

ESTTA Tracking number: **ESTTA142462**

Filing date: **05/24/2007**

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

Proceeding	92045081
Party	Defendant TTT Moneycorp Limited TTT Moneycorp Limited 2 Sloane Street GB2 Knightsbridge, London SW1X 9LA,
Correspondence Address	James L. VANA PERKINS COLE LLP 1201 THIRD AVENUE, 40TH FLOOR SEATTLE, WA 98101 UNITED STATES
Submission	Other Motions/Papers
Filer's Name	Matthew D. Schneller
Filer's e-mail	pctrademarks@perkinscoie.com, jvana@perkinscoie.com
Signature	/Matthew D. Schneller/
Date	05/24/2007
Attachments	Show cause-052407-032959PM.pdf (11 pages)(621275 bytes)

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

Money Corp.)	Petitioner
v.		
TTT Moneycorp Limited)	Registrant

Registrant's Demonstration of Cause

Cancellation No. 92045081

Registrant's Demonstration of Cause

A. The Show Cause Order.

On April 26, 2007, the Trademark Trial and Appeal Board (the "TTAB" or "Board") issued an order (the "Order") denying the parties' cross-motions for summary judgment. Prior to that date, but following the filing of registrant TTT Moneycorp Limited's ("Registrant") summary judgment motion, Registrant filed separate affidavits of continued use for Registrations No. 2,399,042 and Reg. No. 2,396,878 (each, an "Affidavit of Continued Use"), as required by Section 8 of the Lanham Act. 15 U.S.C. §1058.¹

In each Affidavit of Continued Use, Registrant deleted "issuing traveler's cheques, commodity brokerage services and banking services" (the "Deleted Services"), as neither mark remained in use for the Deleted Services. The Board has now ordered Registrant to show cause under 37 C.F.R. §2.134 as to why judgment should not be entered for petitioner Money Corp. ("Petitioner") as to the Deleted Services. Order at p. 4-5.

¹ In its Order of April 26, 2007, the Board stated that Registrant failed to file a Section 8 affidavit for Registration No. 2,396,878. Order at p. 4. Registrant did file this affidavit, deleting the same services as from Registration No. 2,399,042; the affidavit was hand-delivered to and accepted by the United States Patent & Trademark Office on April 24, 2007. A copy of the accepted document, now also available on TDR, is attached as Appendix A. Since the Section 8 affidavit for Reg. No. 2,396,878 was timely filed, Registrant will treat the order to show cause as excluding Registrant's "foreign currency services" in that registration, rather than applying to the entire description of services.

B. Applicable Law

37 C.F.R. §2.134(b) states that

[a]fter the commencement of a cancellation proceeding, if it comes to the attention of the [TTAB] that the respondent has permitted his involved registration to be cancelled under Section 8 . . . , an order may be issued allowing respondent a set time . . . in which to show cause why such cancellation or failure to renew should not . . . result in entry of judgment against respondent."

In establishing the rules for entry of judgment under such circumstances, the Board elaborated on circumstances that would constitute good cause. Specifically, the Board noted that

[i]f respondent submits a showing that the cancellation or expiration was occasioned by the fact that its registered mark had been abandoned and that such abandonment was not made for purposes of avoiding the proceeding but rather was the result, for example, of a two-year period of nonuse which commenced well before respondent learned of the existence of the proceeding, judgment will be entered against it only and specifically on the ground of abandonment.

Response to Comments, Trademark Rule 2.134(b), Fed. Reg. 23133 (1983).

The Board applied this rule in *Marshall Field & Co. v. Mrs. Fields Cookies*, where Marshall Field Co. petitioned to cancel registrations for the marks MRS. FIELD'S CHOCOLATE CHIPPERY on the grounds of priority and abandonment. 11 U.S.P.Q.2d 1154 (T.T.A.B. 1989). To show cause, the registrant submitted a signed declaration stating that it had been phasing out the subject mark for several years, and failed to file affidavits of continued use because it could not claim continued use of the registered mark, and did not intend to resume use at that time. Considering Trademark Rule 2.134 and the comments above, the Board held that the registrant had shown cause when it "stated that use of the

registered mark has in fact been discontinued and that registrant has no present intention to resume use of such marks" for the listed goods and services. *Id.*, at 1156, 1156 n. 1. The Board entered judgment only on the single ground of abandonment, and refused to do so on likelihood of confusion grounds. *Id.* at 1156-57.

C. Registrant's Demonstration of Cause.


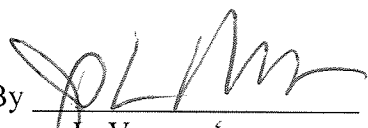
Here, the marks MONEYCORP and TTT MONEYCORP were registered pursuant to Section 44(e) of the Lanham Act, 15 U.S.C. 1144(e), which does not require use of a mark in commerce prior to registration. Instead, only a bona fide intent to use the mark in commerce (in addition to a valid foreign registration certificate) is required as a condition of U.S. federal registration. *Id.*

In fact, Registrant has at no point used either mark, MONEYCORP or TTT MONEYCORP, in commerce with any of the Deleted Services, and has had no intent, since well prior to October 20, 2005 and continuing to the present date (including at the time the Affidavits of Continued Use were filed) to use either mark in commerce with the Deleted Service. *See* Affidavit of Matthew Cook, Appendix B (the "Cook Affidavit"). As a result, Registrant was required to delete these services from its registrations under Section 8 of the Lanham Act.

The decision not to commence use of either mark in commerce with any of the Deleted Services was made for business reasons independent of Petitioner or this proceeding well prior to the October 20, 2005. *Cook Affidavit*. Under the rule in *Marshall Field*, Registrant has shown cause that judgment for Petitioner should not be entered on the ground of likelihood of confusion as to the Deleted Services. As a result, the

Board should not enter judgment in Petitioner's favor on the likelihood of confusion ground with respect to the Deleted Services.

DATED: May 24, 2007.

<p>CERTIFICATE OF SERVICE</p> <p>I hereby certify that this, Registrant's Demonstration of Cause, is being deposited with the United States Postal Service with sufficient postage as first class mail on May 24, 2007 in an envelope addressed to Vernon P. Squires at Bradley & Riley PC, 2007 First Avenue SE, P. O. Box 2804, Cedar Rapids, IA 52406-2804.</p> <p>Signature: <u></u></p> <p>Printed Name: <u>Linda L. Martin</u></p>	<p>PERKINS COIE LLP</p> <p>By <u></u></p> <p>James L. Vana Perkins Coie LLP 1201 Third Avenue, 40th Floor Seattle, Washington 98101-3099 (206) 359-3036</p> <p>Attorneys for TTT Moneycorp Limited</p>
--	---

APPENDIX A

Copy of Section 8 Affidavit for Reg. No. 2,396,878, as hand-delivered to and accepted by the United States Patent & Trademark Office on April 24, 2007.



DONALD L. DENNIS
IRA J. SCHULTZ
MALCOLM J. MACDONALD, PH.D.*
AMIR H. BEHNIA*
*MEMBER OF BAR OTHER THAN VIRGINIA

LAW OFFICES
DENNISON, SCHULTZ & MACDONALD
SUITE 105
1727 KING STREET
ALEXANDRIA, VIRGINIA 22314-2700
PHONE (703) 837-9600
e-mail: mail@dennisonlaw.com
www.dennisonlaw.com

INTELLECTUAL
PROPERTY LAW
FACSIMILE (703) 837-0980
OF COUNSEL
WILLIAM H. MESEROLE
DAVID POLLACK
BURTON SCHEINER*

April 24, 2007

VIA HAND DELIVERY

COMMISSIONER FOR TRADEMARKS
P.O. Box 1451
Alexandria, VA 22313-1451

Re: Declaration under Section 8 with specimen
U.S. Service Mark Registration No.: 2,396,878
Registrant: TTT Moneycorp Limited
Mark: **TTT MONEYCORP**
Our Reference: T98-139

Dear Commissioner:

On behalf of TTT Moneycorp Limited, please acknowledge receipt of the following:

1. Declaration under Section 8
2. Specimen for class 36
3. Credit Card Form authorizing payment of Government filing fees in the amount of \$200.00 for one class and late filing
4. Deposit Account Form authorizing payment if credit card found to be insufficient
5. Filing Receipt to be stamped by the Patent and Trademark Office and returned

If there are any problems, please contact the undersigned.

Respectfully submitted,



04-24-2007

U.S. Patent & TMO/TM Mail Rcpt Dt. #34

By:

Malcolm J. MacDonald
Attorney for Applicant

MJM/PY

Enclosures: As stated

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Registrant:
TTT MONEYCORP LIMITED

Registration No. **2,396,878**

Reg. Date: **October 24, 2000**

Mark: **TTT MONEYCORP**

Int. Class: **36**

To The Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22314-2700

DECLARATION UNDER SECTION 8

The mark shown in Registration No. 2,396,878, owned by the above-noted British company is in use in commerce on or in conjunction with all of the services identified in the registration except for issuing travelers cheques, banking services and commodity brokerage services, as evidenced by the attached specimen showing the mark as currently used.

The undersigned, being warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 USC 1001, and that such willful false statements may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the registrant or trademark owner; he/she believes the present proprietor to be the true owner of the above identified registration; the trademark is in use in commerce; and all statements made of his/her knowledge are true and all

statements made on information and belief are believed to be true.

TTT MONEYCORP LIMITED

Date: 23/04/07

Malcolm Weinberg
Signature

MALCOLM WEINBERG
Name

DIRECTOR
Title



Make your money go further

Moneycorp Inc. is part of the FIF Moneycorp Group specialising in providing foreign exchange services

The Group at a glance:

- Dealing in foreign exchange since 1979.
- Providing a comprehensive foreign exchange service with offices in the USA, UK, UAE, Australia and various European jurisdictions.
- Serving in excess of 2.5 million customers a year.
- Handling over \$14 billion per annum in currencies.
- Over 700 dedicated employees.
- Average income growth in excess of 20% per annum since 1979.
- Excellent credit ratings from leading credit agencies.
- Substantial client list including many blue-chip companies and organisations.
- Private company with an established reputation, focused on long-term customer satisfaction rather than short-term gains.



Moneycorp Inc.

11, California Place, Suite 300

California, Florida 33141 USA

Telephone: 1 305 491 4170

Facsimile: 1 305 491 4170

websites: www.fif.com www.moneycorp.com

APPENDIX B

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

Money Corp.)	Petitioner
v.		
TTT Moneycorp Limited)	Registrant

**Affidavit of Matthew Cook in
Support of Registrant's
Demonstration of Cause**

Cancellation No. 92045081

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that:

1. I am currently a solicitor for TTT Moneycorp Limited ("Registrant"), and have held that position since at least as early as May, 1998.
2. As part of my responsibilities, I am familiar with Registrant's business and with current and past use of, and plans for, all Registrant's trademarks in the United States.
3. Registrant is a provider of commercial foreign exchange, retail currency and wholesale currency services in the United Kingdom and other countries throughout the world, including the United States.
4. In 1998, Registrant filed an application in the United States to register its MONEYCORP and TTT MONEYCORP marks in connection with foreign currency services, issuing travellers' cheques, commodity brokerage services, and banking services.

5. The bases for that application were existing U.K. registrations for these marks covering the same services, and a bona fide intent to use the marks in U.S. commerce with the same services.

6. By no later than 1st January, 2005, Registrant determined that its U.S. business would not expand to cover issuing travellers' cheques, commodity brokerage services, and banking services (the "Deleted Services"), and abandoned its intent to use either the MONEYCORP or the TTT MONEYCORP mark in commerce with any of the Deleted Services.

7. The period of non-use of the marks MONEYCORP and TTT MONEYCORP in commerce with any of the Deleted Services exceeded three years following the registration date for each U.S. registration and prior to before October 20, 2005.

8. Registrant has no present plans to commence use of the marks MONEYCORP or TTT MONEYCORP for any of the Deleted Services.

9. Registrant deleted these services from Registrations No. 2,399,042 and 2,396,878 in order to comply with the requirements of Section 8 of the Lanham Act.

10. Registrant's decision not to use the MONEYCORP and TTT MONEYCORP in commerce with any of the Deleted Services was made well prior to October 20, 2005, for business reasons unrelated to Petitioner or this proceeding.

11. All statements made of my own knowledge are true and all statements made on information and belief are believed to be true.

DATED: May 24th, 2007.



Matthew Cook
Solicitor, TTT Moneycorp Ltd.