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Filing date: **12/20/2012**

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

Proceeding	92056352
Party	Plaintiff Blackstone/OTR, LLC
Correspondence Address	TODD DEVEAU THOMAS HORSTEMEYER LLP 400 INTERSTATE NORTH PARKWAY SE, SUITE 1500 ATLANTA, GA 30339 UNITED STATES trademarks@tkhr.com, todd.deveau@tkhr.com, amy.kwon@tkhr.com, chuck.murray@thomashorstemeyer.com, carla.stone@thomashorstemeyer.com
Submission	Opposition/Response to Motion
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Signature	/Todd Deveau/
Date	12/20/2012
Attachments	01765801.PDF (6 pages)(213408 bytes) 01765802.PDF (19 pages)(640253 bytes) 01765803.PDF (3 pages)(34221 bytes)

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

_____)	
Blackstone/OTR, LLC)	
Petitioner)	Cancellation No. 92056352
v.)	
MAINE INDUSTRIAL TIRE, LLC)	Docket No. 820602-7020
Registrant.)	
_____)	

PETITIONER'S OPPOSITION TO RESPONDENT'S MOTION TO DISMISS

Petitioner Blackstone/OTR, LLC ("Petitioner") submits this brief in opposition to the Motion to Dismiss for Insufficient Service filed by Respondent Maine Industrial Tire, LLC ("Respondent") on December 3, 2012. Because Petitioner served its Petition to Cancel upon counsel who is representing Respondent in this proceeding, that service was sufficient. Moreover, Petitioner has now directly served Respondent, so any deficiency with the original service has been cured.

FACTS

As shown in the TSDR database, Registration 3851316 issued on September 21, 2010. On October 19, 2012, Petitioner filed its Petition to Cancel Registration No. 3851316. In keeping with his longstanding practice and industry custom, counsel for Petitioner served a copy of the Petition upon Respondent by mailing it to Deborah L. Benson, the attorney of record identified in the USPTO's TSDR database for Registration No. 3851316. See Declaration of Todd Deveau, appended hereto as Attachment A, ¶ 4. The TSDR database also listed Ms. Benson as the correspondent for Registration No. 3851312, and the correspondence address

provided in the TSDR database for the registration was that of her law firm, namely, Hinckley, Allen & Snyder, 28 State Str., Boston, MA 02109-1775¹. *Id.* As evidenced by Respondent's Motion to Dismiss, the law firm of Hinckley, Allen & Snyder ("Hinckley Allen") is representing Respondent in this proceeding and therefore is Respondent's current counsel of record. On December 11, 2012, Petitioner served the Petition to Cancel directly on Respondent by mailing a copy of the Petition to Maine Industrial Tire LLC, 107 Audubon Road, Wakefield, MA 01886. Deveau Dec. ¶ 8. Petitioner filed with the Board an amended Certificate of Service that same day. *Id.*; see also Amended Certificate of Service, appended hereto as Attachment B.

ARGUMENT

1. Service of the Petition upon Respondent's Current Counsel of Record was Sufficient to Institute Proceedings on October 19, 2012

Although Petitioner's service of the Petition upon Hinckley Allen, Respondent's current counsel of record, did not technically satisfy the requirements of Trademark Rules 2.111(a) and (b), such service was sufficient to put Respondent on notice of the Petition and to institute this proceeding on October 19, 2012. See *Jacques Moret, Inc. v. Speedo Holdings B.V.*, 102 USPQ2d 1212, 1216 (TTAB Mar. 12, 2012) (service of petition to cancel upon registrant's current counsel of record was sufficient to institute proceedings as of date of that service).

In *Jacques Moret*, the petitioner did not serve its petition for cancellation upon the owner of the subject registration. Instead, the petitioner served its papers upon an attorney who had

¹ As shown in Exhibit A to the Deveau Declaration, on October 18, 2012, the TSDR database listed Ms. Benson as the correspondent for Registration and further provided her firm's address as the correspondence address for the registration. In the TSDR database attached as Exhibit B to Respondent's Motion to Dismiss, however, the correspondent had been changed to Maine Industrial Tire, LLC and the correspondence address had been changed to 107 Audubon Road, Wakefield, MA 01886. Petitioner does not know when or why the correspondence information was changed, but at the time it filed and served its Petition to Cancel, the TSDR database identified Ms. Benson as the correspondent and identified her law firm's address as the correspondence address.

never been the registration owner's counsel of record. *Id.* at 1214. The registration's owner moved to dismiss the petition for insufficient service. In response, the petitioner attempted to make service by serving the petition for cancellation on the Director of Trademarks. *Id.* The petitioner also filed an opposition to the motion to dismiss and served its opposition papers upon the registration owner's then current counsel of record. Included in petitioner's opposition papers was a copy of the petition for cancellation. *Id.* at 1216, n. 9.

The *Jacques Moret* Board ruled that neither service upon an attorney who never was the registration owner's counsel of record nor service upon the Director constituted effective service, as required by Trademark Rules 2.111(a) and (b), and therefore dismissed the Petition for Cancellation. *Id.* at 1216. The Board immediately resumed proceedings, however, ruling that the petitioner's service of its petition for cancellation on the registration owner's current counsel of record, as an exhibit in support of its opposition to the motion to dismiss, was sufficient to put the registration owner on notice of the proceeding. *Id.* at 1216. The *Jacques Moret* Board held that the date of institution of the proceeding would be the date on which the petitioner made such service upon the registration owner's counsel of record.² *Id.*

Here, Petitioner served a copy of its Petition upon Respondent's current counsel of record on October 19, 2012, the same day that it filed the Petition. Accordingly, under *Jacques Moret*, Respondent clearly was put on notice of this proceeding, and such service was sufficient to institute this proceeding on that date. *Id.*; see also *Equine Touch Foundation, Inc. v.*

² Curiously, Respondent relies upon *Jacques Moret* as support for its request to dismiss this proceeding. While Respondent is correct that the *Jacques Moret* Board dismissed a cancellation action for insufficient service, Respondent neglects to mention that the Board immediately reinstated the action based upon the fact that, as is the case here, the petitioner had served the respondent's current counsel of record. Thus, Respondent's own authority shows that its Motion should be denied.

Equinology, Inc., 91 USPQ2d 1943, 1945 n.3 (TTAB Feb. 10 2009) (service of Petition directly upon respondent was not necessary because it was clear that respondent would be represented by counsel in proceeding, and said counsel had been served).

2. Even if Petitioner's Service Was Initially Defective, Petitioner Cured That Defect By Serving Respondent Directly on December 11, 2012.

Assuming *arguendo* that Petitioner's service of the Petition upon Respondent's current counsel of record was insufficient to institute proceedings on October 19, Petitioner cured any defect in service by directly serving Respondent on December 11, 2012. See *Equine Touch*, 91 USPQ2d at 1945 (TTAB 2009) (because petitioner acted promptly to correct its failure of service and because the petition was not time-barred as of the date of proper service, petitioner cured its defective service by serving respondent and by filing an amended proof of service). In *Equine Touch*, the petitioner's counsel did not serve the registration owner because he mistakenly believed that the Board would make service. *Id.* at 1944. Upon realizing his mistake, the petitioner's counsel mailed a service copy of the petition to the registration owner's counsel. *Id.* In addition, the petitioner's counsel filed with the Board a motion to amend the proof of service. *Id.* At the time petitioner's counsel filed the amended proof of service, the subject registration was not yet five year's old. *Id.*

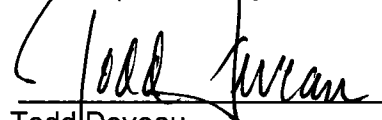
The Board ruled that the petitioner's counsel's corrective actions were sufficient to cure the service defect.

Inasmuch as petitioner acted promptly to cure its acknowledged failure of service, and given the fact that this petition would not be time barred as of the date of actual compliance with the service requirement, petitioner cured the defective filing by its amendment of the proof of service. Therefore, the Board will not dismiss this petition as a nullity but instead will accord the petition a new filing date of October 17, 2008, which is the date of such amendment.

Id. at 1945. Here, upon receiving Respondent's Motion to Dismiss for insufficient service, Petitioner promptly sent a copy of the Petition directly to Respondent and amended its Certificate of Service to reflect that fact. In addition, Registration No. 3851316 is not yet five years old, so the Petition was not time-barred on the date Petitioner served Respondent directly. If Petitioner's service of Respondent's current counsel of record on October 19, 2012 was not sufficient, and it was, then Petitioner's subsequent actions cured the service defect. Accordingly, rather than dismiss the Petition, the Board should accord the Petition a new filing date of December 11, 2012.

For the foregoing reasons, Petitioner respectfully requests that the Board deny Respondent's Motion to Dismiss, declare Petitioner's service of Respondent's current counsel sufficient to institute proceedings on October 19, 2012 and maintain the October 19, 2012 filing date for this proceeding. In the alternative, Petitioner requests that the Board deny Respondent's Motion to Dismiss, declare that Petitioner cured its service defect by mailing the Petition directly to Respondent on December 11, 2012 and accord this proceeding a new filing date of December 11, 2012. Petitioner further requests that the Board lift the suspension of proceedings and reset the conferencing, disclosure, discovery and trial dates accordingly.

Respectfully submitted,
Thomas|Horstemeyer, LLP



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400 Interstate North Parkway SE
Suite 1500
Atlanta, Georgia 30339
Tel: (770) 933-9500
Fax: (770) 951-0933

Attorneys for the Petitioner
Blackstone/OTR, LLC

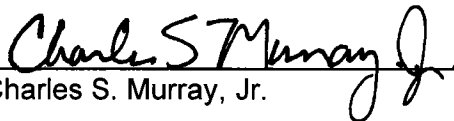
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

_____)	
Blackstone/OTR, LLC)	
)	Cancellation No. 92056352
Petitioner)	
)	
v.)	
)	Docket No. 820602-7020
MAINE INDUSTRIAL TIRE, LLC)	
)	
Registrant.)	
_____)	

CERTIFICATE OF SERVICE

I hereby certify that a copy of Petitioner's Opposition to Respondent's Motion to Dismiss is being deposited with the United States Postal Service December 20, with sufficient postage as first class mail, in an envelope addressed to:

TANYA MARIE CURCIO
HINCKLEY, ALLEN & SNYDER LLP
28 STATE ST
BOSTON, MA 02109-1775


Charles S. Murray, Jr.

ATTACHMENT A

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

_____)	
Blackstone/OTR, LLC)	
)	Cancellation No. 92056352
Petitioner)	
)	
v.)	
)	Docket No. 820602-7020
MAINE INDUSTRIAL TIRE, LLC)	
)	
Registrant.)	
_____)	

**DECLARATION OF TODD DEVEAU IN SUPPORT OF PETITIONER'S
OPPOSITION TO RESPONDENT'S MOTION TO DISMISS**

I, Todd Deveau, hereby declare and state, under penalty of perjury, the following to be true and correct:

1. I am an attorney having over thirty years (30) experience in Intellectual Property Law, including *inter partes* proceedings before the United States Patent and Trademark Office's Trademark Trial and Appeal Board.
2. I present this declaration in support of Petitioner Blackstone/OTR LLC's opposition to Respondent Maine Industrial Tire, LLC's Motion to Dismiss the instant Petition to Cancel.
3. On behalf of Petitioner, I filed on October 19, 2012 the Petition to Cancel that initiated the instant proceedings.
4. In keeping with my longstanding practice and what I believed to be industry custom, I caused the Petition to be served upon Respondent on October 19, 2012 by having a copy of the Petition sent by U.S. mail to Deborah L. Benson, the attorney of record listed in the TSDR database for Registration No. 3851316. Ms. Benson also was identified in the TSDR

database as the correspondent for the registration, and the correspondence address was identified as: Hinkley, Allen & Snyder, 28 State Str., Boston, MA 02109-1775. A copy of the TSDR database record from October 18, 2012 is attached hereto as Exhibit A.

5. In my experience, and upon information and belief, I believed it was acceptable to serve a Petition for Cancellation upon the attorney of record listed in the TSDR (formerly TARR) database, and I have done so numerous times during my career. See Gary D. Krugman, Trademark Trial and Appeal Board Practice and Procedure, § 3:40, at 147 (2012) (noting that Board will accept cancellation petition and assign filing date and cancellation number if petition is served on either registrant or an attorney listed in TSDR database). A copy of the relevant pages from the Krugman Treatise is attached hereto as Exhibit B.

6. Never in my career have I known a respondent to move to dismiss a cancellation petition for insufficient service merely because the petition was served upon the respondent's attorney of record instead of directly upon the respondent.

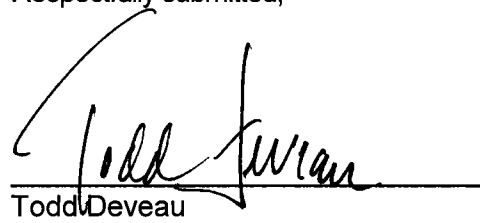
7. Based upon the fact that Respondent's motion to dismiss was filed on Respondent's behalf by Hinkley, Allen & Snyder, the same law firm with which Ms. Benson was identified, it is my belief that Ms. Benson or someone else at Hinkley, Allen & Snyder made Respondent aware of the Petition to Cancel shortly after the Petition was served upon Ms. Benson.

8. After receiving Respondent's Motion to Dismiss for Insufficient Service, I caused a copy of the Petition to Cancel to be mailed directly to Respondent at the address listed in the TSDR database for Registration No. 3851316, namely: Maine Industrial Tire LLC, 107 Audubon Road, Wakefield, MA 01886. The copy of the petition was mailed on December 11, 2012. Attached hereto as Exhibit C is a copy of the documents that were mailed to Respondent. On that same day, I filed an amended Certificate of Service with the Board. Attached hereto as Exhibit D is a copy of the amended Certificate of Service.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge 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.

Respectfully submitted,

Date: 20 Nov 2012



Todd Deveau

**EXHIBIT A TO DECLARATION
OF TODD DEVEAU**

AERIAL

TSDR Enhancement

Cancel Save

USPTO > Trademark > TSDR > Trademark Search

TSDR FAQ'S

On August 25, 2012, the USPTO released version 2.0 of Trademark Status and Document Retrieval (TSDR). Please send any TSDR related questions or comments to TSDR@USPTO.GOV. Additional information about the TSDR 2.0 deployment is available [here](#).

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TSDR Quick Tip: Assignment information has been incorporated into the TSDR Status display, if an assignment has been filed on a case. Look for the section labeled "Assignment Abstract of Title Information" located at the bottom of the Status information. A Conveyance Filter has been added providing the option of displaying some or all types of conveyances.

On August 25, 2012,
 the USPTO released

Trademark Status & Document Retrieval (TSDR)

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Status results found

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Mark: AERIAL MAX

AERIAL MAX

US Serial Number: 77792959 Application Filing Date: Jul. 30, 2009
 US Registration Number: 3851316 Registration Date: Sep. 21, 2010
 Register: Principal
 Mark Type: Trademark
 Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.
 Status Date: Sep. 21, 2010
 Publication Date: Dec. 29, 2009 Notice of Allowance Date: Mar. 23, 2010

Mark Information

expand all

Mark Literal Elements: AERIAL MAX
 Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.
 Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (()) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks "*" identify additional (new) wording in the goods/services.

For: Tires, off-the road tires
International Class: 012 - Primary Class
Class Status: ACTIVE
Basis: 1(a)
First Use: Apr. 13, 2010

U.S Class: 019, 021, 023, 031, 035, 044

Use in Commerce: Apr. 13, 2010

Basis Information (Case Level)

Current Owner(s) Information

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Deborah L. Benson

Correspondent

Correspondent DEBORAH L. BENSON
Name/Address: HINCKLEY, ALLEN & SNYDER LLP
28 STATE ST
BOSTON, MASSACHUSETTS 02109-1775
UNITED STATES

Phone: 617-345-9000

Fax: 617-345-9020

Correspondent e-mail: tmddocket@haslaw.com

Correspondent e-mail No
Authorized:

Domestic Representative - Not Found

Prosecution History

TM Staff and Location Information

Assignment Abstract of Title Information

Conveyance Filter

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**EXHIBIT B TO DECLARATION
OF TODD DEVEAU**

Trademark
Trial and
Appeal Board
Practice and Procedure

2012-2013 Edition

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of record, at the correspondence address of record in the PTO, and the opposition must include proof of service, pursuant to Trademark Rule 2.119.⁵

Similarly, with respect to cancellation petitions filed on or after November 1, 2007, the cancellation petition must be served on the registrant, or the registrant's domestic representative of record, at the correspondence address of record in the PTO, and the cancellation petition must include proof of service, pursuant to Trademark Rule 2.119.⁶

The complaint should be a short and plain statement noting why the plaintiff believes it would be damaged by the registration (plaintiff's standing) and one or more grounds for opposition or cancellation. The complaint should be set forth in numbered paragraphs with enough detail to give the defendant fair notice of the basis for each claim.⁷

§ 3:40 Opposition and cancellation procedures—Pleadings—Complaint—Service of complaint

Under the amendments to the TTAB rules of practice, effective for cases filed on or after November 1, 2007, all opposition and cancellation petitions must be served by the plaintiff on the defendant and proof of service must accompany the opposition or cancellation petition filed with the Board before the proceeding will be instituted.¹

Whether a plaintiff should serve the owner directly, an attorney or a domestic representative, depends on what the PTO records show the correspondence address to be.

In order to determine the correspondence address of record for an applicant or registrant, the plaintiff need simply check the PTO's TSDR database,² available via links from the PTO's Web site at www.uspto.gov. A plaintiff need only serve a copy of the opposition or cancellation petition to the correspondence address of record shown in the TSDR database, and there is no requirement to serve a copy to any address other than the one listed in the TSDR system.

With respect to oppositions, if the TSDR database shows a listing for an attorney for applicant, the Board prefers that the Opposer serve the opposition on the listed attorney. In this situation, however, the Board will accept the opposition and assign a filing date and opposition number if the opposition is served on either the applicant or its listed attorney.³

With respect to cancellations, even if the TSDR database shows a listing for an attorney for registrant, the Board prefers that the petitioner serve the cancellation

⁵Trademark Rule 2.101, as amended.

⁶Trademark Rule 2.111, as amended.

⁷Harsco Corp. v. Electrical Sciences Inc., 9 U.S.P.Q.2d 1570, 1988 WL 252330 (T.T.A.B. 1988).

[Section 3:40]

¹Trademark Rules 2.101, 2.105, 2.111, and 2.113, as amended.

²The TSDR (Trademark Status and Document Retrieval) system has replaced the TARR (Trademark Applications and Registrations Retrieval) system. TSDR integrates the former TARR and Trademark Document Retrieval (TDR) systems into one database. The TSDR database includes a link to assignment information, including any changes of name that have been recorded. If there is a discrepancy between the correspondence address in the TSDR database and information from the assignment records, the better practice is to serve a courtesy copy of the complaint on any address the plaintiff has reason to believe is more current than the one listed in the TSDR database. Similarly, if the plaintiff has reason to believe there has been an ownership change in defendant's application or registration which has not been recorded in the PTO assignment division, the better practice is to serve a courtesy copy of the complaint on any such party known to the plaintiff.

³Chocoladefabriken Lindt & Sprungli AG v. Karlo Flores, 91 U.S.P.Q.2d 1698, 2009 WL 2351435 (T.T.A.B. 2009).

petition on the registrant (or the registrant's domestic representative, if registrant is a foreign entity) rather than the listed attorney. While the Board considers an attorney for an applicant to be the attorney only until the mark is registered, many attorneys nevertheless remain on the TSDR database after the registration issues. In this situation, however, the Board will accept the cancellation petition and assign it a filing date and cancellation number if the cancellation petition is served on either the registrant or any listed attorney.

While not required, it is prudent and recommended that, where an attorney for a registration is listed in the TSDR database, the petition to cancel be served both on the registrant directly and on the attorney listed in the TSDR database.

If a service copy is returned to the plaintiff as undeliverable, the plaintiff must notify the Board within 10 days of receipt of the return service copy, or of any notice indicating that the service copy could not be delivered. Such notice to the Board may be in writing or by an appropriate electronic filing through the ESTTA system.⁴

A plaintiff is under no obligation to search for current correspondence information or to investigate the whereabouts of any defendant on whom service cannot be made. However, if a service copy of a complaint is returned undeliverable, the notice to the Board of failure of service must include any new address information for the defendant, if known.⁵

Service of the complaint by plaintiff and proof of service accompanying the complaint filed with the Board are both necessary in order to have the complaint accepted and afforded a filing date. If a complaint is not served on the defendant, it will not be accepted by the Board and not given a filing date. If the complaint is subsequently served, the filing date will be the date the complaint is served. In the case of an opposition, there is no opportunity to cure the failure of service unless there is time remaining in the opposition period to do so. In other words, if an Opposer files a notice of opposition on the last day of the opposition period and neglects to serve the defendant or defendant's attorney, the opposition will not be instituted and will not receive a filing date and Opposer will be unable to cure this defect.⁶

The same result occurs where a plaintiff serves the complaint on the defendant or defendant's attorney but neglects to indicate proof of service on the defendant or defendant's attorney in the complaint filed with the Board. Even though service actually occurred, the Board will not institute the complaint or give it a filing date. In the case of an opposition filed on the last date of the opposition period, the Board will not allow the Opposer to cure the defect by later submitting proof of service.

⁴See Trademark Rules 2.101(b) and 2.111(b).

⁵If, for example, a plaintiff has discovered a new address for defendant, through voluntary investigation, the results of such investigation must be reported in plaintiff's notice to the Board.

⁶*Springfield, Inc. v. XD*, 86 U.S.P.Q.2d 1063, 2008 WL 351044 (T.T.A.B. 2008) (opposer's remedy in this situation would be to file a petition to cancel if and when the mark in the application matures into a registration); *Schott AG v. LWren Scott*, 88 U.S.P.Q.2d 1862, 2008 WL 4922488 (T.T.A.B. 2008). In the case of a failure to comply with the service requirements of a petition for cancellation, a petitioner was able to cure the failure of service by filing a motion to amend the petition to indicate that service was made. In this situation, the Board accepted the amended petition for cancellation and accorded the petition a filing date which was the date of the amendment. See: *The Equine Touch Foundation, Inc. v. Equinology, Inc.*, 91 U.S.P.Q.2d 1943, 2009 WL 625593 (T.T.A.B. 2009). While the later filing date did not cause a problem for the petitioner in this case since the petition would not be time barred as of the date of compliance with the service requirements, practitioners should be aware that problems could occur if the grounds for cancellation of a registration must be brought within five years from the date of the registration date and the service requirements were not cured until after the five year anniversary of the registration. In accord, *Jacques Moret Inc. v. Speedo Holdings B.V.*, 102 U.S.P.Q.2d 1212, 2012 WL 1288721 (T.T.A.B. 2012).

Once again, the recourse for an Opposer in this situation would be to file a cancellation action if and when the mark in the involved application registers.⁷

While the Board, as noted above, will not allow a filing date in the event of failure of service or failure to include proof of service, the Board appears to be more lenient with respect to curing innocent, inadvertent errors in service or proof of service. For example, if a plaintiff served the defendant but inadvertently served it at an incorrect address, the Board will allow such error to be cured by a subsequent re-service of the complaint at the correct address and the complaint will be given its original filing date.

§ 3:41 Opposition and cancellation procedures—Pleadings—Complaint—Standing

Research References

West's Key Number Digest, Trademarks ☞1294, 1301
 McCarthy on Trademarks and Unfair Competition §§ 20:7, 20:46 (4th ed.)
 Trademark Law Practice Forms § 13:79

Any entity that believes it is or will be damaged by a registration may file an opposition seeking to prevent registration or may file a petition to cancel a registration.¹

The “damage” requirement in the statute and rules relates to one’s standing to oppose or petition to cancel. A plaintiff having no more real interest in a case, beyond that of the general public, is said not to have standing to challenge a registration. To establish standing to oppose or to petition to cancel requires pleading (and later proving) that the plaintiff has a real interest in the proceeding. The Federal Circuit has consistently found that the only purpose of requiring standing in an opposition or cancellation proceeding is to prevent such proceedings from being brought by mere intermeddlers that have no real interest in the case.²

§ 3:42 Opposition and cancellation procedures—Pleadings—Complaint—Grounds

Research References

West's Key Number Digest, Trademarks ☞1291, 1292, 1295, 1299, 1387
 McCarthy on Trademarks and Unfair Competition §§ 20:13 to 20:21, 20:52 to 20:62 (4th ed.)
 Trademark Law Practice Forms §§ 13:28 to 13:35, 13:85 to 13:90

Virtually any ground that could have been the basis for refusal of registration to an applicant during the ex parte prosecution of the application may be raised as a

⁷Springfield, Inc. v. XD, 86 U.S.P.Q.2d 1063, 2008 WL 351044 (T.T.A.B. 2008).

[Section 3:41]

¹15 U.S.C.A. §§ 1063(a), 1064; Trademark Rules 2.101(b), 2.111(b).

²See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 U.S.P.Q. 185 (C.C.P.A. 1982); *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 U.S.P.Q.2d 2021 (Fed. Cir. 1987). See also *Estate of Biro v. Bic Corp.*, 18 U.S.P.Q.2d 1382, 1991 WL 325858 (T.T.A.B. 1991); *Ritchie v. Simpson*, 170 F.3d 1092, 50 U.S.P.Q.2d 1023 (Fed. Cir. 1999); *Michael J. McDermott v. San Francisco Womens Motorcycle Contingent*, 81 U.S.P.Q.2d 1212, 2006 WL 2682345 (T.T.A.B. 2006), *aff'd*, 240 Fed. Appx. 865 (Fed. Cir. 2007); *Corporacion Habanos, S.A. v. Anncas, Inc.*, 88 U.S.P.Q.2d 1785, 2008 WL 4409768 (T.T.A.B. 2008); *Christopher Brooks v. Creative Arts By Calloway, LLC*, 93 U.S.P.Q.2d 1823, 2010 WL 595585 (T.T.A.B. 2010); *Fiat Group Automobiles S.p.A. v. ISM, Inc.*, 94 U.S.P.Q.2d 1111, 2010 WL 956670 (T.T.A.B. 2010); *Coach Services, Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 U.S.P.Q.2d 1713 (Fed. Cir. 2012); *Corporacion Habanos, S.A. and Empresa Cubana del Tabaco, d.b.a. Cubatabaco v. Juan E. Rodriguez*, 2011 WL 3871952 (T.T.A.B. 2011); *compare Robert Doyle v. Al Johnsons Swedish Restaurant & Butik, Inc.*, 101 U.S.P.Q.2d 1780, 2012 WL 695211 (T.T.A.B. 2012).

**EXHIBIT C TO DECLARATION
OF TODD DEVEAU**

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

In Re Trademark Registration No.: 3,851,316

For the Mark: AERIAL MAX
Registered on September 21, 2010

_____)	
Blackstone/OTR, LLC)	
)	Cancellation No. _____
Petitioner)	(To be assigned)
)	
v.)	
)	Docket No. 820602-7020
MAINE INDUSTRIAL TIRE, LLC)	
)	
Registrant.)	
_____)	

PETITION FOR CANCELLATION

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

Sir:

This Petition for Cancellation is brought in the matter of the above trademark registration for the trademark "AERIAL MAX" for "tires, off-the road tires" under Section 1(a) of the Trademark Act ("Registrant's Mark").

Petitioner, Blackstone/OTR, LLC (hereinafter "Blackstone/OTR" or "Petitioner"), believes it has been and will continue to be damaged by the continued registration of the mark identified above, and hereby petitions to cancel the above trademark registration.

The grounds for cancellation are as follows:

1. Petitioner, Blackstone/OTR is a Georgia limited liability corporation, having its

principal place of business at 6 Riverside Industrial Park NE, Rome, Georgia 30161-7301.

2. Long prior to July 30, 2009, the filing date of the application for registration of Registrant's mark, namely believed to be as early as March 2003, Petitioner adopted and used the identical term "AERIAL MAX" (hereinafter sometimes "Petitioner's Mark") as a trademark in connection with tires, in particular, off-the road tires (hereinafter sometimes "Petitioner's Goods"). Since then Petitioner has continuously used its mark in connection with its goods and is still using said mark in commerce in connection with said goods.

3. Registrant has applied to register and registered the trademark "AERIAL MAX" (hereinafter sometimes Registrant's Mark") for use in connection with "tires; off-the road tires" (hereinafter sometimes "Registrant's Goods") in International Class 12.

4. Upon information and belief, the goods of Petitioner and the goods of Registrant, are related, if not identical, goods marketed, offered, and advertised under confusingly similar, if not identical, marks, and are marketed, offered, and advertised in the same or related channels of trade to the same or a related class of customers.

5. Upon information and belief, Registrant's Mark so resembles Petitioner's Mark, which is used in the United States, as to be likely, when used on or in connection with Applicant's Goods, to cause confusion, or to cause mistake, or to deceive in violation of Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d).

6. By reason of all of the foregoing, Petitioner believes it will be gravely damaged by the continued registration of the mark AERIAL MAX by Registrant.

WHEREFORE, Petitioner respectfully requests that this Petition for Cancellation be sustained, and said Registration No. 3,851,316 for the trademark "AERIAL MAX" be cancelled pursuant to Trademark Act §14, 15 U.S.C. §1064.

This Petition for Cancellation is being submitted via the Electronic System for the Trademark Trial and Appeal Board accompanied by the Petition for Cancellation fee under 37

CFR 2.6(a)(16) of \$300.00. Please charge any additional fees to Deposit Account No. 20-0778.

Respectfully submitted,
Thomas|Horstemeyer, LLP

/Todd Deveau/

Todd Deveau, Reg. No. 29,526
400 Interstate North Parkway SE
Suite 1500
Atlanta, Georgia 30339
Tel: (770) 933-9500
Fax: (770) 951-0933
Attorney for the Petitioner
Blackstone/OTR, LLC

**EXHIBIT D TO DECLARATION
OF TODD DEVEAU**

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

In Re Trademark Registration No.: 3,851,316

For the Mark: AERIAL MAX
Registered on September 21, 2010

_____)	
Blackstone/OTR, LLC)	
)	Cancellation No. 92056352
Petitioner)	
)	
v.)	
)	Docket No. 820602-7020
MAINE INDUSTRIAL TIRE, LLC)	
)	
Registrant.)	
_____)	

AMENDED CERTIFICATE OF SERVICE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

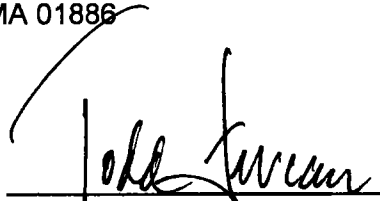
Sir:

I hereby certify that a copy of the Petition for Cancellation in the above-referenced proceeding, filed with the Trademark Trial and Appeal Board on October 19, 2012, was deposited with the United States Postal Service on October 19, 2012, with sufficient postage as first class mail, in an envelope addressed to Registrant's counsel of record:

DEBORAH L. BENSON
HINCKLEY, ALLEN & SNYDER LLP
28 STATE ST
BOSTON, MA 02109-1775

I hereby further certify that a copy of the Petition for Cancellation was served directly upon Registrant by depositing it with the United States Postal Service on December 11, 2012, with sufficient postage as First Class mail, in an envelope addressed to:

MAINE INDUSTRIAL TIRE LLC
107 AUDUBON ROAD
WAKEFIELD, MA 01886

A handwritten signature in black ink, appearing to read "Todd Deveau", written over a horizontal line.

Todd Deveau

ATTACHMENT B

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

In Re Trademark Registration No.: 3,851,316

For the Mark: AERIAL MAX
Registered on September 21, 2010

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Blackstone/OTR, LLC)	
Petitioner)	Cancellation No. 92056352
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MAINE INDUSTRIAL TIRE, LLC)	Docket No. 820602-7020
Registrant.)	
_____)	

AMENDED CERTIFICATE OF SERVICE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

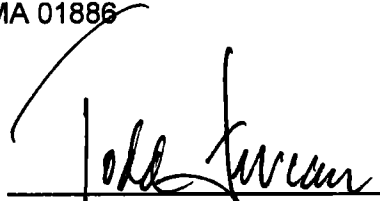
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