

ESTTA Tracking number: **ESTTA375480**

Filing date: **10/27/2010**

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	Carlson, Caspers, Vandenburg & Lindquist, P.A.		
Entity	Corporation	Citizenship	Minnesota
Address	225 South Sixth St., Suite 3200 Minneapolis, MN 55402 UNITED STATES		

Attorney information	Stephen R. Baird Winthrop & Weinstine, P.A. 225 South Sixth St., Suite 3500 Minneapolis, MN 55402 UNITED STATES trademark@winthrop.com, sbaird@winthrop.com, sperera@winthrop.com, aeichrodt@winthrop.com Phone:612-604-6585		
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Registration Subject to Cancellation

Registration No	3010062	Registration date	11/01/2005
Registrant	ALM MEDIA PROPERTIES, LLC 5TH FLOOR 120 BROADWAY NEW YORK, NY 10271 UNITED STATES		

Goods/Services Subject to Cancellation

Class 016. First Use: 2003/10/00 First Use In Commerce: 2003/10/00 All goods and services in the class are cancelled, namely: legal directories
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Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Reverse confusion

Marks Cited by Petitioner as Basis for Cancellation

U.S. Application No.		Application Date	
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		

Goods/Services			
U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	THE GO-TO FIRM FOR PATENT-SAVVY COMPANIES Petitioner's application for this mark was filed today, October 27, 2010, under Serial No. 85/162,192, and apparently is not yet retrievable from the USPTO database.		
Goods/Services	Class 16: Printed material in the nature of written legal advice and/or opinions Class 45: Legal services; consulting and legal services; intellectual property legal services; litigation services; and intellectual property litigation services		

Attachments	Petition for Cancellation.pdf (7 pages)(272119 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	/Bradley J. Walz/
Name	Bradley J. Walz
Date	10/27/2010

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

Carlson, Caspers, Vandenburg & Lindquist, P.A.,)	
)	
Petitioner,)	
)	
v.)	Cancellation No. _____
)	
ALM Media Properties, LLC,)	
)	
Respondent.)	
)	

PETITION FOR CANCELLATION

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

Carlson, Caspers, Vandenburg & Lindquist, P.A. ("Petitioner"), a Minnesota corporation having a principal place of business at 225 South Sixth Street, Suite 3200, Minneapolis, MN 55402, believes that it is and will continue to be damaged by the registration of GO-TO LAW FIRMS (U.S. Registration No. 3,010,062) on the Principal Register and hereby petitions to cancel the same pursuant to the provisions of Lanham Act § 14, 15 U.S.C. § 1064 (2008).

Grounds for Cancellation

1. Petitioner is the owner of the mark, THE GO-TO FIRM FOR PATENT-SAVVY COMPANIES, used in connection with consulting and legal services, intellectual property legal services, litigation services, intellectual property litigation services, and printed material in the nature of written legal advice and/or opinions ("Petitioner's Goods and Services").

2. Petitioner has used the mark, THE GO-TO FIRM FOR PATENT-SAVVY COMPANIES, in connection with the aforementioned consulting and legal-related services since

at least as early as March 31, 2003, and with written legal advice and/or opinions since at least as early as May 29, 2003.

3. Petitioner has maintained continuous use of the mark, THE GO-TO FIRM FOR PATENT-SAVVY COMPANIES, in connection with Petitioner's Goods and Services since the dates listed in Paragraph 2.

4. Petitioner has consistently and publicly promoted its inherently distinctive mark, THE GO-TO FIRM FOR PATENT-SAVVY COMPANIES, in connection with its offering of Petitioner's Goods and Services. Petitioner has developed a favorable reputation and valuable goodwill in the mark, THE GO-TO FIRM FOR PATENT-SAVVY COMPANIES, which identifies, distinguishes, and indicates the source of Petitioner's Goods and Services.

5. Upon information and belief, Respondent, ALM Media Properties, LLC, is a Delaware limited liability company, with a business address of 120 Broadway, 5th Floor, New York, NY 10271.

6. On January 23, 2004, Respondent filed a trademark application, Application Serial No. 76/572,414, for the claimed mark GO-TO LAW FIRMS ("Respondent's Mark") in connection with "legal directories" ("Respondent's Goods"). Respondent's GO-TO LAW FIRMS trademark application, matured into U.S. Reg. No. 3,010,062 ("Respondent's Registration").

7. Respondent's Registration claims a date of first use of October 2003.

8. Upon information and belief, October 2003 is the earliest date for which Respondent can establish use of Respondent's Mark in connection with Respondent's Goods.

9. Upon information and belief, Respondent surveys in-house counsel at top companies to identify law firms that are most often used by corporate counsel for legal assistance in numerous fields, which have included: (1) Intellectual Property, and (2) Litigation, among

others. Selected law firms are then named, for example, a “Go-To Law Firm® for Intellectual Property” or a “Go-To Law Firm® for Litigation” and they are encouraged and authorized by Respondent to market and publicize this mark, title, recognition, and award to the public, including those interested in purchasing legal services.

10. Upon information and belief, Respondent also has surveyed top technology companies and awarded the title, “Go-To Law Firm® For Technology Companies” and encouraged and authorized recipient law firms to market and publicize this mark, title, recognition, and award to the public, including those interested in purchasing legal services.

11. Petitioner began using the mark, THE GO-TO FIRM FOR PATENT-SAVVY COMPANIES, for the aforementioned consulting and legal-related services, at least six months prior to Respondent’s alleged date of first use and more than nine months before Respondent’s application filing date. Petitioner began using it’s mark in connection with written legal opinions at least four months prior to Respondent’s alleged date of first use and more than seven months before Respondent’s application filing date.

12. Petitioner’s common law rights in THE GO-TO FIRM FOR PATENT-SAVVY COMPANIES mark have priority over Respondent’s Mark and Respondent’s Registration.

13. Respondent’s GO-TO LAW FIRMS mark is highly similar to Petitioner’s THE GO-TO FIRM FOR PATENT-SAVVY COMPANIES mark. Both contain the distinctive and dominant term GO-TO in connection with legal-related goods and services.

14. Respondent’s Goods overlap with or are closely related to Petitioner’s Goods and Services.

15. Respondent’s GO-TO LAW FIRMS mark is likely, when used on or in connection with Respondent’s Goods, to cause confusion, mistake, or deception with Petitioner’s THE GO-TO FIRM FOR PATENT-SAVVY COMPANIES mark used in connection with

Petitioner's Goods and Services. Consumers of legal products and services are likely to mistakenly believe that the goods Respondent offers under the GO-TO LAW FIRMS mark are sponsored, endorsed, or approved by Petitioner, or are in some other way affiliated, connected, or associated with Petitioner, all to the detriment of Petitioner.

16. Respondent's use of highly similar non-distinctive designations such as "Intellectual Property," "Litigation," and "Technology Companies," in close proximity and immediately following the GO-TO LAW FIRMS mark aggravates the likelihood of confusion.

17. Petitioner has been damaged, in part, because Respondent's Registration should not have been permitted under Section 2(d) of the Lanham Act, given Petitioner's prior use of, and common law rights in, its prior and senior mark, THE GO-TO FIRM FOR PATENT-SAVVY COMPANIES.

18. Petitioner is further damaged because Respondent's awarding of the title, "Go-To Law Firm" for specific legal specialties, namely "Intellectual property," "Litigation," and "Technology companies" creates further likely confusion with Petitioner's mark and damages Petitioner's ability to fully enjoy the benefits of its prior mark, THE GO-TO FIRM FOR PATENT-SAVVY COMPANIES, without a resulting likelihood of confusion.

19. Petitioner is further damaged by reverse confusion resulting from Respondent's Registration and use of the GO-TO LAW FIRMS mark as this junior use has saturated the market and overwhelmed Petitioner and its senior use of the GO-TO FIRM FOR PATENT-SAVVY COMPANIES, causing Petitioner to lose the value of its trademark/service mark and the control over its goodwill and reputation.

WHEREFORE, Petitioner respectfully requests that the Board grant its petition for cancellation of U.S. Reg. No. 3,010,062 pursuant to § 14 of the Lanham Act, 15 U.S.C. § 1064.

Respectfully Submitted,

WINTHROP & WEINSTINE, P.A.

Date: October, 27, 2010



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ATTORNEY FOR PETITIONER
CARLSON, CASPERS, VANDENBURGH
& LINDQUIST, P.A.

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

In the matter of Registration No.: 3,010,062
Registration Date: November 1, 2005
For the mark: GO-TO LAW FIRMS

Carlson, Caspers, Vandenburg & Lindquist, P.A.,

Petitioner,

v.

Cancellation No. _____

ALM Media Properties, LLC,

Respondent.

CERTIFICATE OF SERVICE BY MAIL

STATE OF MINNESOTA)
) ss.
COUNTY OF HENNEPIN)

Andrea Eichrodt, of the City of Minneapolis, County of Hennepin, in the State of Minnesota, being duly sworn, says that on the 27th day of October, 2010, she mailed by First Class mail, a true and correct copy of the:

1. Petition for Cancellation

in the above-captioned action to the following at the addresses listed in the United States Patent and Trademark Office TARR database, to-wit:

ALM Media Properties, LLC
Attn: President
120 Broadway, 5th Floor
New York, NY 10271

Jordan A. LaVine
Flaster/Greenberg, P.C.
1628 John F. Kennedy Blvd., 15th Floor
Philadelphia, PA 19103

And the address Petitioner discovered on the website located at the <flastergreenberg.com> domain name:

Jordan A. LaVine
Flaster/Greenberg, P.C.
1600 JFK Blvd., 2nd Floor
Philadelphia, PA 19103

Subscribed and sworn to before me
This 27th day of October, 2010.

Andrea Eichrodt

Andrea Eichrodt

Bradley John Walz
NOTARY PUBLIC

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