

ESTTA Tracking number: **ESTTA776021**

Filing date: **10/11/2016**

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**

Name	James Avery Craftsman, Inc.		
Entity	Corporation	Citizenship	Texas
Address	P.O. Box 291367 Kerrville, TX 78029 UNITED STATES		

Attorney information	J. Daniel Harkins Dykema Gossett PLLC 112 East Pecan Street, Suite 1800 San Antonio, TX 78205 UNITED STATES dharkins@dykema.com, swilson@dykema.com, ipdocket@dykema.com Phone:210-554-5500		
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**Registration Subject to Cancellation**

Registration No	5000445	Registration date	07/12/2016
Registrant	Mel Bernie and Company, Inc. 3000 W. Empire Avenue Burbank, CA 90504 UNITED STATES		

**Goods/Services Subject to Cancellation**

Class 014. First Use: 2015/05/01 First Use In Commerce: 2015/05/01 All goods and services in the class are cancelled, namely: Jewelry
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**Grounds for Cancellation**

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
The mark is merely descriptive	Trademark Act Sections 14(1) and 2(e)(1)
The mark is or has become generic	Trademark Act Section 14(3), or Section 23 if on Supplemental Register

Related Proceedings	92064004
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**Mark Cited by Petitioner as Basis for Cancellation**

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	SYMBOLS OF FAITH		

Goods/Services	Retail jewelry store services, jewelry, and other related goods and services.
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Attachments	2016-10-11 FINAL Petition to Cancel Reg No 5000445 4823-6159-4170 v.1.pdf(14158 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	/Sherri A. Wilson/
Name	Sherri A. Wilson
Date	10/11/2016

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

In the Matter of Registration No. 5,000,445  
For the mark: SYMBOLS OF FAITH  
Date registered: July 12, 2016

JAMES AVERY CRAFTSMAN, INC.	)	
	)	
Petitioner,	)	
	)	Cancellation No. _____
v.	)	
	)	
MEL BERNIE AND COMPANY, INC.	)	
	)	
Respondent.	)	

PETITION TO CANCEL

James Avery Craftsman, Inc. (“Petitioner”) believes that it is or will be damaged by the registration of the alleged mark SYMBOLS OF FAITH on the Supplemental Register for jewelry in Registration No. 5,000,445, and hereby petitions to cancel under Section 14 of the Trademark Act of 1946, as amended, 15 U.S.C. §1064.

The grounds for the cancellation are as follows:

1. Petitioner James Avery Craftsman, Inc. is a Texas corporation, having its business address at P.O. Box 291367, Kerrville, Texas 78029.
2. Mel Bernie and Company, Inc. (“Respondent”) in a California corporation, having its correspondence address at 3000 W. Empire Avenue, Burbank, California 90504.
3. On January 25, 2016, Respondent filed U.S. Trademark Application Serial No. 86/886,026 ( “Respondent’s Application”).
4. On July 12, 2016, Respondent’s Application issued on the Supplemental Register as Registration No. 5,000,445 (the “Registration”).

5. The Registration is for the alleged mark SYMBOLS OF FAITH consisting of stylized words “SYMBOLS OF FAITH” in a semi-circle in International Class 14 for “jewelry” (“Respondent’s Goods”).

6. The Respondent filed Respondent’s Application under actual use provisions of Section 1(a) of the Trademark Act of 1946, as amended, 15 U.S.C. §1051, alleging a first use date of at least as early as May 1, 2015, and a first use in commerce date of at least as early as May 1, 2015.

7. On May 17, 2016, the examiner issued an Examiner’s Amendment and, with authorization from the Respondent’s attorney of record, amended the Respondent’s Application to the Supplemental Register.

8. The Registration is for the mark SYMBOLS OF FAITH, which consists of the stylized words “SYMBOLS OF FAITH” in a semi-circle (“Respondent’s Mark”).

9. There are no known assignments recorded with the United States Patent and Trademark Office (“USPTO”) or claimed in the Respondent’s Application.

10. For all asserted grounds and bases, Petitioner timely files this Petition to Cancel.

11. Petitioner seeks cancellation of the Registration in whole.

12. Petitioner has been in the jewelry business in the United States since 1954. Since its inception, Petitioner has designed, manufactured, marketed, and sold jewelry in the United States. In 1957, Petitioner mailed its first catalog comprised solely of jewelry depicting symbols of the Christian faith. Since the early 1980s, Petitioner has continuously used the term “symbols of faith” both in describing its goods or in identification of particular goods. For example, in 1982, Petitioner’s catalog included a line of jewelry under the title “SYMBOLS OF FAITH and LOVE.” Petitioner also produced and sold a line of jewelry in 2011 under the title “SYMBOLS OF FAITH” through its website [www.jameavery.com](http://www.jameavery.com) and catalog titled “SYMBOLS OF

FAITH”. To date, Petitioner has continued to design, manufacture, market, and sell jewelry depicting symbols of faith, along with other types of jewelry, and has continuously used the terms “symbols of faith” both in describing its jewelry or in identification of particular jewelry.

13. The terms “symbols of faith” are extensively used in the jewelry industry to describe products being offered for sale to the public. The terms “symbols of faith” are generic and/or merely descriptive when referring to jewelry products. Countless products are currently offered for sale by jewelry stores that utilize the terms “symbols of faith” to describe the jewelry product being offered for sale. No one is entitled to exclusive rights to use the terms “symbols of faith” when describing a jewelry product.

14. “Symbols of faith” is not capable of distinguishing Respondent’s Goods pursuant to Section 23 of the Trademark Act of 1946, as amended, 15 U.S.C. § 1091, because it is a generic term for Respondent’s Goods.

15. “Symbols of faith” is not capable of distinguishing Respondent’s Goods pursuant to Section 23 of the Trademark Act of 1946, as amended, 15 U.S.C. § 1091, because it is so highly descriptive of a type of jewelry product that it is incapable of acquiring distinctiveness as a trademark.

16. Petitioner and others in the jewelry industry have a present and prospective right to use the term “symbols of faith” generically and/or descriptively in their business.

17. Respondent did not use Respondent’s Mark in the United States prior to May 1, 2015, the date of first use and the date of first use in commerce alleged in Respondent’s Application.

18. Petitioner started using the terms “symbols of faith” to describe jewelry products being sold or offered for sale by Petitioner well before the alleged date of first and the date of first use in commerce alleged in Respondent’s Application.

19. The goods of Petitioner are the same as the Respondent's Goods and are in the same channels of trade as Respondent.

20. Petitioner has developed extensive goodwill in its market area for its products, which are described as being "symbols of faith." Petitioner has spent considerable sums of money in advertising and promoting its products by the descriptive terms "symbols of faith".

21. If anyone can develop superior rights in the terms "symbols of faith" for jewelry products, Petitioner, as the first user, has superior rights to those of Respondent.

22. If Respondent is permitted to maintain its Registration, after a period of five years, the Respondent may file an application for registration of the Respondent's Mark on the Principal Register and, five years later, have it deemed incontestable. Respondent would thereby obtain an incontestable right to use the mark SYMBOLS OF FAITH in commerce. In any event, the continued existence of a registration for the mark SYMBOLS OF FAITH casts a cloud upon Petitioner's rights to continue to use the descriptive terms "symbols of faith" to describe its jewelry. Such continued registration by Respondent is or will be a source of continuing damage and injury to Petitioner.

23. The business and goodwill of Petitioner is or will be damaged if Respondent is permitted to maintain its Registration because any statutory rights that may be created or maintained due to the Registration would be in violation and derogation of the established rights of Petitioner.

24. For at least the reasons set forth above, Respondent's Mark is not registrable pursuant to Section 23 of the Trademark Act of 1946, as amended, 15 U.S.C. § 1091, and the Registration should be cancelled.

WHEREFORE, Petitioner believes that it is or will be damaged by the registration on the Supplemental Register of the alleged mark SYMBOLS OF FAITH for jewelry in Registration

No. 5,000,445 and respectfully requests that this petition to cancel be sustained and the Registration be cancelled in whole pursuant to Sections 14 and 18 of the Trademark Act of 1946, as amended, 15 U.S.C. §§ 1064, 1068.

Dated: October 11, 2016

/Sherri A. Wilson/  
J. Daniel Harkins (Texas Bar No. 09008990)  
Sherri Wilson (Texas Bar No. 24075291)  
DYKEMA GOSSETT PLLC  
112 E. Pecan Street, Suite 1800  
San Antonio, Texas 78205  
Tel: (210) 554-5500  
Fax: (210) 226-8395  
Email: dharkins@dykema.com  
swilson@dykema.com

Attorneys for Petitioner James Avery Craftsman,  
Inc.

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the foregoing Petition to Cancel has been sent to the owner of record for the registration and the attorney of record for the registration by first class mail on this the 11th day of October, 2016.

Mel Bernie and Company, Inc.  
3000 W. Empire Avenue  
Burbank, California 90504

Marvin Gelfand  
Weintraub Tobin Chediak Coleman Grodin  
9665 Wilshire Boulevard, Ninth Floor  
Beverly Hills, California 90212

/Sherri A. Wilson/  
Sherri A. Wilson