

ESTTA Tracking number: **ESTTA565574**

Filing date: **10/17/2013**

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 | National Institute for Social Media | | |
| Entity | limited liability corporation | Citizenship | Minnesota |
| Address | P.O. Box 19620 Minneapolis, MN 55419 UNITED STATES | | |

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| Attorney information | Christopher M. Dolan BRINKS GILSON & LIONE P.O. Box 10395 Chicago, IL 60610 UNITED STATES officeactions@brinksgilson.com, aavsec@brinksgilson.com, cdolan@brinksgilson.com, rrios@brinksgilson.com Phone:3123214200 |
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Registration Subject to Cancellation

| | | | |
|-----------------|---|-------------------|------------|
| Registration No | 4208089 | Registration date | 09/11/2012 |
| Registrant | PARADISE MEDIA VENTURES, LLC 4755 WEBB BRIDGE ROAD BOX 5394 ALPHARETTA, GA 30005 UNITED STATES | | |

Goods/Services Subject to Cancellation

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|---|
| Class 041. First Use: 2012/03/17 First Use In Commerce: 2012/03/17 All goods and services in the class are cancelled, namely: Education services, namely, providing web based training in the field of social media management |
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Grounds for Cancellation

| | |
|-------------|---|
| Genericness | Trademark Act section 23 |
| Other | The mark is incapable of serving a trademark function and is incapable of acquiring distinctiveness or secondary meaning. Registrant does not have exclusive use. See attached Petition for Cancellation. |

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| Attachments | NISM Petition to Cancel 10 17 13.pdf(47649 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 Overnight Courier on this date.

| | |
|-----------|--------------------------|
| Signature | <i>/Andrew J. Avsec/</i> |
| Name | Andrew J. Avsec |
| Date | 10/17/2013 |

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

**NATIONAL INSTITUTE FOR SOCIAL
MEDIA,**

Petitioner,

v.

PARADISE MEDIA VENTURES, LLC,

Registrant.

Cancellation No. _____

Reg. No.: 4,208,089

Mark: Certified Social Media Strategist

Registered: September 11, 2012

PETITION FOR CANCELLATION

In the matter of Trademark Registration No. 4,208,089 for the designation Certified Social Media Strategist registered on the supplemental registry, which issued on September 11, 2012 to John Souza and was assigned on September 27, 2012 to Paradise Media Ventures, LLC (hereinafter called “Registrant”), National Institute for Social Media (hereinafter “Petitioner”), a limited liability corporation duly organized and existing under the laws of the state of Minnesota with its principal place of business in Minneapolis, Minnesota, believes that it is being and will continue to be damaged by the registration and hereby petitions to cancel the registration of said mark.

The grounds for the petition to cancel are as follows:

1. Petitioner has been and is now extensively engaged in the business of selling various services in interstate commerce, including providing social media certification and social media education for professional social media practitioners via the Internet. Petitioner has extensively used, advertised and promoted the mark NISM Social Media Strategist Certification in connection with Petitioner’s services.

2. Registration No. 4,208,089 covers the following services “Education services, namely providing web based training in the field of social media management.” in International Class 41.
3. Registrant provides web based training for certification in the field of social media management under Registration No. 4,208,089.
4. Petitioner and Registrant are competitors in the field of social media management education and social media certification.
5. “Social media strategy” is a framework that an organization creates that applies to using online social media and marketing software platforms.
6. “Social media strategist” is a job, role or position that is created by an organization to describe the person / individual who is fully or partially responsible for creating, implementing and managing the social media strategy for an organization.
7. “Certification” is a voluntary process by which individuals are evaluated against predetermined standards for knowledge, skills, or competencies. Participants who demonstrate that they meet the standards by successfully completing an assessment process are granted the certification or the act of making something official: the act of certifying something. To be “certified” means to have earned certification.
8. “Certified Social Media Strategist” is an individual or group of individuals who have been awarded a certification to perform the job, role or position of “Social Media Strategist” for an organization.
9. It is standard practice in the social media industry and the media to refer to social media professionals as social media strategists and to refer to social media management as social media strategy.

10. It is standard practice in the social media industry and media to refer to social media professionals as social media strategists who have received certifications as certified social media strategists.
11. The relevant consumers and the public use and/or understand the mark in Registration No. 4,208,089 “Certified Social Media Strategist” to refer to the genus or category of Registrant’s services and the mark should be cancelled because it is generic.
12. The relevant consumers and the public use and/or understands the phrase “Social Media Strategist,” with or without the generic modifier “certified,” in Registration No. 4,208,089 to refer to the genus or category of Registrant’s services and the mark should be cancelled because it is generic.
13. None of the words or phrases “certified” “social media” or “strategist” is capable of serving a source identifying trademark function either alone or in combinations such as “certified social media strategist,” and Registration No. 4,208,089 should be cancelled because the mark is generic.
14. Registrant has sought to bar third party uses of the phrase “certified social media strategist” and various combinations of the phrase, with and without additional elements and modifiers, on the basis of Registration No. 4,208,089.
15. If providers of social media services and consumers of those services and the public were prevented from utilizing these words and phrases alone, in various combinations or in the combination “certified social media strategist” those providers, consumers and the public would be harmed.
16. The registered mark has been used and is used extensively by third parties without Registrant’s authorization. Accordingly, Registrant’s mark is not in lawful use in

commerce and cannot be maintained on the Supplemental Register under Section 23(a) of the Lanham Act. Registrant does not have exclusive use of the mark and the registration should be cancelled on this additional ground.

17. The phrase “social media strategist” has been used and is used extensively by third parties without Registrant’s authorization with or without the generic modifier “certified.” Accordingly, Registrant’s mark is not in lawful use in commerce and cannot be maintained on the Supplemental Register under Section 23(a) of the Lanham Act. Registrant does not have exclusive use of the mark and the registration should be cancelled on this ground.

18. The phrase “social media strategy” has been used and is used extensively by third parties without Registrant’s authorization with or without the generic modifier “certified.” Accordingly, Registrant’s mark is not in lawful use in commerce and cannot be maintained on the Supplemental Register under Section 23(a) of the Lanham Act. Registrant does not have exclusive use of the mark and the registration should be cancelled on this ground.

19. The registered mark is not distinctive of registrant’s services.

20. The registered mark is incapable of serving a trademark function and is incapable of acquiring distinctiveness or secondary meaning and it should be cancelled.

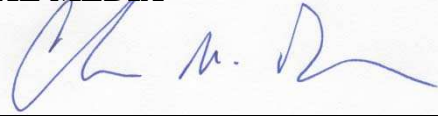
WHEREFORE, Petitioner prays that the Trademark Trial and Appeal Board sustain this Petition for Cancellation and that it cancel Registration No. 4,208,089.

The Commissioner is hereby authorized to charge the filing fee for this Petition to
Cancel to Deposit Account No. 23-1925.

Respectfully Submitted,

**NATIONAL INSTITUTE FOR
SOCIAL MEDIA**

By: _____

A handwritten signature in blue ink, appearing to read "C. M. Dolan", is written over a light gray rectangular background.

Christopher M. Dolan
Andrew J. Avsec
BRINKS GILSON & LIONE
455 N. Cityfront Plaza Drive
Chicago, Illinois 60611-5599
(312) 321-4200

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on October 17, 2013, a true and correct copy of the foregoing Petition for Cancellation was served upon Registrant by Federal Express delivery in an envelope addressed as follows:

John Souza
Paradise Media Ventures, LLC
4755 Webb Bridge Road
Box 5394
Alpharetta, Georgia 30005

/Andrew J. Avsec/
