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Filing date: **04/07/2009**

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

Proceeding	92045081
Party	Defendant TTT Moneycorp Limited
Correspondence Address	James L. VANA PERKINS COLE LLP 1201 THIRD AVENUE, 40TH FLOOR SEATTLE, WA 98101 UNITED STATES
Submission	Other Motions/Papers
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Date	04/07/2009
Attachments	TTT Response to Second Show Cause Order.pdf (11 pages)(296163 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 March 20, 2009, the Trademark Trial and Appeal Board (the "TTAB" or "Board") issued an order (the "Order") requiring TTT Moneycorp Limited ("Registrant") to show cause under 37 C.F.R. §2.134 why judgment should not be entered for petitioner Money Corp. ("Petitioner") as to Registration No. 2,463,593 (the "Registration"). Order at p. 4-5.

Following the filing by Registrant of a summary judgment motion on July 3, 2006, Registrant was unable to file an affidavit of continued use (the "Affidavit of Continued Use") of the mark MONEYCORP (the "Mark") for the goods listed in the Registration, as required by Section 8 of the Lanham Act to maintain the Registration. 15 U.S.C. §1058.

The Registration was based on registration of the Mark in the United Kingdom for the goods listed in the Registration (the "Goods")¹, pursuant to Section 44(e) of the Lanham Act. 15

¹ The Goods are: printed matter, namely, maps; books and newspapers, all relating to foreign exchange, currency and related financial matters; printed periodical publications, namely, magazines, newsletters, all relating to foreign exchange, currency and related financial matters; unmounted photographs; stationery; writing instruments; traveler's checks; playing cards, greeting cards, note cards; flip charts, printed charts and score charts; blank paper tapes and cards for the recording of computer programs and data; diagrams for foreign exchange and currency information;

U.S.C. §1126(e). As the Mark was no longer in use in U.S. interstate commerce for the Goods at the time the Affidavit of Continued Use was due, Registrant could not file that affidavit.

B. Applicable Law

The Trademark Rules state 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." 37 C.F.R. §2.134(b).

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

drawing pads; envelopes; document cards and paper files; paper flags; file folders for papers, graphic art prints; graphic art reproductions; note books; writing pads; writing paper, carbon paper, computer and craft paper and packaging paper; paper for recording machines; pictures; printed signs of paper and cardboard; paper place mats; printed plans; postcards; posters; printed signboards of paper and cardboard; printed instructional, educational and teaching materials in the area of foreign exchange, currency and related financial matters; printed tickets; paper control tokens for foreign exchange, currency and related financial matters; writing and drawing books

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 enter judgment on likelihood of confusion grounds. *Id.* at 1156-57.

C. Registrant's Demonstration of Cause.

Here, the Mark was registered pursuant to Section 44(e) of the Lanham Act, 15 U.S.C. 1126(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 the Mark in commerce with any of the Goods, 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 the Mark in commerce with the Goods. *See* Affidavit of Matthew Cook, Appendix B (the "Cook Affidavit"). As a result, Registrant could not claim ongoing use of the Mark in U.S. commerce, or excusable non-use of the Mark, for the Goods in its Registration under Section 8 of the Lanham Act.


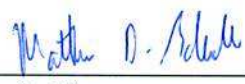
The decision not to commence use of the Mark in commerce with any of the Goods was made for business reasons independent of Petitioner or this proceeding, well prior to the October 20, 2005. *See* Cook Affidavit. Under the rule in *Marshall Field*, Registrant has shown cause why judgment for Petitioner should not be entered against Registrant in connection with that portion of the pending cancellation directed to the Registration on the ground of likelihood of

confusion, and should instead limit any entry of judgment with respect to the Registration solely to abandonment.

As additional support for this conclusion, Registrant notes that the Board previously issued an identical "Show Cause" Order with respect to Reg. Nos. 2396878 and 2399042, also subject of this proceeding, when Registrant deleted certain services from those registrations for which the respective marks were not in use. After Registrant responded to the Order with essentially the same explanation as provided above, the Board determined that Registrant had demonstrated good cause, and limited entry of judgment to solely abandonment grounds. Registrant requests the same limitation on the entry of judgment to abandonment grounds here.

For all of the reasons listed above, Registrant requests that the Board limit any entry of judgment with respect to the Registration solely to abandonment grounds.

DATED: April 7, 2009.

<p>CERTIFICATE OF SERVICE 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 April 7, 2009 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:  _____ Printed Name: <u>Sachiko Crowder</u></p>	<p>PERKINS COIE LLP</p> <p>By  _____ James L. Vana Matthew D. Schneller Perkins Coie LLP 1201 Third Avenue, 40th Floor Seattle, Washington 98101-3099 (206) 359-3036</p> <p>Attorneys for TTT Moneycorp Limited</p>
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APPENDIX A

TARR Record for the Registration

Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2009-04-07 12:34:10 ET

Serial Number: 75911609 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 2463593

Mark (words only): MONEYCORP

Standard Character claim: No

Current Status: [Registration canceled under Section 8.](#)

Date of Status: 2008-03-29

Filing Date: 2000-02-07

Transformed into a National Application: No

Registration Date: 2001-06-26

Register: [Principal](#)

Law Office Assigned: [LAW OFFICE 110](#)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 40S -Scanning On Demand

Date In Location: 2006-10-11

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. [TTT Moneycorp Limited](#)

Address:

[TTT Moneycorp Limited](#)

[2 Sloane Street](#)

[Knightsbridge, London SW1X 9LA](#)

[United Kingdom](#)

Legal Entity Type: [Company](#)

State or Country Where Organized: [United Kingdom](#)

GOODS AND/OR SERVICES

International Class: 016**Class Status:** Section 8 - Cancelled

printed matter, namely, maps; books and newspapers, all relating to foreign exchange, currency and related financial matters; printed periodical publications, namely, magazines, newsletters, all relating to foreign exchange, currency and related financial matters; unmounted photographs; stationery; writing instruments; traveler's checks; playing cards, greeting cards, note cards; flip charts, printed charts and score charts; blank paper tapes and cards for the recording of computer programs and data; diagrams for foreign exchange and currency information; drawing pads; envelopes; document cards and paper files; paper flags; file folders for papers, graphic art prints; graphic art reproductions; note books; writing pads; writing paper, carbon paper, computer and craft paper and packaging paper; paper for recording machines; pictures; printed signs of paper and cardboard; paper place mats; printed plans; postcards; posters; printed signboards of paper and cardboard; printed instructional, educational and teaching materials in the area of foreign exchange, currency and related financial matters; printed tickets; paper control tokens for foreign exchange, currency and related financial matters; writing and drawing books

Basis: 44(e)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

Foreign Registration Number: 2180286**Foreign Registration Date:** 2000-01-02**Country:** [United Kingdom](#)**Foreign Expiration Date:** 2008-10-23

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

[2008-03-29 - Canceled Section 8 \(6-year\)](#)[2006-10-11 - Case File In TICRS](#)[2005-10-26 - Cancellation Instituted No. 999999](#)[2001-06-26 - Registered - Principal Register](#)[2001-04-03 - Published for opposition](#)[2001-03-21 - Notice of publication](#)[2001-01-02 - Approved for Pub - Principal Register \(Initial exam\)](#)

2000-12-22 - Examiner's amendment mailed

2000-10-11 - Communication received from applicant

2000-08-14 - Non-final action mailed

2000-07-24 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

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Domestic Representative

Donald L. Dennison

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 of 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 (Serial No. 75911609) in the United States to register its MONEYCORP mark in connection with various printed materials (the "Goods"): printed matter, namely, maps; books and newspapers, all relating to foreign exchange, currency and related financial matters; printed periodical publications; namely,

magazines, newsletters, all relating to foreign exchange, currency and related financial matters; unmounted photographs; stationery; writing instruments; traveler's checks; playing cards, greeting cards, note cards; flip charts, printed charts and score charts; blank paper tapes and cards for the recording of computer programs and data; diagrams for foreign exchange and currency information; drawing pads; envelopes; document cards and paper files; paper flags; file folders for papers, graphic art prints; graphic art reproductions; note books; writing pads; writing paper, carbon paper, computer and craft paper and packaging paper; paper for recording machines; pictures; printed signs of paper and cardboard; paper place mats; printed plans; postcards; posters; printed signboards of paper and cardboard; printed instructional, educational and teaching materials in the area of foreign exchange, currency and related financial matters; printed tickets; paper control tokens for foreign exchange, currency and related financial matters; writing and drawing books

5. The bases for that application were existing U.K. registrations for this mark covering the Goods, and a bona fide intent to use the mark in U.S. commerce with those Goods.

6. At the time of filing, Registrant had a bona fide intent to use the mark in connection with the Goods in U.S. commerce.

7. Application Serial No. 75911609 matured into registration No. 2463593 on June 26, 2001.

8. By no later than 1st January, 2005, Registrant determined that its U.S. business would not expand to cover the offer or sale of these Goods, and abandoned its intent to use the MONEYCORP mark in commerce with any of the Goods.

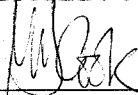
9. The period of non-use of the MONEYCORP mark in U.S. commerce with any of the Goods exceeded three years following the registration date and began prior to before October 20, 2005.

10. Registrant has no present plans to commence use of the marks MONEYCORP for any of the Goods.

11. Registrant's decision not to use the MONEYCORP in U.S. commerce with any of the Goods was made well prior to October 20, 2005, for business reasons unrelated to Petitioner or this proceeding.

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

DATED: April 7, 2009.



Matthew Cook
Solicitor, TTT Moneycorp Ltd.