.241- 20091002103152067282-7744 0967-460a63cfb347548de682 3f01cd0cab838ed-N/A-N/A-2 0091002102814808540

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **77440967** has been amended as follows:

ADDITIONAL STATEMENTS

Disclaimer

No claim is made to the exclusive right to use TIME TRAVEL apart from the mark as shown.

I would like to withdraw the disclaimer of ACADEMY and disclaim TIME TRAVEL

SIGNATURE(S)

Response Signature

Signature: /Reginald Williams/ Date: 10/02/2009

Signatory's Name: /Reginald Williams/

Signatory's Position: Owner

The signatory has confirmed that he/she is not represented by either an authorized attorney or Canadian attorney/agent, and that he/she is either (1) the applicant or (2) a person(s) with legal authority to bind the applicant; and if an authorized U.S. attorney or Canadian attorney/agent previously represented him/her in this matter, either he/she has filed a signed revocation of power of attorney with the USPTO or the USPTO has granted the request of his/her prior representative to withdraw.

Serial Number: 77440967

Internet Transmission Date: Fri Oct 02 10:31:52 EDT 2009

TEAS Stamp: USPTO/ROA-76.183.182.241-200910021031520

67282-77440967-460a63cfb347548de6823f01c

d0cab838ed-N/A-N/A-20091002102814808540