

ESTTA Tracking number: **ESTTA711852**

Filing date: **12/02/2015**

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	Institute for Justice		
Entity	not-for-profit corporation	Citizenship	District of Columbia
Address	901 North Glebe Road, Suite 900 Arlington, VA 22203 UNITED STATES		

Attorney information	Christopher Kelly WILEY REIN LLP 1776 K Street, N.W. Washington, DC 20006 UNITED STATES ckelly@wileyrein.com Phone:202.719.7000
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Registration Subject to Cancellation

Registration No	3790306	Registration date	05/18/2010
International Registration No.	NONE	International Registration Date	NONE
Registrant	Intrum Justitia Licensing AG Industriestrasse 13c SWITZERLAND		

Goods/Services Subject to Cancellation

Class 045. First Use: 0 First Use In Commerce: 0 All goods and services in the class are cancelled, namely: Legal services; security consultation services in the field of protection of property and individuals
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Grounds for Cancellation

The registration is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.	Trademark Act section 14
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Attachments	PETITION FOR PARTIAL CANCELLATION - IJ.pdf(413476 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	/Christopher Kelly/
Name	Christopher Kelly
Date	12/01/2015

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

IN RE REG. NO. : 3,790,306
MARK: IJ
REGISTERED: May 18, 2010

INSTITUTE FOR JUSTICE)	
)	
Petitioner,)	
)	Cancellation No.: _____
v.)	
)	
INTRUM JUSTITIA LICENSING AG,)	
)	
Respondent.)	

PETITION FOR PARTIAL CANCELLATION

Institute for Justice, a not-for-profit corporation organized under the laws of the District of Columbia, with an address at 901 North Glebe Road, Suite 900, Arlington, Virginia 22203 (“Petitioner”), petitions under Section 18 of the Trademark Act, 15 U.S.C. 1068, for partial cancellation of Reg. No. 3,790,306 – IJ (Stylized) registered on the Principal Register May 18, 2010 by Intrum Justitia Licensing AG. (“Respondent”). Petitioner seeks partial cancellation of the services identified in International Class 45, currently described as follows:

legal services; security consultation services in the field of protection of property and individuals.

Petitioner is being damaged by the presence of the subject registration on the Principal Register in the absence of a limitation to the recited services and puts forth the following grounds for partial cancellation:

1. Petitioner is a not-for-profit, non-partisan public interest law and policy firm, combining litigation, media, advocacy, and education to further its goals of limiting the size and scope of government and protecting individual liberties.

2. Petitioner is the owner of pending application Ser. No. 86/544,485 – IJ filed in the U.S. Patent and Trademark Office on February 24, 2015 for the following services:

promoting public awareness through outreach and communication efforts of the need for protection of individual liberties, in International Class 35;

education services, namely, training policy activists, lawyers, law students and others to identify, and bring to public attention, issues and cases in which individual liberties are threatened and to determine the appropriate means for redress; education services, namely, conducting research in the areas of individual liberties, public law and social affairs; publication of documents in the fields of individual liberties, public law and social affairs, in International Class 41;

providing public interest legal services focused on the protection of individual liberties; legal research in the area of public law, in International Class 45.

3. Petitioner’s application stands refused as to the services in International Class 45 by the examination division of the U.S. Patent and Trademark Office based on Respondent’s registration under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), in the belief that a likelihood of confusion exists in this case.¹

4. Petitioner and Respondent are parties to a certain “Consent to Use and Register” agreement (“Agreement”) executed March 24, 2010. (A copy of the Agreement is appended to this Petition as **Exhibit A.**)

¹ Petitioner is filing a Request to Divide concurrently with this Petition for Partial Cancellation requesting approval of the mark as to the services identified in International Classes 35 and 41.

5. Respondent's services relate to, among other things, debt collection and recovery and are unrelated to Petitioner's services.

6. On information and belief, the parties' respective services are sold through different trade channels to different classes of purchasers.

7. Petitioner believes and maintains that no likelihood of confusion exists between its pending application and Respondent's registration.

8. Petitioner forwarded a new consent agreement covering Petitioner's application Ser. No. 86/544,485 to Respondent through Respondent's counsel for review and signature.

9. To date, Petitioner has not received the executed consent.

10. If, as set forth in the Office Action issued in connection with Petitioner's application Ser. No. 86/544,485, the examination division believes that Petitioner's IJ mark so resembles Respondent's registered mark as to be likely, when applied to Petitioner's services, to cause confusion, then the recitation of services in Reg. No. 3,790,306 must be narrowed to contain an appropriate limitation. In the absence of any limitation, the recitation is overly broad.

11. Petitioner believes that an amendment to Reg. No. 3,790,306 to indicate that Respondent's legal services relate to debt collection and recovery will obviate any likelihood of confusion the U.S. Patent and Trademark Office may believe exists in this case.

12. Petitioner is being damaged and will continue to be damaged because Respondent's description of services is overly broad and is barring registration of Petitioner's application Ser. No. 86/544,485.

WHEREFORE, Petitioner prays that its petition for partial cancellation be sustained and that the identification of goods in the challenged registration be limited as set forth above.

Contemporaneously with the electronic filing of this Petition for Partial Cancellation, Petitioner's counsel authorizes filing fees in the amount of \$300.00 to be debited from counsel's Deposit Account No. 501129. If the amount received is insufficient and additional fees are required, the USPTO is authorized to charge Deposit Account No. 501129. Please recognize as attorneys for Petitioner in this proceeding Christopher Kelly and Jennifer Elgin and the law firm WILEY REIN LLP, 1776 K Street, N.W., Washington, D.C. 20006.

This Petition for Partial Cancellation is being filed by the undersigned attorneys at law, duly authorized to represent Petitioner in this proceeding, pursuant to Trademark Rule 2.111(b).

Respectfully submitted,

INSTITUTE FOR JUSTICE

By: /Christopher Kelly/
Christopher Kelly
Jennifer Elgin
WILEY REIN LLP
1776 K Street, N.W.
Washington, D.C. 20006
(202) 719-7000

Attorneys for Petitioner

Dated: December 1, 2015

EXHIBIT A

CONSENT TO USE AND REGISTER

This Agreement is made as of March 24, 2010 by and between Institute for Justice, a non-profit corporation organized under the laws of the District of Columbia having an address at 901 N. Glebe Road, Suite 900, Arlington, Virginia 22203 (“Institute for Justice”) and Intrum Justitia Licensing AG, a corporation organized under the laws of Switzerland having an address at Alpenstrasse 2, CH-6300, Zug, Switzerland (“Intrum Justitia Licensing”).

Institute for Justice is a libertarian public interest law firm that engages in litigation and advocacy to secure economic liberty, school choice, private property rights, freedom of speech and other vital individual liberties, and to restore constitutional limits on the power of government. Institute for Justice is the owner of the following issued registration and pending trademark applications in the United States Patent and Trademark Office (“Institute for Justice marks”):



- **INSTITUTE FOR JUSTICE CLINIC ON ENTREPRENEURSHIP** (IJ INSTITUTE FOR JUSTICE CLINIC ON ENTREPRENEURSHIP & Design) - Reg. No. 2,365,966 for “public interest legal services” in International Class 42, registered July 11, 2000;



- **INSTITUTE for JUSTICE** (IJ INSTITUTE FOR JUSTICE & Design) - Ser. No. 77,618,391 for “promoting public awareness through outreach and communication efforts of the need for protection of individual liberties” in International Class 35; “education services, namely, training policy activists, lawyers, law students and others to identify, and bring to public attention, issues and cases in which individual liberties are threatened and to determine the appropriate means for redress; educational research services in the area of individual liberties and social affairs; publication of documents in the fields of individual liberties, public law and social affairs” in International Class 41; and “providing public interest legal services focused on the protection of individual liberties; legal research in the area of public law” in International Class 45, filed November 20, 2008; and



- **IJ** (IJ & Design)- Ser. No. 77,615,419 for “promoting public awareness through outreach and communication efforts of the need for protection of individual liberties” in International Class 35; “education services, namely, training policy activists, lawyers, law students and others to identify, and bring to public attention, issues and cases in which individual liberties are threatened and to determine the appropriate means for redress; educational research services in the area of individual liberties and social affairs; publication of documents in the fields of individual liberties, public law and social affairs” in International Class 41; and “providing public interest legal services focused on the protection of individual liberties; legal research in the area of public law” in International Class 45, filed November 17, 2008.

Intrum Justitia Licensing is an affiliated company of Intrum Justitia, which provides credit management services, debt recovery and collection services, and related services to businesses. Intrum Justitia Licensing is the owner of the following pending trademark application in the United States Patent and Trademark Office (“Intrum Justitia Licensing mark”):



- **IJ** (IJ & Design) – Ser. No. 79,059,028 for “advertising; business management; business operation, business administration and office functions” in Class 35; “insurance services, namely,

insurance consultation services; financial affairs, namely, financial analysis services, debt recovery and collection agency services, credit inquiry and consultation services; monetary affairs, namely, cash management services; real estate consultation” in Class 36; “education services, namely, providing of training, classes, and seminars in the field of credit management and debt recovery and collection” in Class 41; and “legal services; security consultation services in the field of protection of property and individuals” in Class 42.

Institute for Justice and Intrum Justitia Licensing each intend to continue use of their respective marks in association with the services specified above.

Intrum Justitia Licensing has requested that Institute for Justice consent to use and registration of the Intrum Justitia Licensing mark in connection with the foregoing services based on its belief that no likelihood of confusion will result from concurrent use and registration of the Intrum Justitia Licensing mark and the Institute for Justice marks.

Institute for Justice has requested that Intrum Justitia Licensing consent to use and registration of the Institute for Justice marks in connection with the foregoing services based on its belief that no likelihood of confusion will result from concurrent use and registration of the Institute for Justice marks and the Intrum Justitia Licensing mark.

Institute for Justice and Intrum Justitia Licensing have considered the respective requests, and have determined that no likelihood of confusion will result from concurrent use and registration of the Institute for Justice marks and the Intrum Justitia Licensing mark because the respective marks are used in different fields and through different channels of trade; the marks are sufficiently different in overall sound, meaning and appearance to enable the public to distinguish the marks; and the nature of the services offered by the parties under the respective marks are distinctly different and unlikely to be considered derived from the same source.

The parties are aware of no instances of consumer confusion arising from concurrent use of the Institute for Justice marks and Intrum Justitia Licensing mark in connection with the parties’ respective services.

NOW, THEREFORE, in consideration of the mutual covenants, agreements and obligations set forth below, and other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the parties, intending to be legally bound, agree as follows:

1. Institute for Justice hereby consents to Intrum Justitia Licensing’s use and registration of the Intrum Justitia Licensing mark in connection with the services set forth above, and agrees that it will take no action to interfere with the use or registration of the Intrum Justitia Licensing mark in connection with such services.

2. Intrum Justitia Licensing hereby consents to Institute for Justice’s use and registration of the Institute for Justice marks in connection with the services set forth above, and agrees that it will take no action to interfere with the use or registration of the Institute for Justice marks in connection with such services.

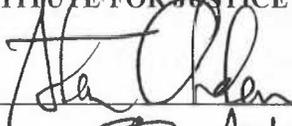
3. In order to ensure that likelihood of confusion is precluded, the parties also agree that neither will in any way attempt to associate itself with the other party or its services.

4. Should confusion arise as a result of the parties’ use of their respective marks, the party first learning of such confusion will immediately notify the other party of such confusion. The parties

agree that in the event of such confusion, they will work together promptly to eliminate confusion in the marketplace.

IN WITNESS WHEREOF, the parties have duly executed, sealed and delivered this Amendment as of the day and year first above written.

INSTITUTE FOR JUSTICE



Print Name: Stefan Andersson
Title: CEO/Treasurer
Date: 3/24/10

INTRUM JUSTITIA LICENSING AG

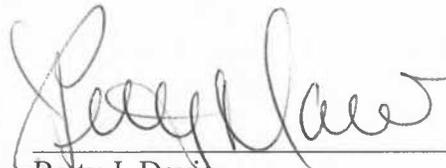
Print Name: G. Wassink E. Yasar
Title: Member of BoD Member of BoD
Date: 24.03.2010 24.03.2010

CERTIFICATE OF SERVICE

I hereby certify that a copy of the PETITION FOR PARTIAL CANCELLATION
by causing a copy thereof to be sent via first-class mail, postage pre-paid to the
following:

Scott Greenberg
Senior Counsel
Locke Lord LLP
Three World Financial Center
New York, New York 10281

This 1ST day of December, 2015


Betty J. Davis