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

Proceeding	92067609
Party	Plaintiff David B. Eaves and Chicago Stagehand, LLC
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Submission	Motion to Amend Pleading/Amended Pleading
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Signature	/ Pawel A. Fraczek /
Date	04/13/2018
Attachments	Motion for Leave to Amend Pet 5331637.pdf(177674 bytes )

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

David B. Eaves and Chicago Stagehand, LLC,

Petitioners,

v.

Theatrical Stage Employees Union Local No. 2 of  
the International Alliance of Theatrical Stage  
Employees and Moving Picture Technicians,  
Artists and Allied Crafts of the United States and  
Canada,

Respondent.

Cancellation No. : 92/067,609 (Parent)  
*Consolidated with*  
Cancellation No. : 92/067,670

Mark: CHICAGO STAGEHANDS

Registration No. : 4,303,933  
Registration No. : 5,331,637

**MOTION FOR LEAVE TO FILE AN AMENDED PETITION TO  
CANCEL REGISTRATION NO. 5,331,637**

Pursuant to Fed. R. Civ. P. 15, 37 CFR Section §2.115, and TBMP § 507, Petitioners, David Eaves and Chicago Stagehand, LLC (“Petitioners”), request leave to amend Petitioner’s Petition to Cancel Registration No. 5,331,637 (“Registration”), and, in support thereof, state as follows:

1. Petitioners request leave to amend the Petition to Cancel to amplify and/or clarify the grounds for cancellation. Petitioners are not adding new grounds, claims, parties, or goods or services to the Petition for Cancellation.

2. According to Fed. R. Civ. P. 15 and TBMP §507 and the cases cited therein, a party may amend its pleading and is liberally allowed leave when justice so requires. Petitioners are also allowed, as a matter of course, to amend the Petition to Cancel within 21 days after a motion under Rule 12(b). TBMP §507.

3. Respondent’s Motion to Dismiss the Petition for Cancellation in this proceeding was filed on March 27, 2018. This Motion is being filed within the 21 day period.

4. At this early stage of this proceeding, Respondent will not be prejudiced by this Board allowing Petitioners to amend the Petition to Cancel.

5. On March 30, 2018, the Board consolidated this proceeding with Cancellation No. 92/067,609, also the subject of a Motion to Dismiss filed on March 27, 2018, and directed that a consolidated response to both Motions to Dismiss be filed on or before April 16, 2018. [Canc. No. 92,067/609, TTABVUE 13 and Canc. No. 92,067/670, TTABVUE 8].

6. Pursuant to the Board's statement that "each proceeding retains its separate character," Petitioners are filing two separate motions and two amended petitions, one for each proceeding, but will file a combined Motion to Amend the Petitions to Cancel and a combined Petition to Cancel if the Board so directs.

7. A clean copy of the Amended Petition to Cancel is attached hereto as Exhibit A.

8. A red-lined copy of the Amended Petition to Cancel is attached hereto as Exhibit B.

In conclusion, Petitioners request that the Board grant this motion for leave to file their Amended Petition to Cancel and for such other and further relief as it deems appropriate.

Dated: April 13, 2018

Respectfully Submitted by:

          / Pawel A. Fraczek /          

Attorney for Petitioners  
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**CERTIFICATE OF SERVICE**

I, Pawel A. Fraczek, certify that a true and complete copy of the foregoing MOTION FOR LEAVE TO FILE AN AMENDED PETITION TO CANCEL REGISTRATION NO. 5,331,637 and related exhibits have been served on Robert S. Rigg and John Burke, on April 13, 2018, via electronic mail addressed to:

Robert S. Rigg  
John Burke  
Vedder Price PC  
222 N LaSalle St  
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/ Pawel A. Fraczek /

Attorney for Petitioners

Pawel A. Fraczek  
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Phone: 312-609-6611  
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# Exhibit A



field of labor and technical support in live corporate, concert and special events” (Ser. No. 86/399, 091) (“Eaves App”).

3. Chicago Stagehand, LLC has been in business since late 2008 and has invested substantial effort and money into developing the CHICAGO STAGEHAND brand. It continues to do business and develop the CHICAGO STAGEHAND brand and will be damaged by the existence of Reg. No. ‘637.

4. Theatrical Stage Employees Union Local No. 2 of the International Alliance of Theatrical Stage Employees and Moving Picture Technicians, Artists and Allied Crafts of the United States and Canada, is an unincorporated association existing under the laws of the State of Illinois, having its principal place of business at 216 S. Jefferson St., Suite 400, Chicago, IL 60661 (“Respondent”).

5. Respondent is a labor union in the Chicagoland area and Respondent provides services self-described as “establishing committees with employers to promote improved relations between employers and unions; providing information regarding labor union services.” [See Serial No. 85/530,945.] Respondent’s activities include, among other things, organizing/providing support for strikes, negotiating/renegotiating Collective Bargaining Agreements, training, referrals to work and benefits for its members.

6. There are certain venues in the Chicagoland area with limited collective bargaining agreements at which both Petitioners and Respondent may provide stage crew services.

7. Since at least 2009, there are certain venues at which both Petitioners and Respondent compete for business. Further, Respondent learned of Petitioners’ CHICAGO STAGEHAND brand in 2009 when a venue with a limited collective bargaining agreement that used both union and non-union stage crews notified Respondent of Petitioners’ business.

8. On April 1, 2014, Respondent filed an application to register the mark CHICAGO STAGEHANDS for a collective membership mark “indicating membership in a union of stagehands” in Class 200 which application was assigned U.S. Serial No. 86/238,513 and matured into Reg. No. ‘637 on November 7, 2017 on the Supplemental Register.

9. Eaves App has been suspended on the basis of confusing similarity with Respondent's Reg. No. '637 and Respondent's application to register the same mark for union services which has been assigned Serial No. 85/530,945.

10. One of the Petitioners and Respondent were previously involved in a prior cancellation proceeding, *Theatrical Stage Employees Union Local No. 2 of the International Alliance of Theatrical Stage Employees and Moving Picture Technicians, Artists and Allied Crafts of the United States and Canada v. David Eaves* (Canc. No. 92/055,242) ("Canc. '242"), which resulted in the cancellation of Petitioner Eaves' CHICAGO STAGEHAND registration.

11. On April 1, 2014, during the pendency of Canc. '242, Respondent submitted its application which matured into Reg. No. '637 supplying as a specimen a hat with a logo on the front facing area ("Specimen") claiming use in commerce since 1950.

12. On information and belief and based on the evidence submitted by Respondent in Canc. '242, Respondent knowingly made material false representations regarding its dates of first use and its use of the words "Chicago Stagehands" as a collective membership mark in connection with its application to register the mark which is the subject matter of this petition with the intent to deceive the USPTO and to procure a trademark registration.

13. At the time of the filing of the Application, Respondent knew it did not have exclusive rights in the mark. Respondent's attorney signed the declaration to this Registration falsely affirming that no other person or corporation has a right to this Mark when he knew that Petitioners were using an almost identical mark for services that Respondent claims are similar.

14. Respondent claims 1950 as first use and first use in commerce but cannot provide any facts to support the claims in the Application to support this date. On information and belief and based on the evidence submitted by Respondent in Cancellation No. 92055242, Respondent did not give, sell, order, or produce hats, shirts, buttons, or any item during the claimed dates that demonstrate use of the mark claimed as a collective membership mark.

15. On information and belief and based on the evidence submitted by Respondent in Canc. '242, in the specific years between 1950 and until today, Respondent did not use the Mark as a collective membership mark either in Illinois or in interstate commerce as set forth in TMEP §§ 1302-1304.

16. On information and belief and based on the evidence submitted by Respondent in Canc. '242, Respondent did not exercise control the use of the mark claimed, through its by-laws or otherwise.

17. Respondent's counsel signed the declaration for Respondent's application to register CHICAGO STAGEHANDS for use as a collective membership mark with knowledge of the false statements of use and the intent of procuring a trademark registration.

18. In connection with Reg. No. '637, Respondent has disclaimed the word "stagehands" apart from the mark as shown. The entire mark is a two word standard character mark, CHICAGO STAGEHANDS. The only word not disclaimed is "Chicago."

19. Chicago is a large city in the United and geographically descriptive of the area in which Respondent and its members are located and operate.

20. In Respondent's companion application (Ser. No. 85/530,945) for the same mark CHICAGO STAGEHANDS for union services, Respondent conceded that the word "Chicago" in the mark CHICAGO STAGEHANDS was descriptive and disclaimed "Chicago" apart from the mark as shown.

21. In the view of the Examining Attorney reviewing the Eaves App, and the Board in its decision in Canc. '242 at page 25-26, there is a likelihood of confusion between Petitioners' mark and Respondent's mark when used in connection with the parties respective services.

22. For the reasons stated above, Respondent's Registration should be cancelled because: a) Respondent has committed Fraud on the United States Patent and Trademark Office during the filing of the Application for the Registration; b) Respondent did not and does not use the mark as a collective membership mark, and c) the mark is primarily merely descriptive in that it consists of two words, one of which is admittedly descriptive of the services and the other of which is geographically descriptive of the only location in which Respondent's members operate.



# Exhibit B

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

David B. Eaves and Chicago Stagehand, LLC,	)	
	)	
Petitioners,	)	
	)	
v.	)	<del>_____</del> Cancellation No. : <u>92/067,609(Parent)</u>
	)	<u>Consolidated with</u>
	)	<u>Cancellation No. : 92/067,670</u>
	)	
Theatrical Stage Employees Union Local	)	Mark: CHICAGO STAGEHANDS
No. 2 of the International Alliance of	)	
Theatrical Stage Employees and Moving	)	Registration No. : <del>5,331,637</del> : <u>4,303,933</u>
Picture Technicians, Artists and	)	<u>Registration No. : 5,331,637</u>
Allied Crafts of the United States	)	
and Canada,	)	
	)	
Respondent.	)	

**AMENDED PETITION FOR CANCELLATION TO CANCEL  
REGISTRATION NO. 5,331,637**

Petitioner, David B. Eaves, is an individual with a correspondence address through counsel at 111 West Washington St., Suite 1110, Chicago, IL 60602. ~~P~~petitioner, Chicago Stagehand, LLC, is a Limited Liability Company established under the laws of the state of Illinois in 2008, with its principal place of business at 1851 West Cuyler, 3<sup>rd</sup> Fl, Chicago, IL 60613. ~~(“ (collectively, “Petitioners”))~~. Petitioners have a real interest in the Mark CHICAGO STAGEHAND and are being damaged by U.S. Registration No. 5,331,637. ~~(“Reg. No. : ‘637”)~~. In support of the petition to cancel ~~U.S. Registration~~Reg. No. ~~5,331,637~~, Petitioners state as follows:

1. Chicago Stagehand, LLC is a sole member limited liability company, doing business as CHICAGO STAGEHAND. Chicago Stagehand, LLC provides freelance stage crew to live event venues and live events in the Chicagoland area including interstate commerce.

2. David B. Eaves is the owner of the Mark CHICAGO STAGEHAND and the owner of Chicago Stagehand, LLC, the applicant for the mark CHICAGO STAGEHAND for “employment staffing in the

field of labor and technical support in live corporate, concert and special events” (Ser. No. 86/399, 091) (“Eaves App”).

2.3. Chicago Stagehand, LLC has been in business since late 2008 and has invested substantial effort and money into developing the CHICAGO STAGEHAND brand. It continues to do business and develop the CHICAGO STAGEHAND brand and will be damaged by the existence of U.S. Registration No. 5,331,637. David B. Eaves is the owner of the Mark CHICAGO STAGEHAND and the owner of Chicago Stagehand, LLC, the applicant for the mark CHICAGO STAGEHAND for “employment staffing in the field of labor and technical support in live corporate, concert and special events” (U.S. Ser. No. 86/399, 091) and will be damaged by the existence of U.S. Registration Reg. No. ‘637. No. 5,331,637.

3.4. Theatrical Stage Employees Union Local No. 2 of the International Alliance of Theatrical Stage Employees and Moving Picture Technicians, Artists and Allied Crafts of the United States and Canada, is an unincorporated association existing under the laws of the State of Illinois, having its principal place of business at 216 S. Jefferson St., Suite 400, Chicago, IL 60661 (“Respondent”), is the owner of U.S. Registration No. 5,331,637 (“Registration”), issued on November 7, 2017 from application U.S. Serial No. 86/238,513 (“Application”), in the Supplemental Register for “Indicating membership in a union of stagehands.”

4.5. Respondent operates is a labor union of stage crew in the Chicagoland area that and Respondent provides services, including: self-described as “establishing committees with employers to promote improved relations between employers and unions; providing information regarding labor union services.” [See Serial No. 85/530,945.] Respondent’s activities include, among other things, organizing, /providing support for strikes, negotiating/renegotiating Collective Bargaining Agreements, training, referrals to work and benefits for its members.

6. There are certain venues in the Chicagoland area with limited collective bargaining agreements at which both Petitioners and Respondent may provide stage crew services.

7. Since at least 2009, there are certain venues at which both Petitioners and Respondent compete for business. Further, Respondent learned of Petitioners' CHICAGO STAGEHAND brand in 2009 when a venue with a limited collective bargaining agreement that used both union and non-union stage crews notified Respondent of Petitioners' business.

8. On April 1, 2014, Respondent ~~submitted the Application~~ filed an application to the USPTO seeking registration of register the mark CHICAGO STAGEHANDS for a collective membership mark "indicating membership in a union in connection therewith supplied of stagehands" in Class 200 which application was assigned U.S. Serial No. 86/238,513 and matured into Reg. No. '637 on November 7, 2017 on the Supplemental Register.

9. Eaves App has been suspended on the basis of confusing similarity with Respondent's Reg. No. '637 and Respondent's application to register the same mark for union services which has been assigned Serial No. 85/530,945.

10. One of the Petitioners and Respondent were previously involved in a prior cancellation proceeding, *Theatrical Stage Employees Union Local No. 2 of the International Alliance of Theatrical Stage Employees and Moving Picture Technicians, Artists and Allied Crafts of the United States and Canada v. David Eaves* (Canc. No. 92/055,242) ("Canc. '242"), which resulted in the cancellation of Petitioner Eaves' CHICAGO STAGEHAND registration.

5-11. On April 1, 2014, during the pendency of Canc. '242, Respondent submitted its application which matured into Reg. No. '637 supplying as a specimen a hat with a logo on the front facing area ("Specimen") claiming use in commerce since 1950. ("Specimen")

12. Nearly 2 years prior to On information and belief and based on the evidence submitted by Respondent in Canc. '242, Respondent knowingly made material false representations regarding its dates of first use and its use of the words "Chicago Stagehands" as a collective membership mark in connection with its application to register the mark which is the subject matter of this petition with the intent to deceive the USPTO and to procure a trademark registration.

~~6.13. At the time of the filing this Application, since February 24, 2012, Respondent has been involved in a Cancellation Proceeding, Cancellation Proceeding No. 92055242 (“Cancellation Proceeding”), involving the CHICAGO STAGEHANDS mark against David B. Eaves. Regardless, Respondent of the Application, Respondent knew it did not have exclusive rights in the mark. Respondent’s attorney signed the declaration to this Registration falsely affirming that no other person or corporation has a right to this Mark when ~~it~~he knew that Petitioners were using an almost identical mark for services that Respondent claims are similar.~~

~~7.14. Respondent claims 1950 as first use and first use in commerce but cannot provide any facts to support the claims in the Application to support this date. On information and belief and based on the evidence submitted by Respondent in Cancellation No. 92055242, Respondent did not give, sell, order, or produce hats, shirts, buttons, or any item during the claimed dates that ~~show the Mark. Respondent’s claimed dates of use on the Application for the Registration have no basis in fact~~demonstrate use of the mark claimed as a collective membership mark.~~

~~8.15. On information and belief and based on the evidence submitted by Respondent in Cancellation No. 92055242 Canc. ’242, in the specific years between 1950 and until today, with Respondent did not use the exception of a few hats during one strike in 2001, neither Respondent nor any of its individual members were using any item of apparel with the words “chicago stagehands” to indicate Mark as a collective membership mark either in Illinois or in interstate commerce (either as a decorative element or as a trademark), as set forth in TMEP §§ 1302-1304.~~

~~16. Assuming for the sake of argument that the words “Chicago Stagehands” on the hat has any trademark significance for indicating membership in the union, the Specimen hat was not ordered by Respondent until 2001, more than five decades after the claimed first use in commerce date, and thereafter discontinued indefinitely. On information and belief and based on the evidence submitted by Respondent in Cancellation Canc. ’242, Respondent did not exercise control the use of the mark claimed, through its by-laws or otherwise.~~

17. Respondent's counsel signed the declaration for Respondent's application to register CHICAGO STAGEHANDS for use as a collective membership mark with knowledge of the false statements of use and the intent of procuring a trademark registration.

~~9.— In connection with Reg. No. 92055242, even until today, Petition does not provide, make, or sell any hats to indicate membership in its union.~~

~~10. Thus '637, Respondent did not provide a proper specimen for the Registration. Respondent submitted the Specimen to obtain the Registration as a mark for indicating membership, but was not using the mark as such.~~

~~11.18. The USPTO Examining attorney has allowed Respondent to disclaim "STAGEHANDS" has disclaimed the word "stagehands" apart from the mark as shown. The Markentire mark is a two word standard character mark, "CHICAGO STAGEHANDS." Allowing the registration of the Mark while disclaiming "STAGEHANDS" means that "CHICAGO" is the. The only non-word not disclaimed word is "Chicago is a large city in the United States and it would be in err to remove "CHICAGO" from circulation by allowing this disclaimer.~~

19. Chicago is a large city in the United and geographically descriptive of the area in which Respondent and its members are located and operate.

20. In Respondent's companion application (Ser. No. 85/530,945) for the same mark CHICAGO STAGEHANDS for union services, Respondent conceded that the word "Chicago" in the mark CHICAGO STAGEHANDS was descriptive, and disclaimed "Chicago" apart from the mark as shown.

~~12.21. In the view of the Examining Attorney reviewing the Eaves App, and the Board in its decision in Canc. '242 at page 25-26, there is a likelihood of confusion between Petitioners' mark and Respondent's mark when used in connection with the parties respective services.~~

~~13.22. For the reasons stated above, Respondent's Registration should be cancelled because: a) Respondent has committed Fraud on the United States Patent and Trademark ~~o~~Office during the filing of the Application for the Registration; and, b) Respondent did not and does not use ~~hats or shirts~~the mark as a ~~specimen for indicating collective membership in a union~~mark, and c) ~~Respondent has conceded the~~~~

mark is primarily merely descriptive in that the word "CHICAGO" it consists of two words, one of which is admittedly descriptive of the services and the other of which is geographically descriptive. ~~Therefore, of the only location in which Respondent's Application, Specimen, and claims do not support the alleged use of the claimed Mark as a collective mark for union membership.~~ members operate.

WHEREFORE, Petitioners ask that this board cancel registration 5,331,637 and provide any further relief that it finds proper and just.

The proper filing fee for this Petition for Cancellation has previously been submitted.

Dated: ~~December 21, 2017~~ April 13, 2018

Respectfully Submitted by:

/ Pawel A. Fraczek /

Attorney for Petitioners

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