

ESTTA Tracking number: **ESTTA737683**

Filing date: **04/04/2016**

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

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|---------|--|-------------|----------|
| Name | Discover Financial Services | | |
| Entity | Corporation | Citizenship | Delaware |
| Address | 2500 Lake Cook Road Riverwoods, IL 60015 UNITED STATES | | |

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|----------------------|---|--|--|
| Attorney information | Deborah K. Squiers Cowan, Liebowitz & Latman, P.C. 114 West 47th St. New York, NY 10036 UNITED STATES tjb@cll.com, dks@cll.com, fxm@cll.com, trademark@cll.com | | |
|----------------------|---|--|--|

Registration Subject to Cancellation

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|-----------------|---|-------------------|------------|
| Registration No | 3941491 | Registration date | 04/05/2011 |
| Registrant | Millhiser-Smith Agency, Inc. 3100 Oakland Road NE Cedar Rapids, IA 52406 UNITED STATES | | |

Goods/Services Subject to Cancellation

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| Class 036. First Use: 2010/11/01 First Use In Commerce: 2010/11/01 All goods and services in the class are cancelled, namely: Consulting and information concerning insurance |
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Grounds for Cancellation

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| Other | Please see attached pleading. |
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| Attachments | PETITION TO CANCEL - DISCOVERISK.pdf(90931 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 | /Timothy J. Buckley/ |
| Name | Timothy J. Buckley |
| Date | 04/04/2016 |

the services of “consulting and information concerning insurance” in International Class 36 (“Registrant’s DISCOVERISK Registration”).

4. Upon information and belief, Registrant did not use Registrant’s DISCOVERISK Mark in commerce prior to October 12, 2009.

5. Since long prior to October 12, 2009, Discover Financial Services, its affiliated and related entities and/or predecessors (collectively referred to hereinafter as “Petitioner”) have used the mark DISCOVER, alone and in connection with other words and designs (“Petitioner’s Marks”), in connection with a variety of goods and services, including, but not limited to banking services, credit, debit and payment card services, insurance services and related goods and services.

1. Petitioner owns U.S. federal registrations and applications for Petitioner’s Marks, including Registration Nos. 1,479,946, 1,620,369, 1,714,156, 1,746,063, 2,501,064, 2,658,527, 2,743,341, 3,025,822, 3,047,936, 3,047,967, 3,090,532, 3,760,567, 4,211,365, 4,280,808, 4,502,778, 4,555,090, 4,571,330, 4,689,411, 4,741,770, 4,817,488 and Application Serial No. 86/743439.

6. Since long prior to October 12, 2009, Petitioner has promoted and advertised the sale and distribution of such services and goods bearing or offered in connection with Petitioner’s Marks, and has rendered such services and offered and sold such goods in commerce.

7. As a result of the sales and promotion of such services and goods bearing or offered in connection with Petitioner’s Marks, Petitioner has built up highly valuable goodwill in Petitioner’s Marks, and said goodwill has become closely and uniquely identified and associated with Petitioner.

8. The services covered by the Registrant's DISCOVERISK Registration are identical and/or closely related to the services rendered and goods offered in connection with Petitioner's Marks.

9. Registrant's DISCOVERISK Mark so resembles Petitioner's Marks as to be likely, when used in connection with Registrant's services, to cause confusion, to cause mistake, and to deceive the trade and public, who are likely to believe that Registrant's services have their origin with Petitioner and/or that such services are approved, endorsed or sponsored by Petitioner or associated in some way with Petitioner. Petitioner would thereby be injured unless Registrant's DISCOVERISK Registration is cancelled.

WHEREFORE, Petitioner respectfully requests that its cancellation action be sustained and that the registration be cancelled.

Please recognize as attorneys for Petitioner in this proceeding Deborah K. Squiers, Esq. and Timothy Buckley, Esq., members of the bar of the State of New York, and the firm of Cowan, Liebowitz & Latman, P.C., 114 West 47th Street, New York, NY 10036.

Dated: New York, New York
April 4, 2016

Respectfully submitted,
COWAN, LIEBOWITZ & LATMAN, P.C.
Attorneys for Petitioner

By: _____/Deborah K. Squiers/
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