

ESTTA Tracking number: **ESTTA461680**

Filing date: **03/14/2012**

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	Filter-All, Inc.		
Entity	Corporation	Citizenship	Texas
Address	6907 FM 1488 Rd. Magnolia, TX 77354 UNITED STATES		

Correspondence information	Melissa M. Martinez Attorney for Petitioner, Filter-All, Inc Keeling Patents & Trademarks 3310 Katy Fwy 2nd Floor Houston, TX 77007 UNITED STATES patents@iplaw-tx.com
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Registration Subject to Cancellation

Registration No	3947380	Registration date	04/19/2011
Registrant	All Filters LLC 795 W 1700 S Ste 1 Salt Lake City, UT 84104 UNITED STATES		

Goods/Services Subject to Cancellation


Class 011. First Use: 2009/11/01 First Use In Commerce: 2009/11/01 All goods and services in the class are cancelled, namely: Air filters for air conditioning units; Air filters for domestic use; Filters for drinking water; Water filtering units for domestic use; Water filters; Water filtration pitchers sold empty; Water purifying units, for potable water for domestic use; Water treatment equipment, namely, cartridge filtration units; Water treatment equipment, namely, reverse osmosis filtration units; Water treatment equipment, namely, reverse osmosis units; Water treatment equipment, namely, water filtration units; Water treatment equipment, namely, water filtration units and reverse osmosis units

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Registrants's mark is used merely as a trade name.

Mark Cited by Petitioner as Basis for Cancellation

U.S. Application No.	85331074	Application Date	05/26/2011
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Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	FILTER-ALL INC.		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 011. First use: First Use: 1988/08/31 First Use In Commerce: 1988/08/31 Air filters for industrial installations; Fibrous filtering media for general industrial use in the purification of air and industrial fluids; Filtering units for separation of liquids for industrial use; Filters for air conditioning; Filters made of fiber for water filtration; Filtration unit for filtering and treating cooking oil being part of commercial deep fryers; Water filters		

Attachments	85331074#TMSN.jpeg (1 page)(bytes) PetitionForCancellation_FINAL_2012_03_14.pdf (5 pages)(150628 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	/Melissa M. Martinez/
Name	Melissa M. Martinez
Date	03/14/2012

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

FILTER-ALL, INC.,)	
)	
Petitioner,)	Cancellation No. _____
)	
v.)	Registration No. 3947380
)	
ALL FILTERS, LLC,)	Mark: ALL FILTERS and Design
)	
Registrant.)	Registered on April, 19, 2011
_____)	

PETITION FOR CANCELLATION

Petitioner Filter-All, Inc. (hereinafter “Petitioner”), a Texas corporation having its principal place of business located at 6907 FM 1488 Road, Magnolia, Texas 77354, believes that it will be damaged by the continued registration of Registration No. 3,947,380 and hereby petitions to cancel same under the provisions of Section 14 of the Lanham Act, 15 U.S.C. §1064.

As grounds for cancellation, Petitioner alleges the following:

1. Petitioner is the owner of U.S. Trademark Application Serial No. 85331074, through which Petitioner seeks to register the mark FILTER-ALL INC. for “*air filters for industrial installations; fibrous filtering media for general industrial use in the purification of air and industrial fluids; filtering units for separation of liquids for industrial use; filters for air conditioning; filters made of fiber for water filtration; filtration unit for filtering and treating cooking oil being part of commercial deep fryers; water filters*” in Class 11.

2. As set forth in Serial No. 85331074, Petitioner has used the FILTER-ALL INC. mark in connection with the subject goods since at least as early as August 31, 1988.

3. During the course of prosecution of Serial No. 85331074, the Examining Attorney refused registration of Petitioner's FILTER-ALL INC. mark under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), over U.S. Registration No. 3947380.

4. All Filters, LLC (hereinafter "Registrant") is identified as the owner of U.S. Registration No. 3947380 (the "Cited Registration"), which is for the mark ALL FILTERS & design (the "ALL FILTERS design"):



The Cited Registration purports to cover the following goods in Class 11: "*air filters for air conditioning units; air filters for domestic use; filters for drinking water; water filtering units for domestic use; water filters; water filtration pitchers sold empty; water purifying units, for potable water for domestic use; water treatment equipment, namely, cartridge filtration units; water treatment equipment, namely, reverse osmosis filtration units; water treatment equipment, namely, reverse osmosis units; water treatment equipment, namely, water filtration units; water treatment equipment, namely, water filtration units and reverse osmosis units*" (the "Subject Goods"). The registration was issued on April 19, 2011. During prosecution the word "FILTERS" was disclaimed.

5. Registrant filed the application (Serial No. 85106727) that ultimately issued as the Cited Registration on August 13, 2010. At the time of filing, Registrant

claimed that the ALL FILTERS design was being used in commerce as a trademark for the Subject Goods, and that it had been used as a mark for such goods since at least as early as November 1, 2009.

6. The Cited Registration should be canceled because Petitioner, prior to the filing of Serial No. 85106727, and prior to Registrant's claimed first use of the purported mark, was already using the mark FILTER-ALL INC. as a trademark for the goods set forth in U.S. Serial No. 85331074. By reason that Petitioner's mark was first used prior to Registrant's reported first use, Petitioner is the senior user. "[T]he senior user, by virtue of its prior appropriation, has superior rights in the mark over a party that subsequently begins using the mark." *Emergency One, Inc. v. Am. Fire Eagle Engine Co.*, 332 F.3d 264, 271 (4th Cir. N.C. 2003). Petitioner therefore has priority of use over Registrant.

7. Additionally, Petitioner has expended considerable effort and expense in promoting its trademark FILTER-ALL INC. and the goods sold under such mark, with the result that the purchasing public has come to know, rely upon, and recognize the products of Petitioner by such mark. Accordingly, Petitioner has established valuable goodwill in the mark.

8. By way of the Cited Registration, Registrant claims the exclusive right to use the ALL FILTERS design in connection with the Subject Goods. Moreover, the U.S. Patent and Trademark Office (the "Office") has taken the position during prosecution of Serial No. 85331074 that the use of the mark FILTER-ALL INC. for the Class 11 goods at issue in Petitioner's application is likely to cause confusion with the use of the ALL FILTERS design mark.

9. Consequently, pursuant to 15 U.S.C. §§1052(d) and 1064(1), U.S. Registration No. 3947380 should be canceled because the ALL FILTERS design (in the view of the Office) consists of a mark that so resembles a mark previously used in the United States by another and not abandoned as to be likely to cause confusion or mistake.

10. Additionally, upon information and belief Registrant is not a manufacturer of the Subject Goods.

11. Upon information and belief, Registrant sells Subject Goods that bear the marks of others and not the ALL FILTERS design for which the Cited Registration was sought, and is now owned, by Registrant.

12. Upon information and belief, Registrant is merely using the ALL FILTERS mark as a trade name. Registrant's use of the ALL FILTERS design serves to identify Registrant as a business entity rather than a mark that identifies the Subject Goods and distinguishes them from those of others. In the instant matter, the Subject Goods themselves contain the trademarks of third parties affixed thereto and those trademarks are what is used to distinguish the Subject Goods for those brand owners. The Trademark Act does not provide for registration of trade names. *See In re Letica Corp.*, 226 USPQ 276, 277 (TTAB 1985); *See In re Diamond Hill Farms*, 32 USPQ2d 1383 (TTAB 1994); *See Lanham Act*, 15 U.S.C. §§ 1051, 1052, and 1127.

13. Petitioner is likely to be damaged by the continued registration of U.S. Registration No. 3947380 in Class 11 because, among other things, it seeks to register the phrase FILTER-ALL INC. as a trademark for the goods specified in Serial No. 85331074, which application has been refused by the Office due to the existence of U.S. Registration No. 3947380.

PRAYER FOR RELIEF

Petitioner prays that U.S. Registration No. 3947380 be canceled for all goods, and that this Petition be sustained in favor of Petition.

PAYMENT OF FILING FEES

Payment of \$300 is being made herewith to cover the required filing fee. Please charge any other fees associated with this proceeding to Deposit Account 11-0307.

Respectfully submitted,

Dated: March 14, 2012

By: /Melissa M. Martinez/
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