

THE LIVINGSTON FIRM

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PATENTS ♦ TRADEMARKS ♦ COPYRIGHTS

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NAPLES, FLORIDA 34103-2329

TTAB

www.thelivingstonfirm.com

October 30, 2006

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

78/223,988

Re: In the Matter of Registration No.: 2,857,959
Date of Registration: June 29, 2004
Petitioner: Southern Title Holding Company LLC
Respondent: Southern Escrow & Title, LLC
Mark: SOUTHERN ESCROW AND TITLE, L.L.C.
Our File No.: 06-6115

Dear Sir:

With regard to the above captioned matter, please find enclosed one original and one copy of a Petition to Cancel and this firm's check in the amount of \$300.00 in payment of the filing fee. Kindly acknowledge receipt of same by stamping the enclosed postcard and returning same to our office.

Thank you for your prompt attention to this matter.

Very truly yours,



Edward M. Livingston
Pat. Atty. Reg. No. 28,523

EML/amm
Enclosures- Petition for Cancellation
Postcard
pc: Applicant. (w/enc.)



11-06-2006
U.S. Patent & TM Office Mail Rept Dt. #50

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

In the Matter of Trademark Registration No.: 2,857,959
For the mark: SOUTHERN ESCROW AND TITLE, L.L.C.
Date Registered: June 29, 2004

SOUTHERN TITLE HOLDING COMPANY LLC,)	
Petitioner,)	Cancellation No.: _____
v.)	
SOUTHERN ESCROW & TITLE, LLC,)	
Registrant.)	
)	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

PETITION TO CANCEL

Petitioner, **SOUTHERN TITLE HOLDING COMPANY, LLC**, a Florida limited liability company having a mailing address of 2335 Beville Road, Daytona Beach, Florida 32119, believes that it has been damaged and/or will continue to be damaged by Registration No. 2,857,959, registered on June 29, 2004 and owned by Southern Escrow & Title, L.L.C., a Florida limited liability company having a mailing address of 12815 Emerald Coast Parkway, Suite 124, Destin, Florida 32550, and hereby petitions to cancel same.

As grounds of this Petition, it is alleged that:

1. Petitioner has been using the mark "SOUTHERN TITLE" in conjunction with title insurance and real estate escrow services and real estate closings, title searches and settlement services continuously and notoriously since 1995.

2. Accordingly, Petitioner filed an application in the United States Patent and Trademark Office, Serial No. 78/579,373, for registration on the Principal Register of Petitioner's SOUTHERN TITLE mark for "title insurance and real estate escrow services" in International Class 36 and for "real estate closings, title searches and settlement services" in International Class 42.

3. Southern Title & Escrow, LLC., Registrant, obtained a registration for "SOUTHERN ESCROW AND TITLE, L.L.C." for "real estate closing services" in International Class 42 on June 29, 2004.

4. Petitioner's application is based on use having a first use date anywhere of February 28, 1995 and a first use date in commerce of March 1, 1995.

5. Registrant's use of the mark was long after the aforementioned first use by Petitioner as the registration information shows its first use of the mark on October 1, 1999, approximately four and a half years after Petitioner's first use of the mark.

6. Petitioner has written Registrant on two separate occasions, namely May 9, 2005 and March 22, 2006, regarding Petitioner's superior rights to the mark SOUTHERN TITLE. A copy of each letter is attached herewith as Composite Exhibit "A".

7. To date, however, Registrant has not responded to Petitioner's letters.

8. Registrant's continued use of Petitioner's mark "SOUTHERN TITLE" has caused and will likely continue to cause confusion in the minds of the purchasing public as to the source of the services, especially in view of the fact Petitioner and Registrant are both located in the State of Florida.


9. Moreover, due to the Registrant's failure to respond to Petitioner's repeated requests to contact the undersigned, Petitioner has had to retain the services of the undersigned to file this Petition to Cancel, thereby incurring attorneys' fees and the costs of filing, which would not have been necessary had Registrant contacted the Petitioner's attorneys to resolve the matter.

Therefore, as Petitioner's first use of the mark long predates Registrant's first use of the mark, Petitioner herewith files this Petition to Cancel.

A duplicate copy of the Petition to Cancel and the fee of \$300.00 as required in 37 CFR 2.6(a)(16) is enclosed herewith.

WHEREFORE, Petitioner prays that the Petition to Cancel be granted.

SOUTHERN TITLE HOLDING COMPANY LLC

By: 

Edward M. Livingston, Esq.

Florida Bar No.: 251879

Pat. Attny. No.: 28,523

Angela M. Miller, Esq.

Florida Bar No.: 716871

Pat. Attny. No.: 53,724

THE LIVINGSTON FIRM

963 Trail Terrace Drive

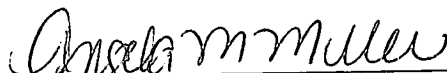
Naples, FL 34103

(239) 262-8502

Attorneys for Petitioner

CERTIFICATE OF MAILING UNDER 37 CFR 1.8

I hereby certify that an original and one copy of this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451 on the 30th day of October, 2006.



Attorney

COMPOSITE EXHIBIT "A"

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TOLL FREE: 800-548-4332

www.thelivingstonfirm.com

March 22, 2006

VIA CERTIFIED MAIL/
RETURN RECEIPT REQUESTED NO.: 7001 2510 0009 3409 9327

Southern Escrow & Title, L.L.C.
12815 Emerald Coast Parkway
Suite 124
Destin, FL 32550

Re: Servicemark Infringement
Mark: "SOUTHERN TITLE"
Our File No.: 05-5697

Dear Ladies and/or Gentlemen:

As you may recall, we mailed you a cease and desist letter on May 9, 2005 (copy enclosed), informing you that we this law firm represents Southern Title Holding Company, LLC, a Florida corporation, the owner and the originator of the mark "SOUTHERN TITLE" in conjunction with real estate services, specifically, title insurance and real estate escrow services, real estate closings, title searches and settlement services; that our client has a pending Federal servicemark on the mark "SOUTHERN TITLE" and a registered State of Florida servicemark for the mark; and that our client's common law rights for use of the mark supercedes your own as our client has been using the mark in Florida as early as February 28, 1995 whereas it appears that the earliest date your company formed was July 1, 1999.

In addition to its servicemarks, our client has been doing business in the State of Florida under numerous registered fictitious names for SOUTHERN TITLE since well before formation of your company.

Furthermore, our letter indicated that we were advised by our client that your company started using our client's mark "SOUTHERN TITLE" in conjunction with similar services provided by our client and that it is our legal opinion that your use of our client's mark is causing and will continue to cause confusion in the marketplace and is thus a direct infringement of our client's servicemark rights.

March 22, 2006

Page 2

Recently the United States Patent and Trademark Office ("USPTO") initially refused registration of our mark SOUTHERN TITLE based on a likelihood of confusion with your registered mark SOUTHERN ESCROW AND TITLE, L.L.C., registration number 2857959, registered June 29, 2004. However, as our client has superior common law rights to the use of the mark SOUTHERN TITLE, we could file a Petition to Cancel your mark, which could result in your loss of your registration. However, rather than pursuing costly cancellation proceedings, our client is interested in discussing a possible settlement agreement wherein both your company and our client will be permitted to use the marks SOUTHERN ESCROW AND TITLE, L.L.C. and SOUTHERN TITLE, respectively, under a concurrent user agreement.

Please contact us as soon as possible, but certainly no later than fifteen (15) days from the date of this letter, to discuss such a settlement. If we do not hear from you within the latter period, we will assume you have no intent in a settlement and we will proceed accordingly.

We look forward to hearing from you.

Sincerely,



Edward M. Livingston

EML:amm

Enclosure: Copy of letter dated May 9, 2005

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EDWARD M. LIVINGSTON
REGISTERED PATENT ATTORNEY

ANGELA M. MILLER
REGISTERED PATENT ATTORNEY

SPECIAL COUNSEL:
EDWIN W. "NED" OLD
REGISTERED PATENT ATTORNEY
ADMITTED IN OHIO ONLY

May 9, 2005

VIA CERTIFIED MAIL/RETURN

RECEIPT REQUESTED NO.: 7001 2510 0009 3409 9716

Southern Escrow & Title, L.L.C.
12815 Emerald Coast Parkway
Suite 124
Destin, FL 32550

Re: Servicemark Infringement on "SOUTHERN TITLE"
Our File No.: 05-5697

Dear Ladies and/or Gentlemen:

This law firm represents Southern Title Holding Company, LLC, a Florida corporation, the owner and the originator of the mark "SOUTHERN TITLE" in conjunction with real estate services, specifically, title insurance and real estate escrow services, real estate closings, title searches and settlement services. A copy of our client's advertisement is enclosed for your reference.

Our client has a pending Federal servicemark on the mark "SOUTHERN TITLE" and a registered State of Florida servicemark for the mark. In addition, our client's common law rights for use of the mark supercedes your own as our client has been using the mark in Florida as early as February 28, 1995 whereas it appears that the earliest date you incorporated was July 1, 1999.

We have been advised by our client that your company has recently started using our client's mark "SOUTHERN TITLE" in conjunction with similar services provided by our client. It is our legal opinion that your use of our client's mark is causing and will continue to cause confusion in the marketplace and is thus a direct infringement of our client's servicemark rights.

May 9, 2005

Page Two

The remedies available to our client for infringement of its servicemark are set forth in the Federal Trademark Law, 15 USC §1117, also known as "The Lanham Act". Under the Federal Trademark Law, the owner of a trademark/servicemark can recover an infringer's profits, damages sustained by the owner, the costs of a law suit, even attorneys' fees, and punitive damages. Furthermore, in assessing the damages the court may award treble (i.e. triple) the amount of actual damages.

The remedies available to our client for infringement of its State of Florida servicemark are set forth in Florida Statute 495.141. Under the statute, the owner of a trademark/servicemark can recover an infringer's profits, damages sustained by the owner, the costs of the law suit and punitive damages (which may be up to three times the amount of actual damages).

Our client has spent considerable time and money developing and advertising its mark. Your company's use of the same mark in conjunction with the same services is not only an infringement of our client's servicemark rights, but also constitutes unfair competition and a dilution of the distinctiveness of our client's mark.

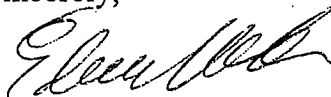
Accordingly, we hereby demand that you immediately cease and desist from using our client's mark. Unless we have assurances in writing of the latter within twenty (20) days of the date of this letter, we will then advise our client that it may proceed with legal action to recover profits, damages, costs and attorneys' fees, including treble damages, and punitive damages for the knowing and willful infringement of our client's mark. In addition, upon filing suit we will also seek temporary and permanent injunctions to prevent your company from selling the products or services using our client's mark.

Please be aware that not only your corporation may be liable for servicemark infringement, but also the individual directors or controlling persons of your corporation may be held liable individually as well.

Therefore, it is in your best interest to cease using our client's name and give us written assurances within the above specified time limit.

PLEASE GOVERN YOURSELF ACCORDINGLY.

Sincerely,



Edward M. Livingston

EML/amm

Enclosures- Advertisement/

pc: Southern Title Holding Company, LLC

3942 A1A Sr
**SOUTHERN
 TITLE**

• St. Augustine, FL 32084 • (904) 460-0270
 • 440 Deltona Blvd., • Deltona, FL 32725 • (407) 860-2788
 • 1360 East Vine Street • Kissimmee, FL 34744 • (407) 933-1212
 • 2335 Beville Road • Daytona Beach, FL 32119 • (904) 760-9800
 • 404 Seabreeze Blvd. • Daytona Beach, FL 32118 • (904) 258-9898
 • 1000 S. Ridgewood Avenue • Edgewater, FL 32132 • (904) 426-7886
 • 3874 San Jose Park Drive, Ste. 5 • Jacksonville, FL 32217 • (904) 739-2205
 • 21 Old Kings Rd. North, Ste. B107 • Palm Coast, FL 32137 • (904) 447-0270

THE TITLE COMPANY ~ "IT ALL COMES DOWN TO US."

Website: www.stitle.com

"WHAT IS TITLE INSURANCE?"

Title insurance is an indemnity against loss resulting from defects in the title to property. Defects take many forms - from bad deeds to long lost heirs. By issuing a title policy, the title company is saying: "We have searched the title to this property, and find it to be good. We guarantee it."

Title insurance differs from other forms of insurance. A title policy insures against matters of the past, and the premium is paid only once - at closing. It is effectual for as long as the insured or the insured's heirs hold title.



"BESIDES ISSUING TITLE POLICIES, WHAT IS THE ROLE OF THE TITLE COMPANY?"

The title policy, although the tangible product of the title company, is only a small aspect of the total role the title company plays in a real estate transaction. They also are called upon to close the deal.



Before the closing itself can take place, however, hours of painstaking preparation must be done. This involves collecting and coordinating myriad pieces of information from many different sources including the Realtor(s), lender, termite

company, surveyor, hazard insurance company, etc. This is all typically done under exacting time constraints.

"HOW MUCH DOES TITLE INSURANCE COST?"

The title premium is An owners title policy costs approximately purchase price up to the rate is \$5.00 per closing fee, re- vary depending on usually around



pegged to the purchase price. in Florida, as of this writing, \$5.75 per \$1000 of the purchase price up to \$100,000. Over that mark thousand. The search and required by Florida law, will the company used. It is \$125.00.

The buyer generally pays for the loan policy, or the "simultaneous issue policy", which can range from \$150 to \$300, including endorsements requested by the lender.

"WHO CHOOSES THE TITLE COMPANY?"



Typically, whoever is paying for the owner's policy chooses the title company - usually the seller.

"I'M SELLING, SO WHY IS TITLE INSURANCE IMPORTANT TO ME?"

Even though the owner's policy would appear to only provide protection to your buyer, there are benefits to you as well. In today's modern, complex economy, title insurance has become an essential component in the movement of real estate. It would be almost impossible to sell real estate without it. Title insurance has become the primary mechanism in resolving title losses. The seller's deed 'warranties', while still valid and binding, have assumed a lesser role in the process.



"WHEN IN THE TRANSACTION DOES THE TITLE COMPANY GET INVOLVED?"

As soon as the contract is signed by both the buyer and seller. At that point the title company will set up a file, order pay-offs from any existing lenders and begin the title search.



"WHAT WILL THE TITLE COMPANY NEED FROM ME?"



From the Seller: The title company will require a copy of the Contract for Sale and Purchase, and a copy of the title policy you received when you purchased the property (also known as the prior title policy), if you have one. If there is an outstanding mortgage, the title company will need the name and address of the lender, and the loan number.

From the Buyer: The title company will need the name and address of the new lender, if any, and the name of their insurance company. They will also need the name of the survey and pest control companies.

"SHOULDN'T I SHOP AROUND FOR THE CHEAPEST TITLE POLICY?"

While cost is important, it should not be the only factor when choosing a title company. Other factors to consider are: the financial strength of the company, which is directly related to its ability to pay claims; quality of services; the knowledge and experience of the staff; and the company's reputation for integrity in the market place.

