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

Proceeding	91254566
Party	Defendant Skout Secure Intelligence LLC
Correspondence Address	BEN NATTER HAUG PARTNERS LLP 745 FIFTH AVE NEW YORK, NY 10151 UNITED STATES Primary Email: bnatter@haugpartners.com Secondary Email(s): docket@haugpartners.com, kkoemm@haugpartners.com 212-588-0800
Submission	Motion to Amend/Amended Answer or Counterclaim
Filer's Name	Ben Natter
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Signature	//Ben Natter//
Date	02/08/2021
Attachments	2.8.2021 - Mot for Leave to Am - CYBERSCOUT(1328475.1).pdf(115661 bytes) 2.8.2021 - Amended Petition for Cancellation - CYBERSCOUT(1328475.1).pdf(146021 bytes)

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

Skout Secure Intelligence LLC,	
Petitioner,	**Opposition No.:** 91254566 (parent)
v.	**Cancellation No.:** 92073775 (child)
CyberScout, LLC,	
Registrant.	

MOTION FOR LEAVE TO AMEND PLEADING

Skout Secure Intelligence LLC ("Petitioner") requests leave to amend its petition for cancellation in response to CyberScout, LLC's ("Registrant") Motion to Dismiss filed on Jan. 19, 2021. *See* Dkt. No. 20. Good cause exists to grant leave to amend under TBMP § 503.03 because Petitioner files this motion within 21 days of service of the Motion to Dismiss. Petitioner's amended petition is attached herewith.

Dated: New York, NY
February 8, 2021

Respectfully submitted,

By: /Ben Natter/

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Attorney for Applicant

CERTIFICATE OF SERVICE

I herby certify that a true copy of the foregoing was served this 8th day of February, 2021, by e-mailing a copy to Registrant's Attorney of Record, Sandra Etherton, at: trademarks@ethertonlaw.com and sandra@ethertonlaw.com as required by the Trademark Trial and Appeal Board.

By: /Ben Natter/
Ben Natter

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

Skout Secure Intelligence LLC,	
Petitioner,	
v.	**Opposition No.:** 91254566 (parent) **Cancellation No.:** 92073775 (child)
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PETITIONER'S AMENDED PETITION FOR CANCELLATION

Petitioner, Skout Secure Intelligence LLC, a New York company having an address of 270 South Service Road, Melville, NY 11747, believes that it is and will continue to be damaged by Registration No. 5,215,366 and, pursuant to 15 U.S.C. § 1064 et seq. and 37 C.F.R. § 2.111, hereby petitions to cancel the same.

As grounds for cancellation it is alleged that:

1. On August 17, 2016, Registrant, CyberScout, LLC ("Registrant"), a Delaware company, filed Application Serial No. 87/141,564 for the mark CYBERSCOUT in connection with services in classes 35, 36, 41, 42 and 45 based upon a bona fide intent to use the mark in connection with such services in commerce.

2. On May 30, 2017, Application Serial No. 87/141,564 matured into Registration No. 5,215,366 in connection with services in all of the applied for classes.

3. Based on Internet research, Registrant has never used its mark in connection with

the following services in international class 35 of its registration: "card-registration services in the nature of credit- and debit-card-notification and cancellation services for lost or stolen cards and notification services; referral services; product marketing services and consulting services in the field of product marketing."

4. Based upon Internet research, screenshots of Registrant's website demonstrate that Registrant has never used its mark in connection with the services, discussed *supra*. *See* Exhibit A (screenshots of Registrant's website from January 2017 through the present showing that Registrant did not offer the above services in international class 35).

5. Registrant has not used its mark in commerce in connection with the services listed in international class 35, namely card-registration services in the nature of credit- and debit-card-notification and cancellation services for lost or stolen cards and notification services; referral services; product marketing services and consulting services in the field of product marketing, of its registration within the past three years in the United States and based upon information and belief, Registrant does not intend resume use of the mark in connection with these services in international class 35. *See* Exhibit A.

6. Because Registrant has never used its mark in commerce in connection with the services listed in international class 35 of its registration, namely card-registration services in the nature of credit- and debit-card-notification and cancellation services for lost or stolen cards and notification services; referral services; product marketing services and consulting services in the field of product marketing, Registrant's mark is abandoned with respect to the services identified in paragraphs 3 and 5 *supra* in international class 35. *See Johnson & Johnson v. Obschestvo s Organitchennoy*, 104 U.S.P.Q.2d 2037, 2039 (T.T.A.B. 2012) (finding the pleading for abandonment for partial cancellation of goods to be "sufficiently plead[] . . . by alleging

abandonment of the mark as to particular goods through nonuse with no intent to resume use").

7. For these reasons, Petitioner requests that the Board modify the services in Registration No. 5,215,366 in international class 35 to remove the services not being used in commerce due to abandonment pursuant to Section 18 of the Lanham Act, namely, card-registration services in the nature of credit- and debit-card-notification and cancellation services for lost or stolen cards and notification services; referral services; product marketing services and consulting services in the field of product marketing.

8. Registrant alleges a likelihood of confusion with respect to Petitioner's SKOUT CYBERSECURITY mark and has opposed Petitioner's application for its mark, Application Serial No. 88/519,707.

9. Continued existence of Registration No. 5,215,366 will cause irreparable harm, injury and damage to Petitioner.

WHEREFORE, Petitioner requests that class 35 of Registration No. 5,215,366 be canceled and that this Petition for Cancellation be sustained in favor of Petitioner.

Dated: New York, NY
February 8, 2021

Respectfully submitted,

By: /Ben Natter/

Ben Natter, Esq.

Haug Partners, LLP
745 Fifth Avenue
New York, NY 10151
Tel: 212-588-0800
email:
bnatter@haugpartners.com
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Attorney for Applicant

CERTIFICATE OF SERVICE

I herby certify that a true copy of the foregoing was served this 8th day of February, 2021, by e-mailing a copy to Registrant's Attorney of Record, Sandra Etherton, at: trademarks@ethertonlaw.com and sandra@ethertonlaw.com as required by the Trademark Trial and Appeal Board.

By: /Ben Natter/
Ben Natter