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Filing date: **01/25/2016**

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

Proceeding	92062194
Party	Plaintiff DCI Marketing, Inc.
Correspondence Address	EDWARD E CLAIR FITCH EVEN TABIN & FLANNERY LLP 120 S LASALLE STREET SUITE 1600 CHICAGO, IL 60603-3402 UNITED STATES trademark@fitcheven.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	John E. Lyhus
Filer's e-mail	trademark@fitcheven.com
Signature	/John E. Lyhus/
Date	01/25/2016
Attachments	2016 01 25 Motion to Amend LIVEGUIDE Cancellation No 92062194.pdf(453049 bytes )

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

In the matter of Trademark Registration No. 4361258  
Trademark LiveGuide

DCI Marketing, Inc.	)	
DBA DCI-Artform	)	
	)	
Petitioner,	)	Cancellation No. 92062194
	)	
v.	)	
	)	
CommFocus, LLC ( <i>by assignment from</i>	)	
<i>LiveGuide, LLC, Registrant</i> )	)	
	)	
Respondent.	)	

MOTION TO AMEND PETITION FOR CANCELLATION

Petitioner, DCI Marketing, Inc., pursuant to TBMP 507; FRCP 15 (a), makes this motion for leave to file an amended Petition for Cancellation, a copy of which is attached to this motion as Exhibit 1.

Petitioner requests leave to amend based on the Answer of the Respondent, which alleges, inter alia, that ownership of the LiveGuide mark, Registration No. 4361258, was transferred from the registrant LiveGuide, LLC to CommFocus, LLC, and, further, that the LiveGuide mark has not been abandoned. Further, Respondent moved to substitute CommFocus, LLC for LiveGuide, LLC, which was granted November 17, 2015.

At the time that Petitioner commenced this Cancellation, LiveGuide, LLC was already a dissolved entity according to the public online records of the State Of Georgia, Office of the Secretary Of State. Petitioner's initial pleadings seek cancellation of Registration No. 4361258

solely on the registrant's abandonment of the LiveGuide mark. However, the alleged transfer of Registration No. 4361258 to CommFocus, LLC and resulting defense of the registered mark creates substantially changed circumstances, which necessitate the filing of an amended Petition for Cancellation.

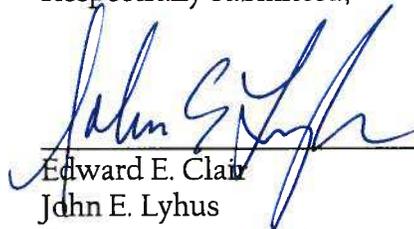
Leave to amend pleadings is to be freely granted under TBMP 507 and FRCP 15 (a).

TBMP 507 states:

[T]he Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties. [Cited cases omitted]

The instant cancellation proceeding is presently in discovery phase and the proposed amended pleadings are neither in violation of settled law or prejudicial to the rights of any party. On the forgoing, the Petitioner respectfully requests that its Motion be granted.

Respectfully submitted,



Edward E. Clair  
John E. Lyhus  
FITCH, EVEN, TABIN & FLANNERY LLP  
120 South LaSalle, Suite 1600  
Chicago, Illinois 60603

Date: January 25, 2016

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Facsimile 312.577.7007

*Attorneys for Petitioner*

# **Exhibit 1**

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

In the matter of Trademark Registration No. 4361258  
Trademark LiveGuide

DCI Marketing, Inc.	)	
DBA DCI-Artform	)	
	)	
Petitioner,	)	Cancellation No. 92062194
	)	
v.	)	
	)	
CommFocus, LLC ( <i>by assignment from</i>	)	
<i>LiveGuide, LLC, Registrant</i> )	)	
	)	
Respondent.	)	

PROPOSED AMENDED PETITION FOR CANCELLATION

Petitioner, DCI Marketing, Inc., a corporation organized in the State of Wisconsin and conducting business at 2727 West Good Hope Road, Milwaukee, Wisconsin 53209, believes that it is or will be damaged by Registration No. 4361258 of the mark LiveGuide specifying the following services:

Analysis of market research data and statistics; Collection of market research information; Computerized market research services; Conducting business and market research surveys; Market research and business analyses; Market research and market intelligence services; Market research by means of a computer database; Market research services; Market research studies; Online business research services that allow users to share opinions with a marketing research company related to everyday consumer products and services.

Petitioner seeks to cancel Registration No. 4361258 on the following grounds:

BACKGROUND ALLEGATIONS COMMON TO ALL CAUSES OF ACTION

1. Petitioner on November 10, 2014 filed an Application identified as Application No. 86449800 to register the mark LIVEGUIDE on the Principal Register based on use of the mark anywhere and in commerce beginning at least as early as June 26, 2009 for

Electronic advertisement and messaging display unit with multi-networking (TCP/IP) capabilities and remote connectivity; Computer applications for use in creating, distributing and managing advertising, information and messaging displays - in International Class 9; and,

Advertising and marketing consultancy; Digital advertising services; Design of advertising materials for others; Creating and updating advertising material; Creating and updating advertising for customer point of purchase display monitors - in International Class 35.

2. By reason of use of the mark and ownership of Application No. 86449800, Petitioner holds valid rights in and to the mark LIVEGUIDE for identified goods and services.

3. Petitioner on November 10, 2014 filed an Application identified as Application No. 86449819 to register the mark  on the Principal Register based on use of the mark anywhere and in commerce beginning at least as early as June 26, 2009 for

Electronic advertisement and messaging display unit with multi-networking (TCP/IP) capabilities and remote connectivity; Computer applications for use in creating, distributing and managing advertising, information and messaging displays - in International Class 9; and,

Advertising and marketing consultancy; Digital advertising services; Design of advertising materials for others; Creating and updating advertising material; Creating and updating advertising for customer point of purchase display monitors - in International Class 35.

4. By reason of use of the mark and ownership of Application No. 86449819, Petitioner holds valid rights in and to the mark  for identified goods and services.

5. During the examination of Petitioner's Application Nos. 86449800 and 86449819, the Patent and Trademark Office cited Registration No. 4361258 as a likely source of confusion and, therefore, Application Nos. 86449800 and 86449819 have both been initially refused registration.

6. Registration No. 4361258 for the mark LiveGuide results from a Section 1(a)-based Application No. 85775649 filed November 9, 2012 and registered July 2, 2013 on the Principal Register, with registration issued to LiveGuide, LLC, a Georgia Limited Liability Company with a business address of 395 Guildhall Grove, Johns Creek, Georgia 30022.

7. On information and belief, Registrant LiveGuide, LLC did not provide services specified in Registration No. 4361258 in connection with use of the LiveGuide mark on or before November 9, 2012.

8. On information and belief, Registrant LiveGuide, LLC has never provided services specified in Registration No. 4361258 in connection with use of the LiveGuide mark.

9. Respondent CommFocus, LLC asserts ownership of the LiveGuide mark and Registration No. 4361258 effective as of January 1, 2013 by an assignment from Registrant LiveGuide, LLC executed October 15, 2015.

10. On information and belief, Registrant, LiveGuide, LLC was dissolved at the time that the assignment document transferring asserted ownership of the LiveGuide mark and Registration No. 4361258 to CommFocus, LLC was executed.

11. On information and belief, CommFocus, LLC never became and is not now the owner of the LiveGuide mark and Registration No. 4361258.

12. Registrant LiveGuide, LLC discontinued use of the mark LiveGuide on or about January 1, 2013.

13. On information and belief, Respondent CommFocus, LLC has never provided services specified in Registration No. 4361258 in connection with use of the LiveGuide mark.

14. The continued registration of mark LiveGuide for its specified services causes damage to the Petitioner which will continue as long as Registration No. 4361258 is maintained on the Register.

#### REGISTRATION NO. 4361258 VOID AB INITIO

15. On information and belief, at the time of filing Application No. 85775649, Registrant LiveGuide, LLC was not providing services specified in Registration No. 4361258 in connection with use of the mark LiveGuide anywhere or in commerce, making Registration No. 4361258 void ab initio.

#### ABANDONMENT OF LIVEGUIDE MARK

16. On information and belief, Registrant LiveGuide, LLC discontinued use of the mark LiveGuide without intent to resume and abandoned any rights that it ever may have had or could have claimed in or to the mark LiveGuide for the services specified in Registration No. 4361258 for which cancellation is sought.

17. On information and belief, Respondent CommFocus, LLC never used or discontinued use of the mark LiveGuide without having intent to resume and abandoned any rights that it ever may have had or could have claimed in or to the mark LiveGuide for the services specified in Registration No. 4361258 for which cancellation is sought.

#### LIKELIHOOD OF CONFUSION

18. Petitioner is the owner of Registration No. 3680994 for the LIVEGUIDE mark based on use of the mark beginning at least as early as June 26, 2009 for specified "Point of purchase displays," which was filed as Application No. 77481454 on May 22, 2008 and which

issued September 8, 2009. A current printout of information from the USPTO electronic database records, which shows the current status and title of Registration No. 3680994, appears in Exhibit A.

19. On information and belief, Registrant LiveGuide, LLC and Respondent CommFocus, LLC cannot establish use or other priority in the LiveGuide mark earlier than the Oct. 26, 2012 claim of first use anywhere asserted in Application No. 85775649.

20. On information and belief, Petitioner's priority in and use of its LIVEGUIDE marks for the goods and services specified in Application Nos. 86449800 and 86449819 and goods specified in Registration No. 3680994 is earlier than any priority that can be asserted in relation to Registration No. 4361258.

21. By reason of use, marketing, publicity, advertising, promotion and resulting public recognition and sales of specified goods throughout the United States in connection with the Petitioner's LIVEGUIDE marks and the high quality of its specified goods and services, the LIVEGUIDE marks have acquired substantial distinctiveness and have come to represent substantial and valuable goodwill to the Petitioner.

22. The adoption of the LiveGuide mark in Registration No. 4361258 has been without the consent or permission of the Petitioner.

23. On information and belief, the adoption of LiveGuide mark in Registration No. 4361258 has been with actual or constructive knowledge of the Petitioner's prior rights in, use of and/or registration of the LIVEGUIDE marks in connection with the Petitioner's specified goods and services.

24. The services specified in Registration No. 4361258 are identical, similar and closely related to the goods and services that the Petitioner provides in connection with the LIVEGUIDE marks.

25. On information and belief, the services specified in Registration No. 4361258 are marketed and sold to the same or related customers in the same or related channels of trade as the Petitioner's goods and services in connection with the LIVEGUIDE marks.

26. The LiveGuide mark in Registration No. 4361258 is identical to, indistinguishable from and confusingly similar to the Petitioner's LIVEGUIDE marks, causing the likelihood of confusion, mistake, or deception that the services specified in Registration No. 4361258 are those of the Petitioner or are otherwise endorsed, sponsored, or approved by the Petitioner.

#### REQUEST FOR RELIEF

WHEREFORE, DCI Marketing, Inc. DBA DCI-Artform respectfully requests that Registration No. 4361258 for LiveGuide be cancelled in its entirety, and that DCI Marketing, Inc. DBA DCI-Artform be awarded such further relief as the Board deems just and proper.

Respectfully submitted,

Date: \_\_\_\_\_

\_\_\_\_\_  
Edward E. Clair  
John E. Lyhus  
FITCH, EVEN, TABIN & FLANNERY LLP  
120 South LaSalle, Suite 1600  
Chicago, Illinois 60603

Telephone 312.577.7000  
Facsimile 312.577.7007

*Attorneys for Petitioner*

# **Exhibit A**

**Trademarks > Trademark Electronic Search System (TESS)**

TESS was last updated on Fri Jan 22 03:21:05 EST 2016

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# LIVEGUIDE

<b>Word Mark</b>	LIVEGUIDE
<b>Goods and Services</b>	IC 020. US 002 013 022 025 032 050. G & S: Point of purchase displays. FIRST USE: 20090626. FIRST USE IN COMMERCE: 20090626
<b>Standard Characters Claimed</b>	
<b>Mark Drawing Code</b>	(4) STANDARD CHARACTER MARK
<b>Serial Number</b>	77481454
<b>Filing Date</b>	May 22, 2008
<b>Current Basis</b>	1A
<b>Original Filing Basis</b>	1B
<b>Published for Opposition</b>	August 19, 2008
<b>Registration Number</b>	<b>3680994</b>
<b>Registration Date</b>	September 8, 2009
<b>Owner</b>	(REGISTRANT) DCI Marketing, Inc. CORPORATION WISCONSIN 2727 West Good Hope Road Milwaukee WISCONSIN 53209
<b>Attorney of Record</b>	Edward E. Clair
<b>Type of Mark</b>	TRADEMARK
<b>Register</b>	PRINCIPAL
<b>Affidavit Text</b>	SECT 15. SECT 8 (6-YR).
<b>Live/Dead Indicator</b>	LIVE

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**Mark:** LIVEGUIDE

# LIVEGUIDE

<b>US Serial Number:</b>	77481454	<b>Application Filing Date:</b>	May 22, 2008
<b>US Registration Number:</b>	3680994	<b>Registration Date:</b>	Sep. 08, 2009
<b>Filed as TEAS Plus:</b>	Yes	<b>Currently TEAS Plus:</b>	Yes
<b>Register:</b>	Principal		
<b>Mark Type:</b>	Trademark		
<b>Status:</b>	A Sections 8 and 15 combined declaration has been accepted and acknowledged.		
<b>Status Date:</b>	Oct. 20, 2015		
<b>Publication Date:</b>	Aug. 19, 2008	<b>Notice of Allowance Date:</b>	Nov. 11, 2008

▼ **Mark Information** [▲ Collapse All](#)

**Mark Literal Elements:** LIVEGUIDE

**Standard Character Claim:** Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

**Mark Drawing Type:** 4 - STANDARD CHARACTER MARK

▼ **Goods and Services**

**Note:**

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks \*..\* identify additional (new) wording in the goods/services.

**For:** Point of purchase displays

**International Class(es):** 020 - Primary Class **U.S Class(es):** 002, 013, 022, 025, 032, 050

**Class Status:** ACTIVE

**Basis:** 1(a)

**First Use:** Jun. 26, 2009 **Use in Commerce:** Jun. 26, 2009

▼ **Basis Information (Case Level)**

<b>Filed Use:</b>	No	<b>Currently Use:</b>	Yes	<b>Amended Use:</b>	No
<b>Filed ITU:</b>	Yes	<b>Currently ITU:</b>	No	<b>Amended ITU:</b>	No

<b>Filed 44D:</b> No	<b>Currently 44D:</b> No	<b>Amended 44D:</b> No
<b>Filed 44E:</b> No	<b>Currently 44E:</b> No	<b>Amended 44E:</b> No
<b>Filed 66A:</b> No	<b>Currently 66A:</b> No	
<b>Filed No Basis:</b> No	<b>Currently No Basis:</b> No	

**▼ Current Owner(s) Information**

**Owner Name:** DCI Marketing, Inc.

**Owner Address:** 2727 West Good Hope Road  
Milwaukee, WISCONSIN UNITED STATES 53209

**Legal Entity Type:** CORPORATION

**State or Country Where Organized:** WISCONSIN

**▼ Attorney/Correspondence Information**

**Attorney of Record**

**Attorney Name:** Edward E. Clair

**Docket Number:** 20259-132205

**Attorney Primary Email Address:** [trademark@fitcheven.com](mailto:trademark@fitcheven.com)

**Attorney Email Authorized:** Yes

**Correspondent**

**Correspondent Name/Address:** Edward E. Clair  
Fitch, Even, Tabin & Flannery LLP  
120 South LaSalle Street  
Suite 1600  
Chicago, ILLINOIS UNITED STATES 60603

**Phone:** 312-577-7000

**Fax:** 312-577-7007

**Correspondent e-mail:** [trademark@fitcheven.com](mailto:trademark@fitcheven.com)

**Correspondent e-mail Authorized:** Yes

**Domestic Representative - Not Found**

**▼ Prosecution History**

Date	Description	Proceeding Number
Oct. 20, 2015	NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - E-MAILED	
Oct. 20, 2015	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	76873
Oct. 20, 2015	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	76873
Sep. 08, 2015	TEAS SECTION 8 & 15 RECEIVED	
Sep. 08, 2009	REGISTERED-PRINCIPAL REGISTER	
Jul. 31, 2009	LAW OFFICE REGISTRATION REVIEW COMPLETED	71441
Jul. 30, 2009	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Jul. 24, 2009	STATEMENT OF USE PROCESSING COMPLETE	70565
Jun. 30, 2009	USE AMENDMENT FILED	70565
Jul. 24, 2009	CASE ASSIGNED TO INTENT TO USE PARALEGAL	70565
Jun. 30, 2009	TEAS STATEMENT OF USE RECEIVED	
May 06, 2009	EXTENSION 1 GRANTED	98765
May 06, 2009	EXTENSION 1 FILED	98765
May 06, 2009	TEAS EXTENSION RECEIVED	
Nov. 11, 2008	NOA MAILED - SOU REQUIRED FROM APPLICANT	
Aug. 19, 2008	PUBLISHED FOR OPPOSITION	

Jul. 30, 2008	NOTICE OF PUBLICATION	
Jul. 16, 2008	LAW OFFICE PUBLICATION REVIEW COMPLETED	71441
Jul. 14, 2008	ASSIGNED TO LIE	71441
Jul. 14, 2008	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jul. 14, 2008	ASSIGNED TO EXAMINER	77769
May 28, 2008	NOTICE OF PSEUDO MARK MAILED	
May 27, 2008	NEW APPLICATION ENTERED IN TRAM	

▼ **Maintenance Filings or Post Registration Information**

**Affidavit of Continued Use:** Section 8 - Accepted

**Affidavit of Incontestability:** Section 15 - Accepted

▼ **TM Staff and Location Information**

**TM Staff Information - None**

**File Location**

**Current Location:** TMEG LAW OFFICE 102

**Date in Location:** Oct. 20, 2015

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CERTIFICATE OF SERVICE

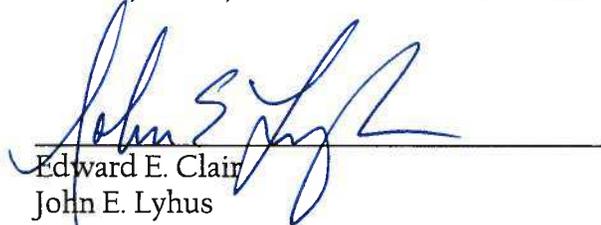
I, John E. Lyhus, Attorney for Petitioner, hereby certify that a copy of the foregoing MOTION TO AMEND PETITION FOR CANCELLATION was served by first class mail, postage prepaid, upon:

Peter E Morgan  
Briskin Cross & Sanford LLC  
1001 Cambridge Square, Suite D  
Alpharetta, GA 30009

*Attorney for Registrant LiveGuide, LLC and Respondent CommFocus, LLC*

on this 25th day of January 2016.

FITCH, EVEN, TABIN & FLANNERY LLP



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*Attorney for Petitioner*