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Filing date: **11/12/2015**

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

Proceeding	92059657
Party	Plaintiff New Jersey Turnpike Authority
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Date	11/12/2015
Attachments	First Amended Petition for Cancellation.pdf(3890244 bytes)

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

In the matter of Registration No. 4,056,183 issued on November 15, 2011.

NEW JERSEY TURNPIKE
AUTHORITY,

Petitioner,

v.

BOARDWALK PIZZA, INC.

Registrant.

Cancellation No. 92059657

BOX TTAB NO FEE
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

FIRST AMENDED PETITION FOR CANCELLATION

In the matter of the registration of the service mark depicted below:



Registration No. 4,056,183, issued on November 15, 2011 (hereinafter referred to as "Registrant's Mark"), owned by Boardwalk Pizza, Inc., a Florida corporation with a principal address of 20 High Point Road, Tavernier, Florida 33070 ("Registrant"), which

registration covers restaurants in International Class 43, New Jersey Turnpike Authority (hereinafter "Petitioner"), who is organized and existing under the laws of the State of New Jersey with its principal place of business located at 581 Main Street, Woodbridge, New Jersey 07095, believes it is being damaged and will continue to be damaged by such registration and hereby petitions for the cancellation thereof.

1. Petitioner is the owner of the iconic Garden State Parkway Logo, which mark it has been using in connection with highway management and maintenance services and travel information services since at least as early as 1956. Petitioner's Garden State Parkway Logo is depicted below:



2. Petitioner's Garden State Parkway Logo is utilized in connection with Plaintiff's operation of one of the most iconic and well known highways in the United States, the Garden State Parkway. The Garden State Parkway is travelled by many millions of people each year and Petitioner's roadway has become one of the most symbolic fixtures within the State of New Jersey. The Garden State Parkway opened in 1954 and stretches from the New York State line down to the end of the New Jersey Shore.

3. Petitioner is the owner of United States Service Mark Registration No. 2,452,349 for its Garden State Parkway Logo in International Class 37 for highway

management and maintenance services; and in Class 39 for travel information services. A printout from the United States Patent & Trademark Office's Online Database of Plaintiff's registration is attached hereto as **Tab A**.

4. In addition to the provision of its highway related services, Petitioner is the owner of several pending United States Trademark applications covering various categories of goods. Moreover, there are many service areas along the Garden State Parkway that include restaurants, many of which feature pizza.

5. Petitioner has invested a substantial amount of time, money and other resources advertising, promoting, marketing and publicizing its services provided under the Garden State Parkway Logo mark. As a result of Petitioner's substantial advertising, marketing and promotional efforts, the Garden State Parkway Logo mark has acquired substantial consumer recognition and goodwill and has achieved the status of being a famous mark. The Garden State Parkway Logo mark has become an important source indicator which identifies Petitioner's services to consumers and motorists both in the State of New Jersey, and elsewhere throughout the United States. For all of the foregoing reasons, the Garden State Parkway Logo mark is an exceedingly valuable asset of Petitioner.

6. Over the years, many third parties have attempted to trade off of the fame and notoriety associated with Petitioner's Garden State Parkway Logo and Petitioner has actively and successfully policed against infringing third party uses of its mark. Petitioner's successful policing efforts have served to even further enhance the strength of Petitioner's Garden State Parkway Logo mark.

7. Registrant has obtained the subject registration for the mark depicted below in International Class 43 for restaurants. There is no question that the design portion of Registrant's Mark was appropriated from Petitioner's Garden State Parkway Logo mark in an effort to trade upon the fame and tremendous goodwill associated with Petitioner's Mark. Side by side comparisons of Petitioner's Garden State Parkway Logo mark and the mark covered by the subject registration are depicted below:

Petitioner's Mark



Registrant's Mark



8. Petitioner believes that it will be damaged by the continued registration of Registration No. 4,056,183 and hereby petitions for cancellation of same on the grounds set forth herein.

COUNT I – Likelihood of Confusion

9. Petitioner repeats and re-alleges each and every allegation set forth in Paragraphs 1-8 as though fully set forth herein.

10. Registrant's Mark depicted above so resembles Petitioner's Mark as to be likely, when applied to Registrant's services, to cause confusion, mistake and/or to deceive as well as cause damage to Petitioner and the consuming public.

11. Registrant's Mark was undoubtedly appropriated from and is confusingly similar to Petitioner's Mark such that the continued registration of Registrant's Mark would be inconsistent with, and damaging to, Petitioner's prior rights in and to its

Garden State Parkway Logo mark. In fact, not only has Registrant willfully and blatantly misappropriated Petitioner's Mark in connection with Registrant's Mark, Registrant also prominently displays an exact replica of Petitioner's Mark in Registrant's establishments in an effort to trade upon the fame and goodwill associated with Petitioner's Mark.

12. Petitioner has priority of use in connection with its Garden State Parkway Logo mark by virtue of its earlier date of first use of said mark over any date that can be established by Registrant in connection with the subject mark.

13. Petitioner's Garden State Parkway Logo mark is entitled to a wide scope of protection and therefore Petitioner can easily bridge any gap between the services of the respective parties. Moreover, there are many service areas along the Garden State Parkway that include restaurants, many of which feature pizza. As such, consumers who encounter Registrant's mark as used in connection with its restaurant services will mistakenly assume that Registrant's use of the mark is authorized by Petitioner and/or that the food items served at Registrant's restaurant are associated with the food served at the restaurants located at the service areas on the Garden State Parkway.

14. Petitioner will be damaged by the continued registration of Registrant's Mark because such registration is supporting and assisting Registrant in the confusing and misleading use of Registrant's mark.

COUNT II – Abandonment

15. Petitioner repeats and re-alleges each and every allegation set forth in Paragraphs 1-14 as though fully set forth herein.

16. Registrant is no longer providing restaurant services or actively conducting business. In fact, Registrant is in the process of formally dissolving.

17. Registrant has discontinued use of the mark that is the subject of Registration No. 4,056,183 in connection with any services prior to the filing of this Petition for Cancellation, and Registrant has no intent to resume use.

18. As a result of Registrant's failure to use the subject mark in connection with restaurants (or any other goods or services for that matter), with no intent to resume such use, the mark that is the subject of Registration No. 4,056,183 has been abandoned in accordance with Section 45 of the Trademark Act.

19. Since, upon information and belief, Registrant has abandoned the mark covered by 4,056,183, the subject registration should be cancelled.

20. Petitioner will be damaged by the continued registration of Registrant's Mark because the subject registration is confusingly similar to Petitioner's Mark and such registration is supporting and assisting Registrant and its affiliates in the confusing and misleading use of Registrant's mark.

WHEREFORE, Petitioner believes that it will be damaged by the continued registration of Registrant's Mark and prays that its petition to cancel said registration be sustained and that Registration No. 4, 056,183 be cancelled.

This Petition for Cancellation is being filed electronically.

Respectfully submitted,

NEW JERSEY TURNPIKE AUTHORITY

By: _____


Ronald L. Israel
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(973) 530-2245
Attorneys for Petitioner

Dated: November 12, 2015

CERTIFICATE OF SERVICE

It is hereby certified that a true and correct copy of the foregoing First Amended Petition For Cancellation was served via e-mail and first class mail on the Attorney for Registrant, Justin M. Klein, Marks & Klein, LLP, 63 Riverside Avenue, Red Bank, New Jersey 07701.


ABIGAIL J. REMORE
CHIESA SHAHINIAN & GIANTOMASI PC
Attorneys for Petitioner

Dated: November 12, 2015

TAB A



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Word Mark GARDEN STATE PARKWAY
Goods and Services IC 037. US 100 103 106. G & S: HIGHWAY MANAGEMENT AND MAINTENANCE SERVICES. FIRST USE: 19560000. FIRST USE IN COMMERCE: 19560000
 IC 039. US 100 105. G & S: TRAVEL INFORMATION SERVICES. FIRST USE: 19560000. FIRST USE IN COMMERCE: 19560000
Mark Drawing Code (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code 01.17.11 - Maps of states of the United States, excluding Texas
 26.01.04 - Circles with two breaks or divided in the middle
 26.01.18 - Circles, three or more concentric; Concentric circles, three or more; Three or more concentric circles
Serial Number 75575699
Filing Date October 22, 1998
Current Basis 1A
Original Filing Basis 1A
Published for Opposition February 27, 2001
Registration Number 2452349
Registration Date May 22, 2001
Owner (REGISTRANT) NEW JERSEY HIGHWAY AUTHORITY STATE AGENCY NEW JERSEY The

Garden State Arts Center P.O. Box 5050 Woodbridge NEW JERSEY 070955050

(LAST LISTED OWNER) NEW JERSEY TURNPIKE AUTHORITY STATE AGENCY NEW JERSEY P.O. BOX 5042 WOODBRIDGE NEW JERSEY 07095

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record PETER NUSSBAUM

Type of Mark SERVICE MARK

Register PRINCIPAL-2(F)-IN PART

Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20110728.

Renewal 1ST RENEWAL 20110728

Live/Dead Indicator LIVE

Distinctiveness Limitation Statement as to "GARDEN STATE PARKWAY"

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Generated on: This page was generated by TSDR on 2014-07-21 15:04:34 EDT**Mark:** GARDEN STATE PARKWAY**US Serial Number:** 75575699**Application Filing Date:** Oct. 22, 1998**US Registration Number:** 2452349**Registration Date:** May 22, 2001**Register:** Principal**Mark Type:** Service Mark**Status:** The registration has been renewed.**Status Date:** Jul. 28, 2011**Publication Date:** Feb. 27, 2001

Mark Information

Goods and Services

Basis Information (Case Level)

Current Owner(s) Information

Owner Name: NEW JERSEY TURNPIKE AUTHORITY**Owner Address:** P.O. BOX 5042
WOODBRIDGE, NEW JERSEY 07095
UNITED STATES**Legal Entity Type:** STATE AGENCY**State or Country Where
Organized:** NEW JERSE

Attorney/Correspondence Information

Prosecution History

Maintenance Filings or Post Registration Information

TM Staff and Location Information

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