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

Proceeding	91222886
Party	Plaintiff Signum, LLC and NaturaLawn of America, Inc.
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Date	03/01/2016
Attachments	TTAB - Mot to Suspend for Civil Action.pdf(13600 bytes) Complaint and Ex 1.pdf(303284 bytes)

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

SIGNUM, LLC and
NATURALAWN OF AMERICA, INC.
Opposers,

v.

NATURESCAPE, INC.,
Applicant.

Opposition No. 91222886

Serial No: 86521202

Mark: NATURE'SLAWN

OPPOSERS' MOTION TO SUSPEND FOR CIVIL ACTION

Opposers Signum, LLC and NaturaLawn of America, Inc. (collectively, "Opposers") hereby move for an Order suspending this Opposition pending the disposition of Civil Action No. 1:16-cv-0560, *Signum, LLC and NaturaLawn of America, Inc. v. Naturescape, Inc.*, filed in the District Court for the Northern District of Georgia.

In their Notice of Opposition (Dkt. No. 1), Opposers alleged that Applicant's use and registration of the mark NATURE'SLAWN for lawn care services would create a likelihood of confusion with their federally-registered NATURLAWN and NATURALAWN marks, which Opposers had used for several decades in connection with lawn care services.

Similarly in the Georgia civil action, Opposers alleged that Applicant's use of NATURE'SLAWN for lawn care services infringes Opposers' NATURLAWN and NATURALAWN marks, which Opposers have used for lawn care services for over 27 years. A copy of Opposers' Complaint is attached. Opposers request that this Opposition be suspended because the pending civil action bears on the issues involved in this proceeding, including the likelihood of confusion between Opposers' marks and Applicant's applied-for mark for the applied-for services.

Dated: March 1, 2016

**Signum, LLC and NaturaLawn of
America, Inc.**

By _____/s/

John J. Dabney

Katie Bukrinsky

McDermott Will & Emery LLP

500 North Capitol Street

Washington, DC 20001

Attorneys for Opposers

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on March 1, 2016, a copy of this paper has been served upon counsel for Applicant, by email per the parties' agreement, at the following address:

Joe Kromholz
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Respectfully submitted,

 /Katie Bukrinsky/
Katie Bukrinsky
Attorney for Opposers

FILED IN CLERK'S OFFICE
U.S.D.C. - Atlanta

FEB 23 2016

UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF GEORGIA

JAMES N. HATTEN, Clerk
By: *[Signature]*
Deputy Clerk

SIGNUM, LLC and)
NATURALAWN OF AMERICA,)
INC.,)
)
Plaintiffs,)
)
v.)
)
NATURESCAPE, INC.,)
)
Defendant.)

CIVIL ACTION

FILE NO. _____

1:16-CV-0560

COMPLAINT

Plaintiffs Signum, LLC and NaturaLawn of America, Inc. (collectively, "Plaintiff") bring this action against Defendant Naturescape, Inc. ("Defendant"), and allege as follows:

1.

Plaintiff is a leading, franchised lawn care business. For over 27 years, Plaintiff and its franchises have operated under a family of NATURALAWN-formative marks, including NATURLAWN and NATURALAWN. Plaintiff has long owned federal trademark registrations for NATURLAWN and NATURALAWN for lawn care services. Plaintiff has over 70 franchisees in 23 states, and consumers and others in the trade have long associated NATURLAWN

and NATURALAWN exclusively with lawn care services offered by Plaintiff. Plaintiff has had franchisees in Georgia in the past, and in the Atlanta market specifically, and is currently negotiating with potential franchisees to re-open in the Atlanta, Georgia area.

2.

Defendant is a lawn care business that typically operates under the name NATURESCAPE. Recently, however, Defendant opened a lawn care business in the Atlanta, Georgia area under the name NATURE'SLAWN, instead of NATURESCAPE.

3.

Defendant's new mark NATURE'SLAWN is confusingly similar in sight, sound, and meaning to Plaintiff's federally registered marks NATURLAWN and NATURALAWN. Plaintiff requested that Defendant cease use of NATURE'SLAWN, but Defendant refused. Plaintiff has lost control of the goodwill in its NATURLAWN and NATURALAWN marks and Defendant's infringing mark is interfering with Plaintiff's ability to open a franchise in the Atlanta, Georgia area.

THE PARTIES

4.

Plaintiff Signum, LLC (“Signum”) is a Maryland limited liability company with its principal place of business in Frederick, Maryland. Plaintiff NaturaLawn of America, Inc. (“NLA”) is a Maryland corporation with its principal place of business in Frederick, Maryland. Plaintiffs have the same owners and the business address. Signum owns the trademarks asserted by Plaintiffs in this case, including NATURLAWN and NATURALAWN, and licenses those marks to NLA, who in turn uses the marks itself or sublicenses them to franchisees. Collectively, Signum and NLA are referred to as “Plaintiff.”

5.

Defendant Naturescape, Inc. is a Wisconsin corporation with its principal place of business in Muskego, Wisconsin. Defendant recently commenced offering lawn care services in the Atlanta, Georgia area under the mark NATURE’S LAWN.

JURISDICTION AND VENUE

6.

Plaintiff asserts claims for trademark infringement, false designation of origin and unfair competition arising under federal and state law. The Court has

subject matter jurisdiction over the federal claims under 28 U.S.C. § 1331 and § 1338(a). The Court has subject matter jurisdiction over the state law claims under 28 U.S.C. § 1367.

7.

The Court has personal jurisdiction over Defendant because Defendant advertises and sells its services under the mark NATURE'SLAWN in Atlanta, Georgia.

8.

Venue is proper under 28 U.S.C. § 1391(b) because a substantial part of the events giving rise to the claims occurred in this district and the Court has personal jurisdiction over Defendant in this district.

FACTS GIVING RISE TO PLAINTIFF'S CLAIMS

I. Plaintiff and its NATURLAWN Marks

9.

Plaintiff is a nationwide leader in the provision of lawn care services. For over 27 years, Plaintiff has used the marks NATURLAWN and NATURALAWN (collectively, "NATURLAWN Marks") in connection with its goods and services.

10.

Plaintiff has over 70 franchises in 23 states, including in North and South Carolina, providing NATURLAWN-branded lawn care services. Plaintiff is negotiating with possible franchisees to re- open a franchise in the Atlanta, Georgia area.

11.

Plaintiff has invested many millions of dollars in advertising and promoting its services under the NATURLAWN Marks.

12.

Sales of Plaintiff's NATURLAWN-branded services are substantial. In 2015, Plaintiff and its franchisees earned over \$51 million dollars in revenues and have earned over \$300 million dollars in revenues over the past decade.

13.

Plaintiff owns Registration No. 1,414,588 for NATURLAWN and Registration No. 2,543,921 for NATURALAWN. (Ex. 1.) Plaintiff's registrations are "incontestable" under the Lanham Act and "conclusive evidence" of its "exclusive right" to use the marks for lawn care services in United States commerce. 15 U.S.C. §§ 1065, 1115(b).

14.

Plaintiff's NATURLAWN Marks have acquired significant goodwill and are widely recognized. The public associates Plaintiff's NATURLAWN Marks exclusively with lawn care services rendered by Plaintiff, and has for decades.

II. Defendant and Its Mark NATURE'SLAWN

15.

For years, Defendant has offered lawn care services in Wisconsin under the name NATURESCAPE.

16.

Defendant recently began to offer lawn care services in the Atlanta, Georgia area, but under the name NATURE'SLAWN, instead of NATURESCAPE.

17.

Defendant's NATURE'SLAWN mark is nearly identical to Plaintiff's NATURLAWN and NATURALAWN marks in sight, sound, and meaning.

18.

Plaintiff and Defendant advertise and sell lawn care services in the same channels of trade to the same class of customers and use the same advertising mediums, including the web.

19.

Defendant filed an intent-to-use application for the mark NATURE'SLAWN in the USPTO. Plaintiff opposed Defendant's application in the Trademark Trial and Appeal Board and notified Defendant of the likelihood of confusion between the parties' marks.

20.

Defendant had actual knowledge of Plaintiff's NATURLAWN Marks before proceeding to use NATURE'SLAWN. Defendant's use of NATURE'SLAWN is an attempt to trade off Plaintiff's reputation and to confuse consumers and others in the industry that Defendant is Plaintiff or a franchisee of Plaintiff.

21.

Consumers and others in the trade are likely to mistakenly believe that Defendant and Defendant's services are franchised, licensed, or approved by Plaintiff.

COUNT I

Trademark Infringement, False Designation of Origin and Unfair Competition under the Federal Lanham Act (15 U.S.C. §§ 1114 and 1125)

22.

Plaintiff incorporates the foregoing paragraphs as if fully set forth herein.

23.

Plaintiff owns federally-registered and common-law marks for NATURLAWN and NATURALAWN for lawn care services.

24.

Defendant's use of the mark NATURE'SLAWN for lawn care services is likely to cause confusion, deception and mistake that Defendant or Defendant's services are franchised or approved by or affiliated, associated or connected with Plaintiff or Plaintiff's NATURLAWN Marks. 15 U.S.C. §§ 1114(1), 1125(a).

25.

Defendant's use of the mark NATURE'SLAWN is irreparably injuring Plaintiff and unless enjoined will continue to do so.

COUNT II

Trademark Infringement and Unfair Competition under Georgia Law

26.

Plaintiff incorporates the foregoing paragraphs as if fully set forth herein.

27.

Plaintiff owns federally registered and common law marks for NATURLAWN and NATURALAWN for lawn care services.

28.

Defendant's use of the mark NATURE'SLAWN is likely to cause confusion, deception and mistake that Defendant and Defendant's services are approved by or affiliated, associated or connected with Plaintiff or Plaintiff's NATURLAWN- and NATURALAWN-branded services.

29.

Defendant's use of the mark NATURE'SLAWN is irreparably injuring Plaintiff and unless enjoined will continue to do so.

REQUEST FOR RELIEF

Plaintiff requests that the Court grant the following relief:

1. A preliminary and permanent injunction:

(a) enjoining Defendant, its principals, employees, owners, agents, officers, directors, attorneys, representatives, affiliates, subsidiaries, and successors and assigns, and all those in active concert or having knowledge of the causes of action, from using the NATURE'SLAWN mark or any confusingly similar mark or any other name or mark that infringes or unfairly competes with Plaintiff's NATURLAWN Marks;

(b) requiring Defendant to deliver up for destruction all literature, signs, billboards, labels, prints, packages, wrappers, containers, advertising materials, stationery, and other items in its possession, custody or control that contains the mark NATURE'SLAWN, pursuant to 15 U.S.C. § 1118;

(c) requiring Defendant to withdraw Application Serial No. 86521202 for NATURE'SLAWN; and

(d) requiring Defendant to file with the Court and serve on Plaintiff, within thirty (30) days after entry of an injunction, a report in writing under oath setting forth in detail the manner in which Defendant has complied with the Court's injunction.

2. Plaintiff's reasonable attorney's fees and costs; and
3. Any other and further relief as the Court deems just and necessary.

Dated: February 23, 2016

Respectfully submitted,

DAVIS, PICKREN, SEYDEL & SNEED, LLP

By: Paul R. Jordan
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Ga. Bar No. 404950
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and NaturaLawn of America, Inc.*

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EXHIBIT 1

Int. Cl.: 42

Prior U.S. Cls.: 100 and 103

United States Patent and Trademark Office **Reg. No. 1,414,588**
Registered Oct. 21, 1986

**SERVICE MARK
PRINCIPAL REGISTER**

NATURLAWN

VAN DEN TOP, MELVIN (UNITED STATES
CITIZEN), DBA NATUR LAWN
305 NORTH LEWIS
SIOUX FALLS, SD 571031571

FIRST USE 7-26-1985; IN COMMERCE
7-26-1985.

SER. NO. 588,683, FILED 3-18-1986.

FOR: LAWN CARE SERVICES, IN CLASS 42
(U.S. CLS. 100 AND 103).

MICHAEL HAMILTON, EXAMINING ATTOR-
NEY

Int. Cls.: 37 and 42

Prior U.S. Cls.: 100, 101, 103 and 106

United States Patent and Trademark Office

Reg. No. 2,543,921

Registered Mar. 5, 2002

**SERVICE MARK
PRINCIPAL REGISTER**

NATURALAWN

NATURALAWN OF AMERICA, INC. (MARY-
LAND CORPORATION)
1 EAST CHURCH STREET
FREDERICK, MD 21701

FOR: PEST CONTROL SERVICES, IN CLASS 37
(U.S. CLS. 100, 103 AND 106).

FIRST USE 7-17-1986; IN COMMERCE 7-17-1986.

FOR: LAWN CARE SERVICES, NAMELY OR-
GANIC BASED FERTILIZING AND BIOLOGICAL
WEED CONTROL SERVICES AND MECHANICAL
AND CULTURAL RENOVATION PRACTICES,

NAMELY, PROVIDING INFORMATION REGARD-
ING PLANTING NEW TURF VARIETIES, PROPER
MOWING, WATERING, AND THATCHING TECH-
NIQUES, AND PH BALANCE REQUIREMENTS, IN
CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 7-17-1986; IN COMMERCE 7-17-1986.

OWNER OF U.S. REG. NO. 1,414,588.

SER. NO. 75-901,410, FILED 1-22-2000.

BARBARA RUTLAND, EXAMINING ATTORNEY