

ESTTA Tracking number: **ESTTA768082**

Filing date: **08/31/2016**

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	Made By Grizzly, Inc.		
Entity	Corporation	Citizenship	California
Address	1425 UNIVERSITY AVE. STE C SAN DIEGO, CA 92103 UNITED STATES		

Attorney information	Kieran de Terra Wilkinson Mazzeo PC 705 16TH ST. STE 200B SAN DIEGO, CA 92101 UNITED STATES kieran@wilkinsonmazzeo.com Phone:6192898184		
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Registrations Subject to Cancellation

Registration No	3218108	Registration date	03/13/2007
Registrant	DOMINION ENTERPRISES 100 W. PLUME STREET NORFOLK, VA 23510 UNITED STATES		

Goods/Services Subject to Cancellation

Class 042. First Use: 1998/12/00 First Use In Commerce: 1998/12/00
All goods and services in the class are cancelled, namely: design, creation, and maintenance of web-sites for others in the field of real estate

Grounds for Cancellation

Abandonment	Trademark Act Section 14(3)		
Fraud on the USPTO	Trademark Act Section 14(3); In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)		
Registration No	3218117	Registration date	03/13/2007
Registrant	DOMINION ENTERPRISES 150 Granby Street NORFOLK, VA 23510 UNITED STATES		

Goods/Services Subject to Cancellation

Class 042. First Use: 2006/05/05 First Use In Commerce: 2006/05/05
All goods and services in the class are cancelled, namely: design, creation, and maintenance of web-sites for others in the field of real estate

Grounds for Cancellation

Abandonment	Trademark Act Section 14(3)
Fraud on the USPTO	Trademark Act Section 14(3); In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)

Attachments	GRZ Cancellation Pleading_FINAL.pdf(3417128 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	/Kieran de Terra/
Name	Kieran de Terra
Date	08/31/2016

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

3 In the matter of Registration Nos. 3218108 and 3218117

4 Both registered March 13, 2007

5 Marks: GRIZZLY DESIGNS and GRIZZLY DESIGNS (composite mark)

6
7 MADE BY GRIZZLY, INC.)

8 Petitioner,)

9 vs.)

10 DOMINION ENTERPRISES,)

Cancellation No.: _____

11 Registrant.)
12)
13)
14)
15)

16 **PETITION FOR CANCELLATION**

17 This petition for cancellation is made by Made By Grizzly, Inc. (“Petitioner”), a California
18 corporation with a business address of 1425 University Ave., STE C, San Diego, CA 92103.
19 Petitioner believes that it has been and will continue to be damaged by U.S. Trademark Registration
20 Nos. 3218108 and 3218117 for the marks GRIZZLY DESIGNS and GRIZZLY DESIGNS
21 (composite mark) respectively (hereinafter, referred to collectively as “Registrant’s Marks” or
22 “Marks”). Both marks are currently registered in International Class 42, and Petitioner hereby
23 request cancellation of each pursuant to Section 14(3) of the Lanham Trademark Act of 1946
24 (“Lanham Act”). (15 U.S.C. § 1064(3).)

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1 As grounds for cancellation, Petitioner hereby alleges the following:

2 1. Petitioner adopted, and has continuously used, the mark GRIZZLY in
3 commerce since at least as early as December 1, 2012 up until the present time, in connection with
4 “Brand concept and brand development services for corporate clients; Marketing consulting;
5 Marketing plan development; Marketing services, namely, creating corporate logos for others;
6 Advertising and marketing; Branding services, namely, consulting, development, management and
7 marketing of brands for businesses and/or individuals; Consulting services in the field of internet
8 marketing; Creative marketing design services,” all in International Class 43.

9 2. On May 6, 2016, Petitioner filed an application for federal trademark
10 registration of its mark "GRIZZLY," namely U.S. Application Serial No. 87027862 ("Petitioner's
11 Application"). (See Exhibit A).

12 3. Petitioner's Application is currently pending before the U.S. Patent and
13 Trademark Office (“USPTO”). Petitioner will be requesting suspension of action in Petitioner's
14 Application pending resolution of this cancellation proceeding.

15 4. Petitioner's Application was rejected on May 23, 2016, primarily due to a
16 Section 2(d) likelihood of confusion refusal citing Registrant's marks (the only additional issue with
17 Petitioner's Application is a Significance Inquiry as to whether “Grizzly” is a “term of art” within
18 Petitioner's industry, or whether it is a geographic identifier, which is easily curable – it is neither).

19 5. Registrant's application for the mark GRIZZLY DESIGNS (Reg. No.
20 3218108) was filed on June 30, 2006, and Registrant's application for the mark GRIZZLY
21 DESIGNS (composite mark) (Reg. No. 3218117) was filed on July 19, 2006. For both marks,
22 Registrant asserted a Section 1(a) current use basis, stating that the earliest use of the mark was May
23 5, 2006.

24 6. Registrant obtained U.S. Trademark Registration Nos. 3218108 and 3218117
25 on March 13, 2007 for the marks GRIZZLY DESIGNS and GRIZZLY DESIGNS (composite
26 mark) respectively, for use with the “design, creation, and maintenance of websites for others in the
27 field of real estate.”
28

1 7. Both of Registrant’s Marks have been, at all times, owned by either Trader
2 Publishing Company, or Dominion Enterprises.

3 8. Upon information and belief, both GRIZZLY DESIGNS and GRIZZLY
4 DESIGNS (composite mark) applications were filed by Trader Publishing Company, a general
5 partnership comprised of TPI, Inc., a Delaware corporation, and LTM Company, a Virginia general
6 partnership, comprised of LTM Properties, Inc., a corporation organized under the laws of Virginia,
7 and LTM Holdings, Inc., a corporation organized under the laws of Virginia (“Trader Publishing
8 Company”).

9 9. Upon information and belief, the general partnership of Trader Publishing
10 Company is now Dominion Enterprises, a general partnership comprised of ATC Holdings, Inc., a
11 Nevada corporation, and LTM Company, a Virginia Limited Partnership, comprised of LTM
12 Investments, Inc., a Nevada corporation, and LTM Holdings, Inc., a Virginia corporation
13 (“Dominion Enterprises”).

14 10. In the Trademark Status and Document Retrieval (“TSDR”) system database,
15 Dominion Enterprises is listed on the Registration Certificate for both GRIZZLY DESIGNS, and
16 GRIZZLY DESIGNS (composite mark).

17 11. In the TSDR system database, both Trader Publishing Company and
18 Registrant are listed as having an address of 100 W. Plume St., Norfolk, Virginia, United States,
19 23510.

20 12. Upon information and belief, Registrant was only using the Marks on its
21 website, which, at the time of registration, was found at the domain
22 <http://www.grizzlydesigns.com>. Petitioner can identify no evidence of *any* use of the marks
23 GRIZZLY DESIGNS, and GRIZZLY DESIGNS (composite mark) in U.S. commerce since at least
24 April 12, 2012, according to the Internet Archival tool “The Wayback Machine”
25 (<https://archive.org/web/>). Indeed, as of April 12, 2012, the domain <http://www.grizzlydesigns.com>
26 has redirected to the domain <http://connect.homes.com/>, a separate domain also owned by
27 Dominion Enterprises. Neither of Registrant’s Marks appear anywhere on
28 <http://connect.homes.com/>.

1 13. In the TSDR system database, Registrant submitted the same Specimen of
2 Use for both Marks on March 6, 2013, as the basis for its Section 8 Declaration of Use. (Exhibit B.)
3 This Specimen was a screenshot of Registrant’s website showing use of the Marks, with the date in
4 the header showing March 5, 2013. The Specimens, however, appear to have mislead the USPTO
5 due to the fact that (a) the website’s URL (<http://www.grizzlydesigns.com>) has redirected to
6 <http://connect.homes.com/> since April 12, 2012, meaning that the website containing the Marks was
7 not accessible to the public at that time, and (b) the website’s code contains a JavaScript line that
8 automatically updates the date displayed on the header to whatever date the visitor views the page,
9 making it an unreliable date stamp. (See Exhibit C.) Thus, Registrant appears to have committed
10 fraud on the USPTO by submitting a Section 8 Declaration of Use for a mark it was no longer using
11 in commerce.

12 14. Upon information and belief, Registrant has not used the marks GRIZZLY
13 DESIGNS and GRIZZLY DESIGNS (composite mark) in U.S. commerce for at least a consecutive
14 three-year period with respect to any of the services for which it was registered, without a valid
15 excuse for non-use, in violation of 15 U.S.C. §1064(3). Consequently, Registrant has abandoned the
16 marks GRIZZLY DESIGNS and GRIZZLY DESIGNS (composite mark) as defined in 15 U.S.C.
17 §1127. Registrant’s non-use of the Marks for at least a consecutive three-year period is prima facie
18 evidence of Registrant’s abandonment of the Marks.

19 15. Petitioner is being damaged by the continued existence of Registrant’s
20 registrations for the marks GRIZZLY DESIGNS, and GRIZZLY DESIGNS (composite mark),
21 because Petitioner’s Application is now under a Section 2(d) refusal with the only basis for such
22 being the existence of Registrant’s Marks. Upon information and belief, Registrant is not using the
23 registered Marks in commerce, and the Registered Marks are improperly impeding Petitioner from
24 registering its own trademark.

25 16. Allowing Registrant’s Marks to continue to remain on the Federal Register
26 would run counter to the public interest, specifically with respect to allowing the public to know
27 what marks are truly protected. Members of the public will be deceived into thinking that
28 Registrant’s Marks are valid, when in fact the Marks are not being used and are invalid. Thus, the

1 Marks should be available for use by other legitimate users, including Petitioner. Indeed, unless
2 Registrant's Marks are cancelled, Petitioner's Application will likely receive a final rejection from
3 the USPTO due to the similarity between the two marks. Thus, Petitioner has been, and will
4 continue to be, damaged unless this petition is sustained.

5 WHEREFORE, the Petitioner respectfully requests that the Trademark Trial and
6 Appeal Board grant its petition and cancel U.S. Registration Nos. 3218108 and 3218117 for the
7 marks GRIZZLY DESIGNS and GRIZZLY DESIGNS (composite mark), respectively, in their
8 entirety.

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As noted in the electronic filing to which this document is attached, the undersigned has authorized payment by deposit account of the filing fee of \$300.00. A copy of this Petition for Cancellation is submitted herewith.

DATED: August 31, 2016

By: 

Kieran de Terra, Esq.

Wilkinson Mazzeo PC
705 16th St., Ste 200B
San Diego, CA 92101
Tel. (619) 289-8184
Attorney for Petitioner

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Petition for Cancellation was deposited in the United States mail, first-class mail, postage prepaid, to Registrant at the address and on the date indicated below:

100 W. PLUME STREET
NORFOLK, VIRGINIA
UNITED STATES 23510

Date: 08/31/16

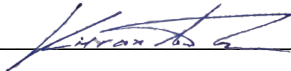
By: 
Kieran de Terra

EXHIBIT A

GRIZZLY

Word Mark GRIZZLY

Goods and Services IC 035. US 100 101 102. G & S: Brand concept and brand development services for corporate clients; Marketing consulting; Marketing plan development; Marketing services, namely, creating corporate logos for others; Advertising and marketing; Branding services, namely, consulting, development, management and marketing of brands for businesses and/or individuals; Consulting services in the field of internet marketing; Creative marketing design services. FIRST USE: 20121201. FIRST USE IN COMMERCE: 20121201

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 87027862

Filing Date May 6, 2016

Current Basis 1A

Original Filing Basis 1A

Owner (APPLICANT) MADE BY GRIZZLY, INC. CORPORATION CALIFORNIA 1425 UNIVERSITY AVE STE C SAN DIEGO CALIFORNIA 92103

Attorney of Record KIERAN DE TERRA

Type of Mark SERVICE MARK

Register PRINCIPAL

Live/Dead Indicator LIVE

EXHIBIT B

Grizzly Designs, Web Site Design And Hosting For Real Estate Professionals



[Home Page](#)

[Web Site Features](#)

[Sample Web Sites](#)

[About Our Company](#)

[Preferred Vendors](#)

[MLS Listing Providers](#)

Good Afternoon, Today Is Tuesday, March 5, 2013

Award Winning Web Sites

Custom Graphics And Colors

Local Links For Your Area

Customer Friendly Forms And E-Mail

Grizzly Designs develops Web Sites that are easy for your clients to use.

Customized MLS Search and Email "HOT SHEET" with NEW listings to your potential buyers!

You can NOW have your OWN MLS search engine, right on your site! Allow your customers to search through all available homes for sale, right from your own website. This feature is available for members of MAXmls®, EBRD®, REINFORLINKS®, METROLIST®, BAREIS® and SANDICOR® MLS. Email us for more information.

Using this latest in search technology, your website buyers will be able to see the latest properties that come up for sale. In fact, your buyers will be able to sign up to receive a daily **HOT SHEET** featuring the newest listings. This email looks like it comes from you, and gives you more chances to follow up. Plus, when each buyer signs up through your website, you automatically receive an email notification of that buyers information, email address and search criteria so you can follow up!

The question asked most often is, "How can I be different from other sites?" The answer is simple: offer your buyers the opportunity to search for the latest listings through your website.

Email or call us for more information!

[Click here for a sample of the search engine.](#)

We include Links to:

- Homes For Sale
- Mortgage Calculators
- Local Schools
- Parks And Recreation
- Local Transportation Information
- Local Attractions, Theatres, Activities...

...Everything a buyer wants to know about the cities and areas you serve.

Check Out Some Of The Grizzly's Customers

- [Samples Of The Grizzly Designs Web Package](#)

If you are an agent looking for a presence on the Internet, Grizzly Designs can build an affordable site

<http://www.grizzlydesigns.com/index.cfm>[3/5/2013 3:48:31 PM]

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Grizzly Designs, Web Site Design And Hosting For Real Estate Professionals



you will be proud to show off

Agents! Click here to get the free graphics program you can use to resize and compress photos of your listings. It's very important that you size the pictures correctly, to be able to upload them to your website. [Click here to download the program](#), save it to disk (I recommend saving it to your desktop to find it easily) and double click to install the program. Just say yes or next to everything, and it installs in just a moment. The icon it creates on your desktop looks like a red, flat cat with a mask, click that to start the program.



[HOME](#) | [ABOUT](#) | [SAMPLES](#) | [FEATURES](#) | [VENDORS](#) | [MLR](#)

Grizzly Designs, Web Design For Real Estate Professionals
grizzly@grizzlydesigns.com

Sales: 925.449.2076

Email and Website Support:
925.449.2174 or 877.283.3684

Grizzly Designs
c/o Homes.com
325 John Knox Road
Building L., Suite 200
Tallahassee, FL 32303



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EXHIBIT C

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The screenshot shows a web browser window displaying the Grizzly Designs website. The browser's address bar shows the URL `http://grizzlydesigns.com/`. The website features a navigation menu on the left with links such as "Home Page", "Web Site Features", "Sample Web Sites", "About Our Company", "Preferred Vendors", and "MLS Listing Providers". The main content area displays a greeting: "Good Afternoon, Today is Tuesday, August 16, 2016", followed by a list of services: "Award Winning Web Sites", "Local Links For Your Area", "Custom Graphics And Colors", and "Customer Friendly Forms And E-Mail". Below this, it advertises "Customized MLS Search and Email 'HOT SHEET' with NEW listings to your potential buyers!".

The browser's developer tools are open, showing the source code for the page. The selected line of code is a JavaScript snippet that dynamically updates the date in the page header:

```
<script language="JavaScript">!-- Greeting(new Date()); document.write(StringTime(new Date())) --></script> - $0
```