UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Baxley

Mailed: January 16, 2013

Cancellation No. 92056352

Blackstone/OTR, LLC

v.

Maine Industrial Tire LLC

By the Trademark Trial and Appeal Board:

On December 3, 2012, respondent, in lieu of an answer, filed a motion to dismiss under Fed. R. Civ. P. 12(b)(5) for insufficient service of the petition to cancel. Petitioner filed a brief in response thereto.

A cancellation proceeding is commenced by filing a timely petition for cancellation with the required fee. The petition must include proof of service on the owner of record for the registration, or the owner's domestic representative of record, at the correspondence address of in USPTO records. See Trademark Rule 2.111(a). Service of a petition for cancellation on an attorney who represented a respondent during *ex parte* examination, or who represented or represents the respondent in other matters, is insufficient unless the attorney is *also* listed in the Office records for the registration as the domestic representative. *Jacques Moret Inc. v. Speedo Holdings B.V.*,

102 USPQ2d 1212, 1215 (TTAB 2012). "[A]ny representation which may be of record in an application file after the mark has registered at the time of the commencement of a cancellation is not considered to be effective for purposes of the proceeding." TBMP Section 310.01 (3d ed. rev. 2012).

The certificate of service of the petition to cancel indicates that petitioner failed to serve it in compliance with Trademark Rule 2.111(a). In particular, petitioner served the petition to cancel upon the attorney who represented respondent during ex parte prosecution of the application for Accordingly, respondent's motion to dismiss pursuant to Fed. R. Civ. P. 12(b)(5) is granted. See *id.*

Notwithstanding the foregoing, petitioner, on December 11, 2012, filed an amended certificate of service which indicates that petitioner served the petition to cancel on respondent by mail on that date.

A petition to cancel a registration issued on the Principal Register on a claim under under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), may be filed up to five years from the issuance of the registration. See Trademark Act Section 14(3), 15 U.S.C. Section 1064(3). Because the involved registration was issued on September 21, 2010, petitioner has until the fifth anniversary of the date of the registration, i.e., September 21, 2015, to file a petition to cancel asserting a Section 2(d) claim.

Petitioner acted promptly in response to the motion to dismiss to correct its insufficient service. Given that this petition would not be time-barred as of the date of petitioner's compliance with the service requirement, the Board will not dismiss this petition as a nullity but instead will accord the petition a new filing date of December 11, 2012, the filing date of its amended certificate of service. See *Equine Touch Foundation Inc. v. Equinology Inc.*, 91 USPQ2d 1943, 1945 (TTAB 2009).

Pespondent's new attorney Tanya Marie Curcio filed the motion to dismiss. See Trademark Rules 2.17(b) and (c). Accordingly, Ms. Curcio and the firm of Hinckley Allen Snyder LLP are recognized as respondent's counsel of record in this proceeding.

Proceedings herein are resumed. Dates are reset as follows.

Answer Due	**2/14/2013**
Deadline for Discovery Conference	**3/16/2013**
Discovery Opens	**3/16/2013**
Initial Disclosures Due	**4/15/2013**
Expert Disclosures Due	**8/13/2013**
Discovery Closes	**9/12/2013**
Plaintiff's Pretrial Disclosures Due	**10/27/2013**
Plaintiff's 30-day Trial Period Ends	**12/11/2013**
Defendant's Pretrial Disclosures Due	**12/26/2013**
Defendant's 30-day Trial Period Ends	**2/9/2014**
Plaintiff's Rebuttal Disclosures Due	**2/24/2014**
Plaintiff's 15-day Rebuttal Period Ends	**3/26/2014**

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after

completion of the taking of testimony. Trademark Rule 2.l25.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.

If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.