

ESTTA Tracking number: **ESTTA346841**

Filing date: **05/11/2010**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

| | | | |
|--------------|---|-------------|------------|
| Name | BY OUR RECORDS | | |
| Entity | Partnership | Citizenship | California |
| Composed Of: | Daniel Mark Glass (US), Edwin Bruce Nichols (US), and David Jesse Dorame (US) | | |
| Address | 130 E. Montecito Avenue Sierra Madre, CA 91024 UNITED STATES | | |

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| Correspondence information | Gordon E. Gray III Attorney of record GRAY LAW FIRM 4401 N. Atlantic Ave. Suite 233 Long Beach, CA 90807 UNITED STATES geg@grayiplaw.com Phone:5629842020 |
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Registration Subject to Cancellation

| | | | |
|-----------------|--|-------------------|------------|
| Registration No | 3636255 | Registration date | 06/09/2009 |
| Registrant | Karen Lynn diminno 880 Spring Park Loop celebration, FL 34747 UNITED STATES | | |

Goods/Services Subject to Cancellation

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| Class 041. First Use: 2008/10/07 First Use In Commerce: 2008/11/02 All goods and services in the class are cancelled, namely: Record production services; Production of music recordings; Music composition, namely, song writing services |
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Grounds for Cancellation

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| Priority and likelihood of confusion | Trademark Act section 2(d) |
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| Related Proceedings | None currently |
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Marks Cited by Petitioner as Basis for Cancellation

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| U.S. Application No. | 77444885 | Application Date | 04/10/2008 |
| Registration Date | NONE | Foreign Priority Date | NONE |

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|---------------------|--|
| Word Mark | ROYAL CROWN REVUE |
| Design Mark |  |
| Description of Mark | The above mark consists of the stylized text "Royal Crown Revue" and a stylized background design consisting of a crown atop a shield on the upper left corner of said text and stylized scrolled vining and leaves above and below the text. There is also a faint shadow effect behind the mark as a whole. The text and design is at a slant going upward from left to right. |
| Goods/Services | Class 041. First use: First Use: 1989/06/01 First Use In Commerce: 1992/06/01 Entertainment, namely, live performances by a musical band; Entertainment, namely, live music concerts; Entertainment services, namely, providing a web site featuring musical performances, musical videos, related film clips, photographs, and other multimedia materials |

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|-----------------------------------|---------------------|------------------|------|
| U.S. Application/Registration No. | NONE | Application Date | NONE |
| Registration Date | NONE | | |
| Word Mark | ROYAL CROWN RECORDS | | |
| Goods/Services | music recordings | | |

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|-------------|---|
| Attachments | 77444885#TMSN.jpeg (1 page)(bytes) Petition to Cancel - By Our Records.pdf (6 pages)(73161 bytes) |
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

| | |
|-----------|----------------------|
| Signature | /Gordon E. Gray III/ |
| Name | Gordon E. Gray III |
| Date | 05/11/2010 |

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

BY OUR RECORDS, a California General
Partnership,

Petitioner,

v.

KAREN LYNN DIMINNO, an individual,

Registrant.

Cancellation No. _____

Mark: ROYAL CROWN RECORDS

Registration No. 3,636,255

Serial No. 77/396955

Filed: February 14, 2008

Published: July 15, 2008

Registration Date: June 9, 2009

PETITION TO CANCEL

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

BY OUR RECORDS, a California general partnership comprising the following partners: Daniel Mark Glass, Edwin Bruce Nichols and David Jesse Dorame (hereinafter “petitioner” or “BY OUR RECORDS”), having a business address of 130 E. Montecito Ave., Sierra Madre, California 91024 believe that it is being or that it will be damaged by U.S. Service Mark Registration No. 3,636,255 and hereby petitions to cancel the same. As grounds therefore, it is alleged that:

1. Petitioner is the owner of the marks, “ROYAL CROWN REVUE” and “ROYAL CROWN RECORDS”, for, *inter alia*, music recordings, live performances by a musical band, live music concerts, a website featuring musical performances, musical videos related film clips,

photographs and other multimedia materials.

2. Petitioner is also the owner of U.S. application serial no. 77/444885 for “ROYAL CROWN REVUE” and design for Entertainment, namely live performances by a musical band; Entertainment, namely, live music concerts; Entertainment services, namely, providing a web site featuring musical performances, musical videos, related film clips, photographs, and other multimedia materials.

3. Petitioner’s date of first use in commerce for the “ROYAL CROWN REVUE” mark is at least as early as June 1, 1992. Petitioner’s date of first use in commerce for the “ROYAL CROWN RECORDS” mark is at least as early as 1999. Furthermore, petitioner has continuously used the “ROYAL CROWN REVUE” mark in interstate commerce in relation to live musical performances, etc. since 1992.

4. Registrant is, on information and belief, Karen Lynn Diminno, an individual (hereinafter “registrant”.) Registrant’s registration, U.S. Registration No. 3,636,255, for the mark ROYAL CROWN RECORDS for “Record production services; Production of music recordings; Music composition, namely, song writing services” alleges a date of first use of October 7, 2008 and a date of first use in commerce of November 2, 2008.

5. Petitioner’s valid and continuous use of the “ROYAL CROWN REVUE” and “ROYAL CROWN RECORDS” marks has developed exceedingly valuable goodwill and recognition with respect to those marks.

6. By virtue of its efforts and the expenditure of considerable sums for promotional materials, advertisements, and the quality of its goods and services, petitioner has gained a valuable reputation for the marks “ROYAL CROWN REVUE” and “ROYAL CROWN

RECORDS” for use in relation to music recordings, live performances by a musical band, live music concerts, a website featuring musical performances, musical videos related film clips, photographs and other multimedia materials.

7. Petitioner was also mailed an office action on December 4, 2009 citing U.S. Reg. No. 3,636,255 against U.S. application serial no. 77/444885 for “ROYAL CROWN REVUE” and design and refused petitioner’s application because of “a likelihood of confusion with the mark in U.S. Registration No. 3,636,255” pursuant to Trademark Act, Section 2(d). The office action further states that petitioner’s and registrant’s goods and services are “highly related and flow through the same channels of trade.”

8. If registrant is permitted to continue its use and registration of its mark as specified in the registration herein opposed, confusion is likely to result because the commercial impression of “ROYAL CROWN RECORDS” is confusingly similar to petitioner’s marks “ROYAL CROWN REVUE” and “ROYAL CROWN RECORDS.” The marks are also similar as to sound and appearance. Furthermore, the relatedness of the goods, the channels of trade, and the classes of purchasers for the goods and services are such that confusion is likely. Therefore, it is very likely that persons familiar with petitioner’s marks would assume that registrant was associated with petitioner and any such confusion would inevitably result in damage to petitioner. Furthermore, any objection or fault found with registrant’s goods and/or services would necessarily reflect upon and seriously injure the reputation that petitioner has established under its marks. Thus, if registrant is allowed to continue use and registration of “ROYAL CROWN RECORDS,” the resulting confusion and assumed affiliation will be damaging to petitioner’s goodwill under the “ROYAL CROWN REVUE” and “ROYAL

CROWN RECORDS” marks, and registrant’s continued use of “ROYAL CROWN RECORDS” as a mark will dilute petitioner’s mark in violation of Section 43(a) of the Trademark Act.

9. Pursuant to Section 2(d) of the Act, 15 U.S.C. §1052(d), registrant’s mark so resembles petitioner’s marks, as to be likely, when used on or in connection with the goods and/or services of registrant, to cause confusion, or to cause mistake, or to deceive. Therefore, a likelihood of confusion exists and registrant’s registration should be cancelled because petitioner has priority of use.

10. Further, if registrant is allowed to maintain the registration herein, it would thereby have at least a *prima facie* exclusive right to the use of its mark, and would appropriate considerable goodwill and recognition that petitioner has established through its exclusive marketing and use. Such registration would be a source of damage and injury to petitioner.

11. Petitioner believes that registrant’s maintenance of Registration No. 3,636,255 will result in financial or other injury and damage to petitioner in its business due to a likelihood of confusion between the marks. Moreover, petitioner’s continued and legal use of its trademark will be impaired by the continued registration of registrant’s mark.

12. To the best of petitioner's knowledge, the name and address of the current owner of Registration No. 3,636,255 is as follows:

Karen Lynn Diminno
880 Spring Park Loop
Celebration, FL 34747

WHEREFORE, petitioner requests that Registration No. 3,636,255 be cancelled and for such other and further relief as the Board may deem proper.

Respectfully submitted,

Dated: May 11, 2010

By: s/Gordon E. Gray III
Gordon E. Gray III
GRAY LAW FIRM
4401 N. Atlantic Ave., Suite 233
Long Beach, CA 90807
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Fax: (562) 984-2019
Email: geg@grayiplaw.com
Attorney for Petitioner
BY OUR RECORDS

CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the foregoing PETITION TO CANCEL was sent by first class mail, postage pre-paid to Registrant's address as follows:

Karen Lynn Diminno
880 Spring Park Loop
Celebration, FL 34747

Dated: May 11, 2010

By: s/Gordon E. Gray III
Gordon E. Gray III