

ESTTA Tracking number: **ESTTA496810**

Filing date: **09/26/2012**

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

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	T. JOHN WARD, JR., P.C. d/b/a Ward & Smith Law Firm
Granted to Date of previous extension	09/26/2012
Address	1127 Judson Rd., Ste. 220 Longview, TX 75601 UNITED STATES

Attorney information	Chelsea Davis Chelsea Davis P.C. 25 Highland Park Vlg., Ste. 100-830 Dallas, TX 75205 UNITED STATES cdavis@chelseadavispc.com Phone:214-884-8723
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**Applicant Information**

Application No	85457915	Publication date	05/29/2012
Opposition Filing Date	09/26/2012	Opposition Period Ends	09/26/2012
Applicant	Ward and Smith, P.A. 1001 College Court New Bern, NC 28562 UNITED STATES		

**Goods/Services Affected by Opposition**


Class 045. First Use: 1972/12/27 First Use In Commerce: 1972/12/27 All goods and services in the class are opposed, namely: legal services
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**Grounds for Opposition**

False suggestion of a connection	Trademark Act section 2(a)
Consists of or comprises a name, portrait, or signature of a living individual without written consent, or the name, portrait, or signature of a deceased president without the written consent of the surviving spouse	Trademark Act section 2(c)
Priority and likelihood of confusion	Trademark Act section 2(d)
The mark is merely descriptive	Trademark Act section 2(e)(1)
The mark is deceptively misdescriptive	Trademark Act section 2(e)(1)
The mark is primarily geographically descriptive	Trademark Act section 2(e)(2)
The mark is primarily geographically deceptively	Trademark Act section 2(e)(3)

misdescriptive	
The mark is primarily merely a surname	Trademark Act section 2(e)(4)
The mark comprises matter that, as a whole, is functional	Trademark Act section 2(e)(5)
Dilution	Trademark Act section 43(c)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Genericness	Trademark Act section 23

### Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	85667924	Application Date	07/03/2012
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	WARD AND SMITH LAW FIRM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 2007/05/01 First Use In Commerce: 2007/05/01 Legal services		

Related Proceedings	85667924, 85461077
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Attachments	85667924#TMSN.jpeg ( 1 page )( bytes ) NoticeofOpposition2.pdf ( 8 pages )(116912 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	/chelsea davis/
Name	Chelsea Davis
Date	09/26/2012

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

In the matter of trademark application Serial No. 85457915 for the mark WARD & SMITH, P.A. published in the Official Gazette on MAY 29, 2012.

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T. JOHN WARD, JR., P.C. d/b/a WARD & SMITH LAW FIRM

v.

WARD & SMITH, P.A.

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**NOTICE OF OPPOSITION**

Opposer, T. John Ward, JR., P.C. d/b/a Ward & Smith Law Firm, (hereinafter referred to as “Opposer”) with a place of business at 1127 Judson Rd., Ste. 220, Longview, TX 75601, United States, is a corporation organized under the laws of Texas. Opposer respectfully believes that it will be damaged by the registration of the mark shown in the above-identified application, and, after receiving two extensions of time to file a notice of opposition, hereby opposes the same for the goods and services described as legal services in International Class 42.

Opposer has applied for a registered trademark by filing currently pending Trademark Application Serial Number 85667924 for the mark WARD AND SMITH LAW FIRM for the goods and services described as legal services in International Class 42. Opposer has a reasonable belief that registration of its application will be refused because of Applicant’s registration. *See* Letter of Protest Memorandum concerning Trademark Application Serial Number 85667924 dated August 31, 2012; *see also* TBMP 309.03(b).

The grounds for opposition are as follows:

1. T. John Ward, Jr., P.C. was formed on May 1, 2007 and began providing legal services under the name Ward & Smith Law Firm at that time. The Ward & Smith Law Firm has offices in Longview and Tyler, Texas. As described on the Ward & Smith Law Firm's website, located at <http://www.wsfirm.com/>, the Ward & Smith Law Firm offers the combined experience of six attorneys, including board certified trial attorneys. Longview, Texas-based Ward & Smith Law Firm has earned a national reputation in high-stakes cases involving complex commercial litigation, intellectual property law, oil and gas disputes, and serious personal injury claims. Ward & Smith frequently assists lawyers nationwide in complex cases before East Texas juries. Notable attorneys Bruce Smith, Johnny Ward and the Honorable T. John Ward practice at the Ward & Smith Law Firm. The Honorable T. John Ward served as United States District Judge for the Eastern District of Texas from September 24, 1999 until his retirement from the bench on October 1, 2011. Judge Ward was profiled in the Fall 2010 Intellectual Property supplement to American Lawyer Magazine and was selected as one of the Top 25 Most Influential People in Intellectual Property. Applicant's mark would dilute the distinctive quality of the Ward & Smith Law Firm's famous marks, proprietary rights and trade name associations, including those registered and those used in commerce.

2. The Ward & Smith Law Firm continues to provide legal services under the name Ward & Smith Law Firm to clients throughout the United States. For example, the Ward & Smith Law Firm represents large national law firms and assists lawyers nationwide in complex cases before East Texas juries. Clients and potential clients of the legal services provided by notable attorneys Bruce Smith, Johnny Ward and the Honorable T. John Ward call upon the Ward & Smith Law Firm to contact these attorneys. Since 1969, clients of T. John Ward have looked for the name Ward to contact him for his legal services, as he has provided legal services using his

name since he began practicing law in 1967 and founded Ward & Ross in 1969. In addition to any one or more state and/or common law rights and trade name associations, T. John Ward, Jr., P.C.'s application for a registered trademark by filing currently pending Trademark Application Serial Number 85667924 for the mark WARD AND SMITH LAW FIRM for the goods and services described as legal services in International Class 42 is valid, unrevoked and uncanceled. Use has been continuous and not abandoned. Opposer pleads likelihood of confusion directly and/or hypothetically. Under Section 2(d) of the Act, 15 U.S.C. § 1052(d), plaintiff may have grounds for opposition where "defendant's mark so resembles a mark registered in the Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods or services of the defendant, to cause confusion, or to cause mistake, or to deceive." *Id.*

3. Attorney Bruce Smith was licensed to practice law by the State of Texas in 1986. In 1992, Mr. Smith became board certified in personal injury trial law. In order to qualify to become board certified, a lawyer is required to have a minimum of five years of legal experience with a required number of actual trials. Mr. Smith qualified to sit for the board certification examination immediately upon completion of his fifth year of practice and passed the written examination at the first opportunity offered by the State Bar upon being qualified to sit for the examination. He has been re-certified in 1997, 2002 and 2007. The distinction of board certification in personal injury trial law is held by fewer than three percent of licensed attorneys. Mr. Smith was further recognized and selected by his peers to the Texas Super Lawyers list in 2008, 2009 and 2010, and he maintains a national attorney peer rating. Mr. Smith has also been admitted to practice law in the U.S. District Court for the Eastern District of Texas at least as early as 1987, the U.S. District Court for the Northern District of Texas at least as early as 1992,

the U.S. Court of Appeals for the Fifth Circuit at least as early as 1987, and the U.S. Court of Federal Claims at least as early as 1990.

4. Attorney T. John “Johnny” Ward Jr. was licensed to practice law by the State of Texas in 1995. Mr. Johnny Ward has proven to be a zealous representative for clients involved in intellectual property disputes, complex commercial litigation, automobile accidents, and wrongful death claims. He has served as the lead trial attorney in more than thirty jury trials, securing courtroom victories against some of the world’s most recognizable companies. He is a Fellow of the American College of Trial Advocates and a Fellow of the American College of Trial Lawyers. The invitation-only American College of Trial Lawyers (“ACTL”) is an honorary association of experienced courtroom attorneys who have mastered the art of advocacy and whose professional careers have been marked by the highest standards of ethical conduct, professionalism, civility and collegiality. Mr. Ward has also been admitted to practice law in the U.S. District Court for the Eastern District of Texas, the U.S. District Court for the Northern District of Texas, the U.S. Court of Appeals for the Fifth Circuit, and U.S. Court of Appeals for the Fifth Circuit.

5. The Honorable T. John Ward was licensed to practice law in 1967 and started the law firm of Ward & Ross in 1969. He served as a United States District Judge for the Eastern District of Texas from September 24, 1999 until his retirement October 1, 2011. While serving as federal judge, he presided over one-hundred and fifty jury trials and managed a docket resulting in the final disposition of over three thousand civil cases. Judge Ward spent thirty-one years as an active trial lawyer, trying over two-hundred and fifty cases to jury verdict throughout Texas. At the time of his appointment by President Clinton, in addition to being licensed in Texas, Judge Ward was admitted to practice before the U.S. Supreme Court, the U.S. Court of

Appeals for the 5th Circuit, as well as the Eastern, Northern, Southern, and Western Districts of Texas.

6. Accordingly, Opposer T. John Ward, Jr., P.C. has numerous grounds for opposition to oppose Applicant's above-identified mark. The above-identified mark falsely suggests a connection with T. John Ward, Jr., P.C.'s name and identity. The above-identified mark falsely suggests a connection with T. John Ward's name and identity. The above-identified mark falsely suggests a connection with T. John Ward Jr.'s name and identity. The above-identified mark uses the names of particular living individuals without the individuals' consent. The above-identified mark has not acquired distinctiveness for legal services as an indication of the source of Applicant's goods and services. The above-identified mark would dilute the distinctive quality of the Ward & Smith Law Firm's famous mark, which acquired fame prior to the filing date of the above-identified mark. The above-identified mark, when used on or in connection with the goods or services of the Applicant, is merely descriptive or deceptively misdescriptive of them, or is primarily geographically descriptive or primarily geographically deceptively misdescriptive of them; and the above-identified mark is primarily merely a surname or a phantom mark. *See* Section 2(e) of the Act, 15 U.S.C. § 1052(e).

7. Applicant does not intend to use WARD & SMITH P.A., which is the actual mark for which Applicant has applied, in connection with the goods and services listed. Rather, applicant intends to use WARD & SMITH or WARD & SMITH in conjunction with LAW FIRM in connection with legal services and/or other goods and services in International Class to which Applicant has applied or intends to apply. Accordingly, Applicant's product design, including its website and offering of legal services, is generic.

8. Applicant's mark or marks registered or in use in commerce may be abandoned due to nonuse; or due to a course of conduct that has caused the mark to lose significance as an indication of source.

9. Opposer T. John Ward, Jr. P.C. and any or all of its shareholders individually or collectively may have prior or superior proprietary rights such that it has a legitimate interest in preventing a likelihood of confusion and/or actual confusion between Applicant's mark and Opposer's marks in either the USPTO or at common law. The name Ward alone and Judge Ward's name and identity and that of the Ward & Smith Law Firm are famous as they relate to legal services and goods and services provided in conjunction with or in addition to legal services in International Class 42 or any other class, or related or complementary classes of services or products. These assets are valuable to Opposer and demonstrate the vast amount of goodwill that Opposer has acquired by providing legal services, advertising and marketing those legal services, serving the community over the years, and being recognized for the same by various associations, peer-ratings and court and bar admissions and honors.

WHEREFORE, Opposer respectfully requests that registration be denied and award costs and such further relief to Opposer which the Board finds Opposer is entitled under law or equity.



Respectfully Submitted on September 26, 2012 by:

/Chelsea Davis/

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**CERTIFICATE OF SERVICE**

I hereby certify that on this 26th day of September, 2012, a copy of this Notice of Opposition was served via Express Mail in an envelope with sufficient postage addressed to the Applicant of Record.

By: /Chelsea Davis/  
Chelsea Davis

Date: September 26, 2012