

ESTTA Tracking number: **ESTTA1138434**

Filing date: **06/07/2021**

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

Proceeding	92077287
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Date	06/07/2021
Attachments	AM PET - AS FILED.pdf(154137 bytes )

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

**NITTI GRITTI MUSIC, LLC,**  
Petitioner,

v.

**NITTY GRITTY DIRT BAND, INC.,**  
Registrant.

Cancellation No.: 92077287  
Registration No.: 4,900,314  
Mark: **NITTY GRITTY DIRT BAND**  
Registration Date: February 16, 2016

**AMENDED PETITION TO CANCEL**

Pursuant to the provisions of 15 U.S.C. § 1064 and TBMP § 307, Petitioner Nitti Gritti Music, LLC (“Petitioner”), a Florida limited liability company located at 17901 SW 66 Street, Southwest Ranches, Florida 33331, believes that it is and will continue to be damaged by Registration No. 4,900,314, and hereby submits its Amended Petition to Cancel same.

As grounds for this Petition, Petitioner alleges as follows:

1. According to the electronic records of the United States Patent and Trademark Office (“PTO”), Nitty Gritti Dirt Band, Inc. (“Registrant”), a Tennessee corporation located at 1605 17th Ave S., Nashville, Tennessee 37212. Registrant is the record owner of U.S. Trademark Registration 4,900,314 for the mark **NITTY GRITTY DIRT BAND**, which registration issued on the Principal Register on February 16, 2016.

2. U.S. Trademark Registration No. 4,900,314 includes “Entertainment services in the nature of live visual and audio performances by members of the band; Entertainment services in the nature of live visual and audio performances, namely, musical band, rock group, gymnastic, dance, and ballet performances; Entertainment services in the nature of live visual and audio performances, namely, musical, variety, news

and comedy shows; Entertainment services in the nature of presenting live musical performances; Entertainment services in the nature of recording, production and post-production services in the field of music,” in International Class 41.

3. Upon information and belief, U.S. Trademark Registration No. 4,900,314 is subject to cancellation on the basis of non-use. In particular, Registrant previously and knowingly claimed a Section 1(a) filing basis when the **NITTY GRITTY DIRT BAND** mark was *not* in use in commerce on or in connection with all the services covered by the Section 1(a) basis as of the application filing date for Registration No. 4,900,314.

4. Alternatively, U.S. Trademark Registration No. 4,900,314 is subject to cancellation on the basis of abandonment.

5. Alternatively, because Registrant knowingly and falsely represented that it was using the **NITTY GRITTY DIRT BAND** mark, with the intent to deceive the PTO when it maintained the registration, U.S. Trademark Registration No. 4,900,314 is invalid and unenforceable.

6. Petitioner believes that it is and is likely to continue to be damaged by the continued existence of the U.S. Trademark Registration No. 4,900,314. Specifically, Petitioner owns U.S. Application Serial Nos. 88/670,665 and 88/670,709 for NITTI GRITTI (word mark) and NITTI GRITTI (stylized), respectively, and both applications were finally refused registration on August 24, 2020. Furthermore, Petitioner’s continued and legal use of the phrase NITTI GRITTI will be impaired by the continued registration of U.S. Trademark Registration No. 4,900,314.

**Non-Use and Void *Ab Initio***

7. U.S. Trademark Registration No. 4,900,314 should be cancelled based on Registrant's non-use in U.S. commerce of **NITTY GRITTY DIRT BAND**.

8. Pursuant to Trademark Rule 2.34(a)(1)(i) and 37 C.F.R. § 2.34(a)(1)(i), in a use-based application reciting services, if an applicant fails to use its mark "in commerce" in association with any of the services in a particular class specified at the time of filing, the application and any resulting registration are void *ab initio* as to that entire class on the ground of nonuse.

9. Under Trademark Act Section 45, 15 U.S.C. § 1127, the "use in commerce" requirement is met for service marks when: (1) a mark is "used or displayed in the sale or advertising of services" and (2) either (i) the services are "rendered in commerce" or (ii) the services are "rendered in more than one State or in the United States and a foreign country and the person rendering those services is engaged in commerce in connection with the services."

10. In filing its trademark application, Registrant falsely alleged use of **NITTY GRITTY DIRT BAND** in connection with each of the identified services, namely, "Entertainment services in the nature of live visual and audio performances by members of the band; Entertainment services in the nature of live visual and audio performances, namely, musical band, rock group, gymnastic, dance, and ballet performances; Entertainment services in the nature of live visual and audio performances, namely, musical, variety, news and comedy shows; Entertainment services in the nature of presenting live musical performances; Entertainment services in the nature of recording, production and post-production services in the field of music," in International Class 41.

11. Upon information and belief, Registrant did not use (and currently is not using) **NITTY GRITTY DIRT BAND** in connection with each of the above-identified services as of its claimed date of first use (i.e., May 1, 1966) or its application filing date (i.e., November 20, 2014).

12. Despite exhaustive searches of Registrant's website at <nittygritty.com> and Registrant's related social media pages, there is no evidence that Registrant ever offered each of the above-identified services under the **NITTY GRITTY DIRT BAND** mark.

13. Registration No. 4,900,314 is void *ab initio* because Registrant made certain material misrepresentations to the PTO regarding use of the **NITTY GRITTY DIRT BAND** mark in connection with all of the services identified in its then-pending application.

14. Upon information and belief, Registrant subsequently submitted a Combined Declaration of Use and Incontestability under Sections 8 & 15 and specimens to the PTO on February 16, 2021, alleging continuous use of the **NITTY GRITTY DIRT BAND** mark, notwithstanding that Registrant had never used the mark in connection with *all* of the services identified in U.S. Trademark Registration No. 4,900,314.

15. Registrant alleged use of **NITTY GRITTY DIRT BAND** under penalty of "fine or imprisonment, or both, ...and [knowing] that such willful false statements may jeopardize the validity of the application or any resulting registration..."

16. As a result of Registrant's misrepresentations and non-use, Registrant's trademark registration is void *ab initio* and unenforceable.

### **Abandonment**

17. Alternatively, U.S. Trademark Registration No. 4,900,314 should be cancelled based on Registrant's abandonment of **NITTY GRITTY DIRT BAND** in U.S. commerce.

18. According to Section 308 of the TBMP, 15 U.S.C. 1064, a Petition to Cancel a registration may be filed at any time if the registered mark has been abandoned.

19. Upon information and belief, Registrant has not used the **NITTY GRITTY DIRT BAND** mark in U.S. commerce for at least three years in connection with at least certain of the services identified by Registration No. 4,900,314, i.e. "Entertainment services in the nature of live visual and audio performances, namely, gymnastic, dance, and ballet performances," in International Class 41.

20. Upon information and belief, Registrant has abandoned the **NITTY GRITTY DIRT BAND** mark, as applied to the services set forth in Registration No. 4,900,314, and has discontinued use of said trademark with the intention not to resume the use thereof.

21. Upon information and belief, Registrant's **NITTY GRITTY DIRT BAND** mark is abandoned and its registration should be cancelled based on its loss of its priority date.

### **Fraudulent Maintenance of Registration No. 4,900,314**

22. Registrant committed fraud in maintaining Registration No. 4,900,314 for **NITTY GRITTY DIRT BAND** based on nonuse in commerce, thus making Registrant's registration for **NITTY GRITTY DIRT BAND** *void ab initio*.

23. Registrant's Combined Declaration of Use and Incontestability under Sections 8 & 15 alleged that Registrant was using the **NITTY GRITTY DIRT BAND** mark "in commerce on or in connection with **all** goods or services listed in the existing registration." (emphasis in original).

24. Registrant falsely alleged trademark use of the mark **NITTY GRITTY DIRT BAND** in connection with services including, but not limited to, "Entertainment services in the nature of live visual and audio performances, namely, gymnastic, dance, and ballet performances," and "Entertainment services in the nature of live visual and audio performances, namely, news and comedy shows," notwithstanding that Registrant had never used the mark in the drawing in connection with such services.

25. Upon information and belief, Registrant admittedly knew that its representations to the PTO were false.

26. Upon information and belief, Registrant made these statements under penalty of "fine or imprisonment, or both, ...and [knowing] that such willful false statements may jeopardize the validity of the application or any resulting registration..."

27. Upon information and belief, Registrant knowingly made material misrepresentations to the PTO to maintain Registration No. 4,900,314, and the PTO relied on the representations. The PTO would not have maintained Registration No. 4,900,314 but for Registrant's false representations.

28. As a result of Registrant's fraudulent conduct, Registration No. 4,900,314 is invalid and unenforceable.

29. Registrant's fraudulent conduct, undertaken willfully and knowingly, invalidates Registration No. 4,900,314.

**PRAYER FOR RELIEF**

WHEREFORE, Petitioner prays that this Petition to Cancel be sustained and granted in favor of Petitioner and that Registration No. 4,900,314 be cancelled and removed from the Principal Register.

Date: June 7, 2021

Respectfully submitted,

**FRIEDLAND VINING**

/s/ Jaime Rich Vining

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